



European IP Helpdesk

Stay ahead of the innovation game.

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

Dr. Christian Hackl

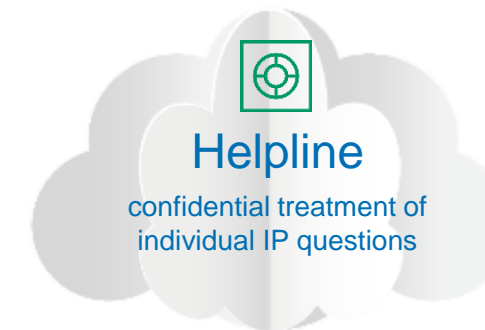
Senior IP Advisor

September 2024



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: 43 ambassadors from 26 EU countries



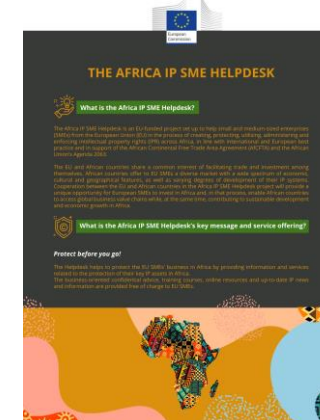
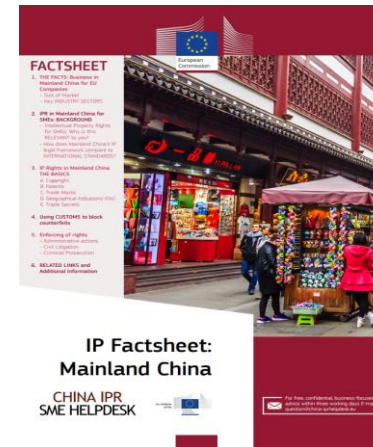
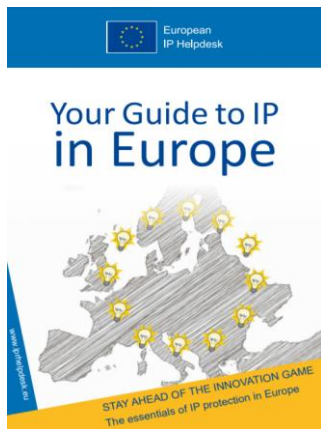


The EC IP Helpdesks





EC IP (SME) Helpdesk Hub – Gateway to Information

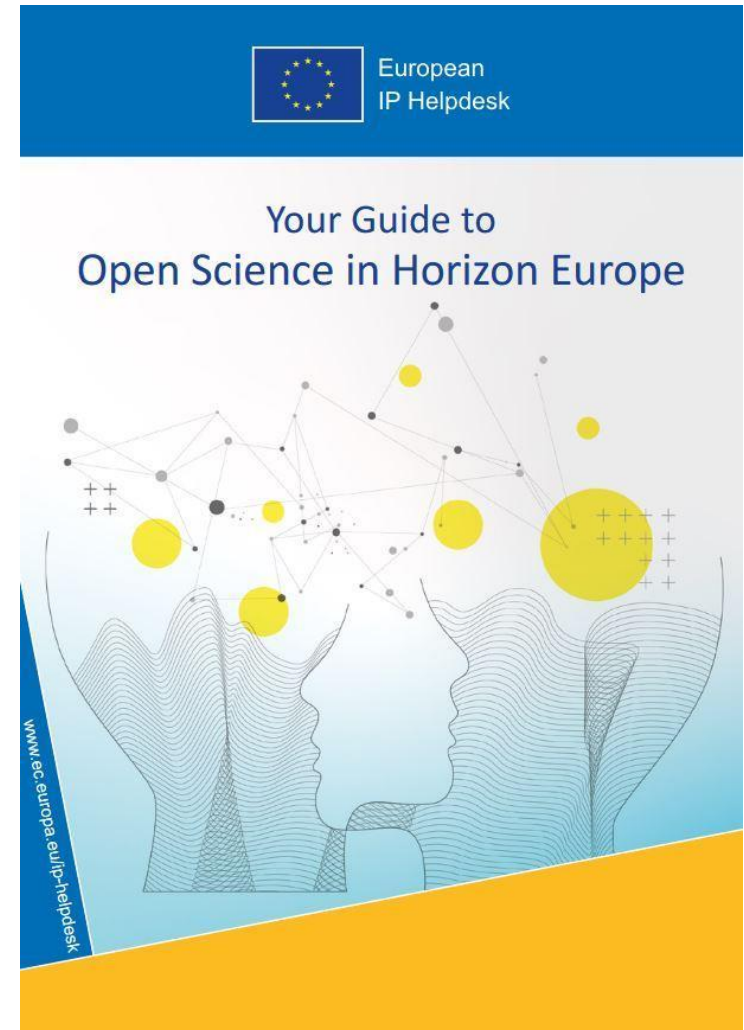


- E-learning modules & more
- Guides / Topic, country, sector-specific factsheets / Infographics
- Case studies



Out Now: Your Guide to Open Science in Horizon Europe

- Open science promotes transparency, accessibility, and collaboration in scientific research
- This Guide helps readers understand OS, offering explanations and guidelines for those preparing or already implementing a Horizon Europe project proposal.





Public Consultation on Craft and Industrial Geographical Indications

- The consultation will shape future international policy and negotiations on geographical indications.
- Open until 10 October 2024, contributions can be submitted [online](#) or via email to GROW-CIGI@ec.europa.eu.





Ambassador Scheme

- **Cooperation scheme** with the Enterprise Europe Network (EEN): 43 ambassadors – 26 countries
- **Building IP capacities** among European SMEs
- **Overcoming language barriers**
- Making the topic **more accessible**
- Exchange and feedback from ambassadors on **needs of SMEs**
- Local **awareness** and **training events**





Upcoming events



04-05
SEP
2024

Conferences and summits

The Dublin IP and R&D Summit: Connecting the Worlds of Business, IP and R&D

Ireland

05
SEP
2024

Training and workshops

EU - Webinar: IP Assessment

Live streaming available

10
SEP
2024

Training and workshops

EU - Webinar: Introduction to IP

Live streaming available

12
SEP
2024

Training and workshops

EU - Webinar: Copyright in collaborative projects

Live streaming available

17
SEP
2024

Training and workshops

EU - Webinar: IP Commercialisation and Licensing

Live streaming available

18
SEP
2024

Training and workshops

EU - Webinar: AI Act

Live streaming available

19-20
SEP
2024

Conferences and summits

PATLIB2024

26
SEP
2024

Training and workshops

EU - Webinar: IP in Horizon Projects (HEU)

Live streaming available

01
OCT
2024

Training and workshops

EU - Webinar: IP in Biotechnology

Live streaming available

03
OCT
2024

Training and workshops

EU - Webinar: IP in Business collaborations for SMEs and Start-ups

Live streaming available

08
OCT
2024

Training and workshops

EU - Webinar & Horizon Results Platform: Technology Transfer

Live streaming available

09
OCT
2024

Training and workshops

EU - Webinar: IP and Artificial Intelligence

Live streaming available

09
OCT
2024

Training and workshops

European IP Helpdesk&EIC&EPO Webinar: License as an exit strategy

Live streaming available

14
OCT
2024

Training and workshops

EU - Webinar: IP Commercialisation & Licensing - Advanced

Live streaming available



- Enhance the dissemination of IP-related knowledge
- Provide innovation support to SMEs, researchers, and EU beneficiaries from EU-13 and Widening countries.

[Register for Novi Sad, Serbia](#)

[Register for Brno, Czechia](#)



Thank you!

- www.ec.europa.eu/ip-helpdesk
- helpline@iprhelphdesk.eu
- training@iprhelphdesk.eu
- X [@iprhelphdesk](#)
- LinkedIn [/european-ipr-helpdesk](#)
- Subscribe / [Newsletter](#)





Overview

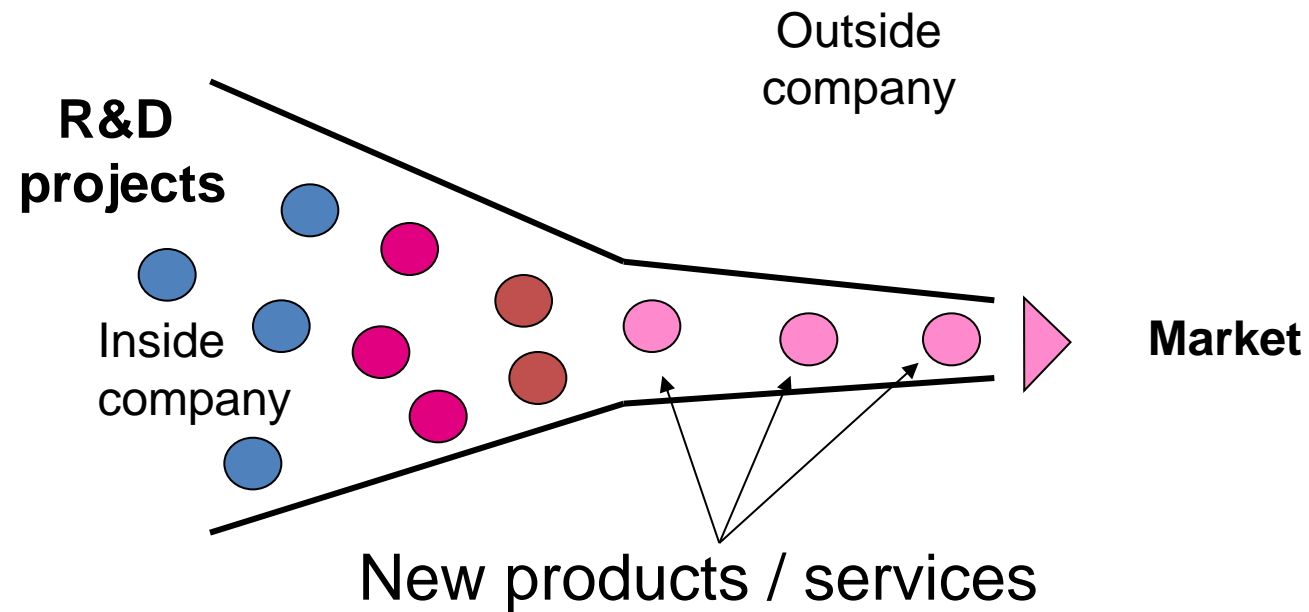
- Introduction European IP Helpdesk
- Open innovation / Commercialisation
- What and why (license)
- Before negotiating
- Core content (licensing agreements)
- Case study
- The negotiation

Training: „Licensing -
Advanced“





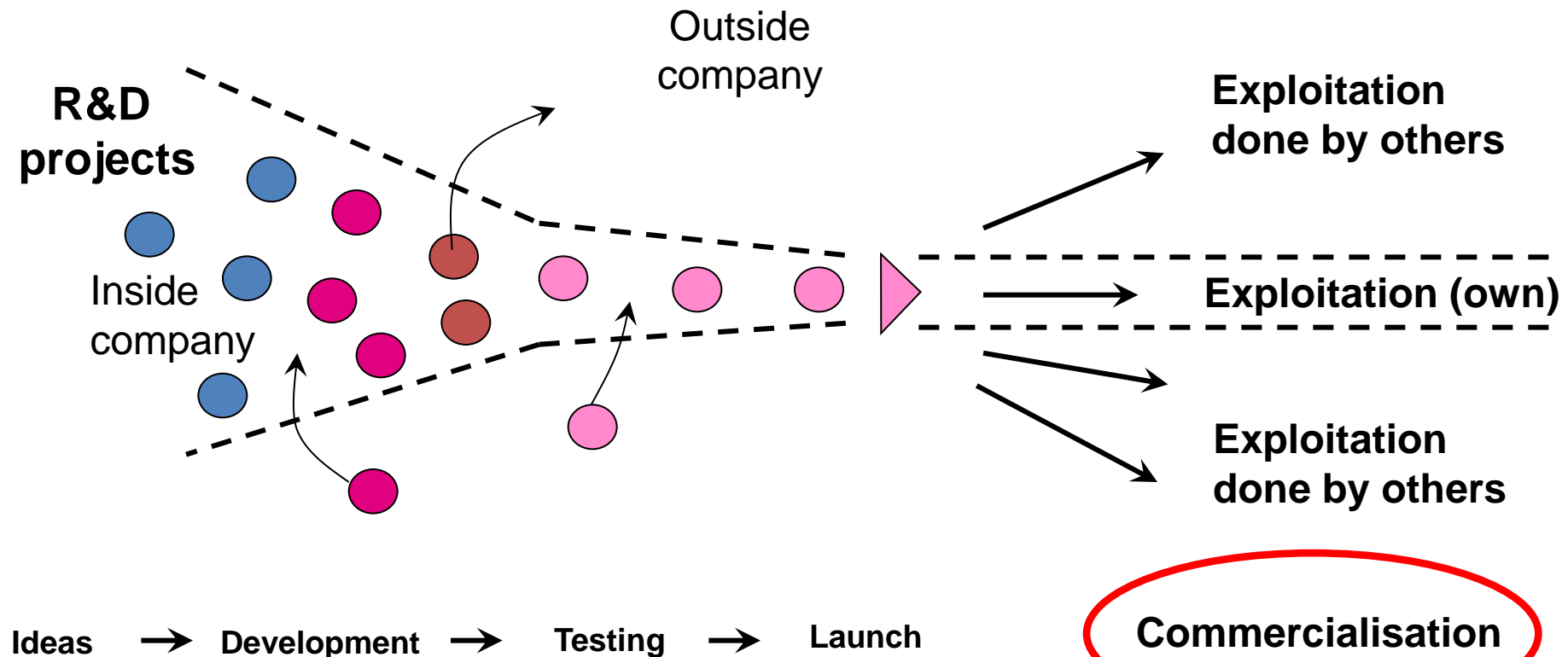
Closed Innovation



Ideas → Development → Testing → Launch

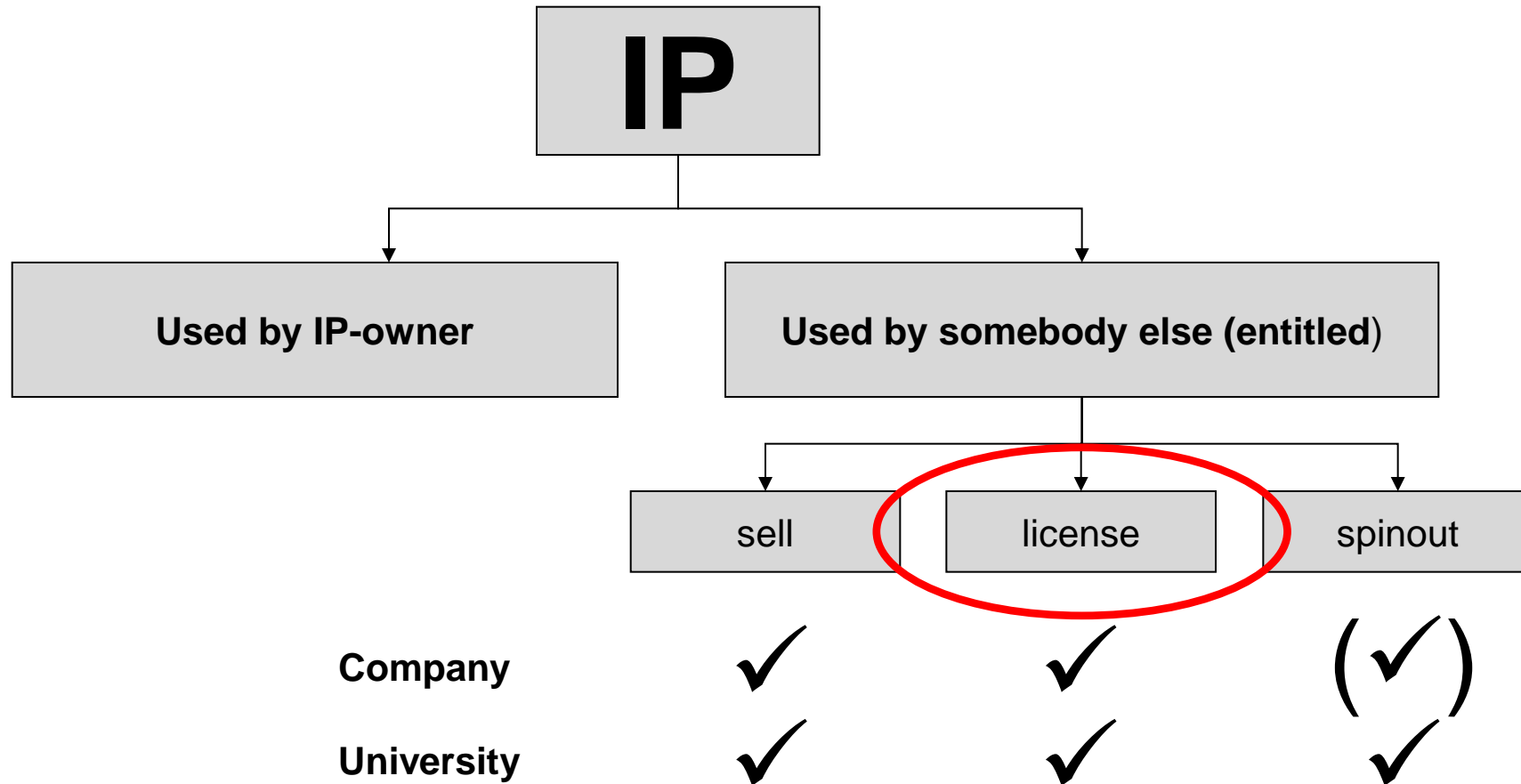


Open Innovation





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

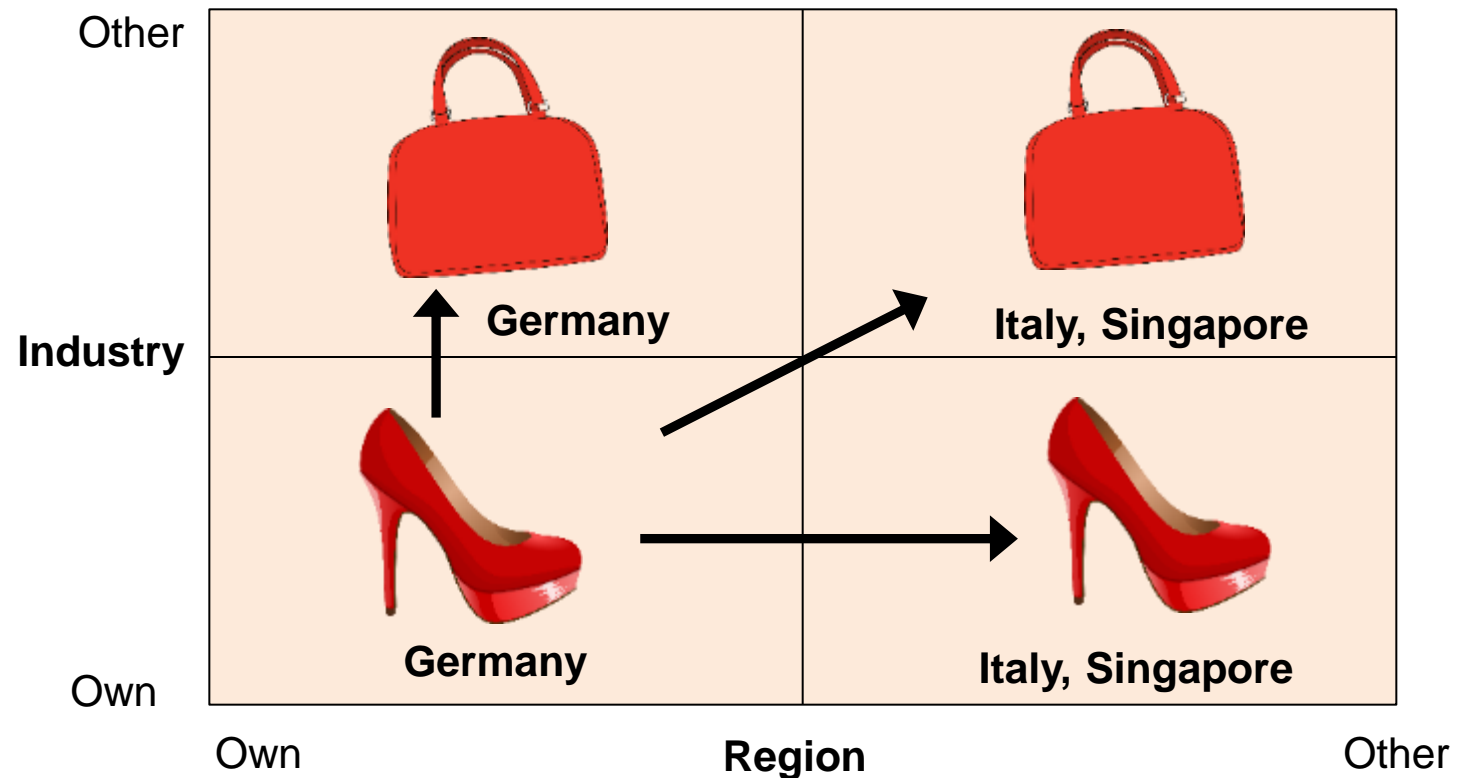


When does external commercialisation make sense?

- 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



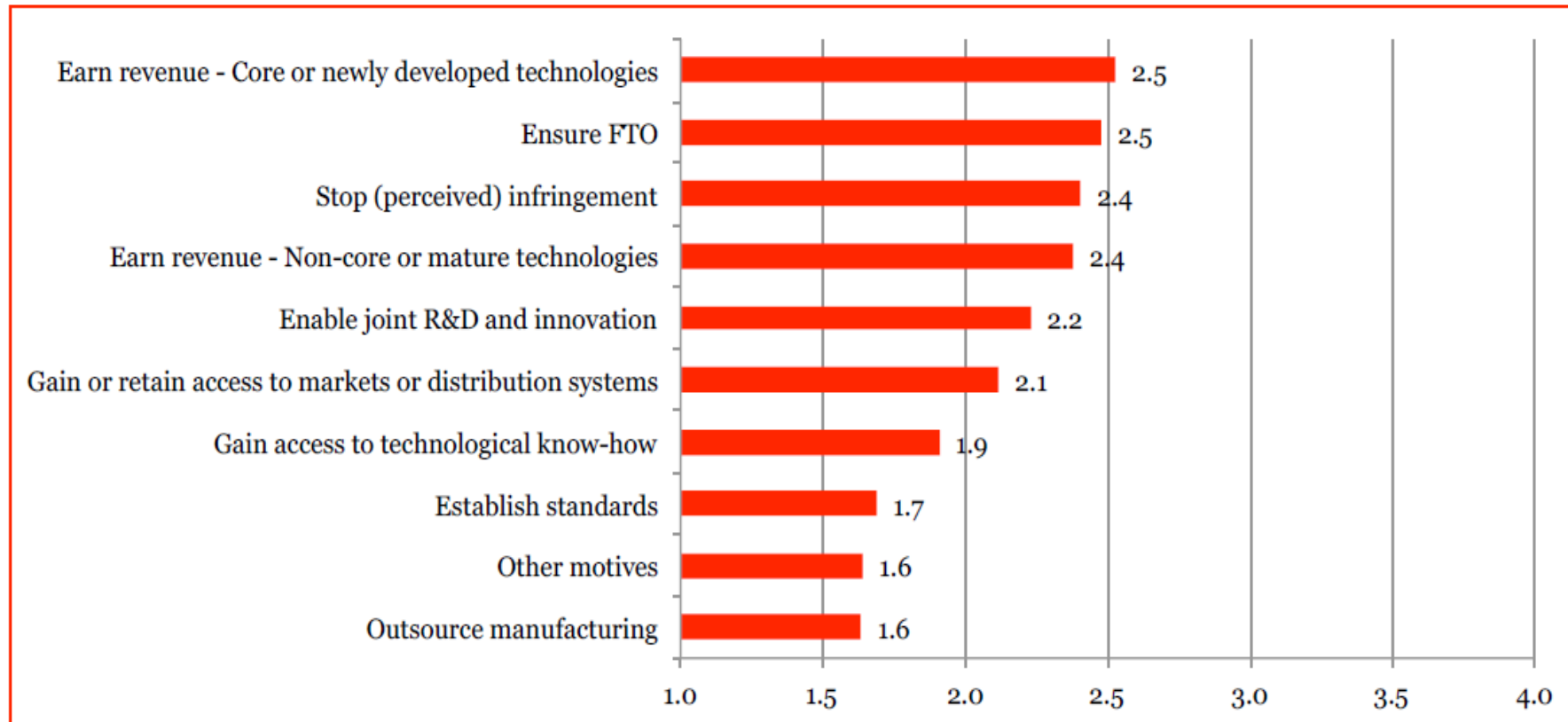
Some more reasons for licensing

- 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

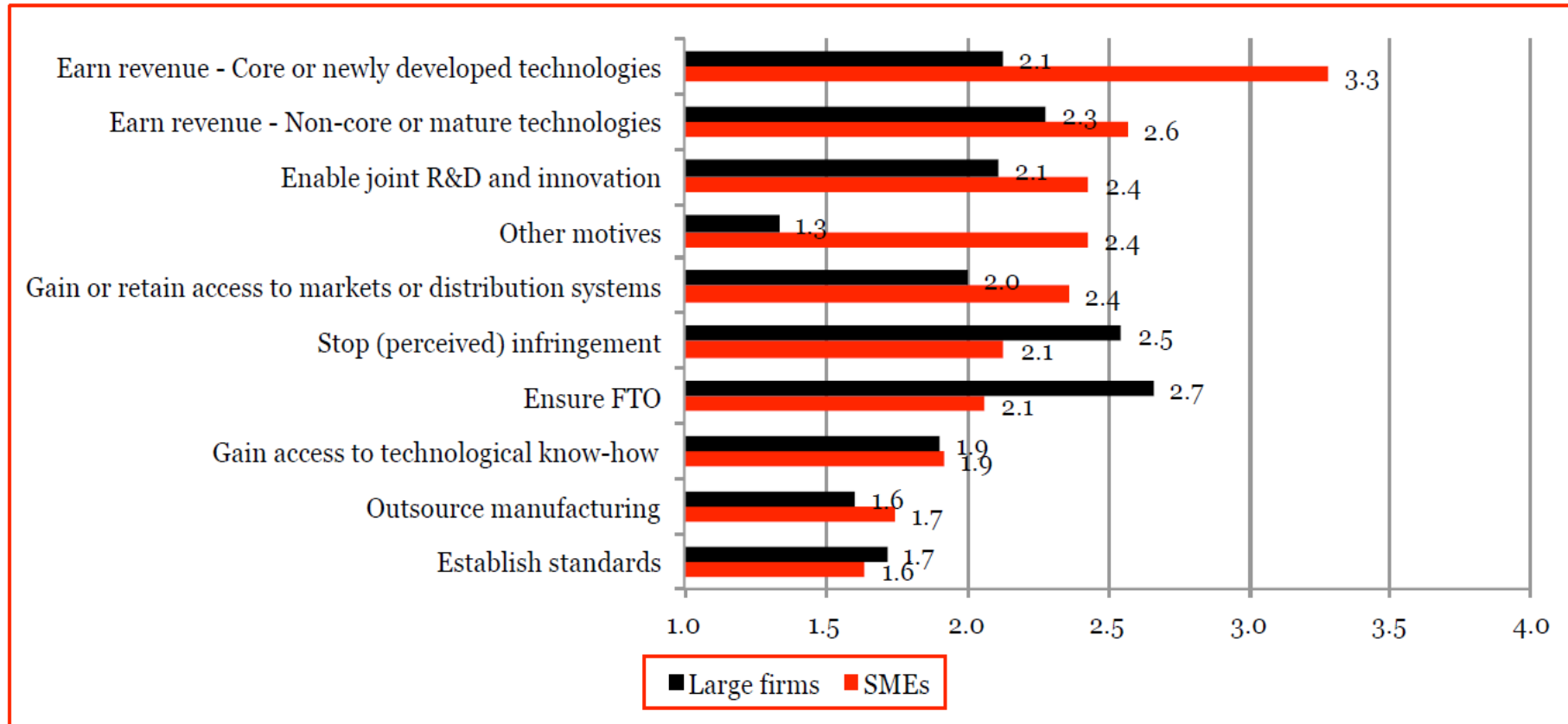


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



Motives for outlicensing patents (size)

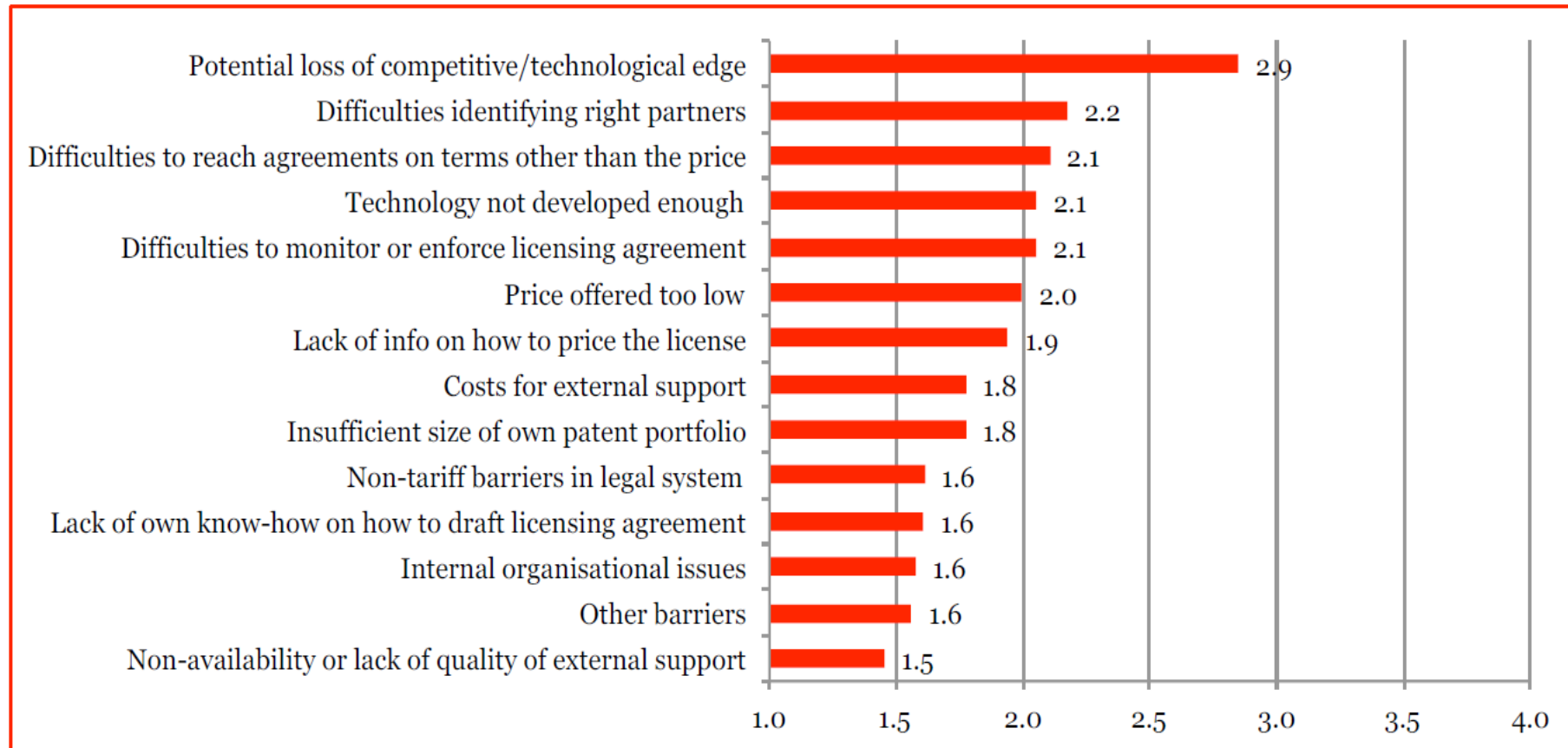


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



Barriers to outlicensing patents

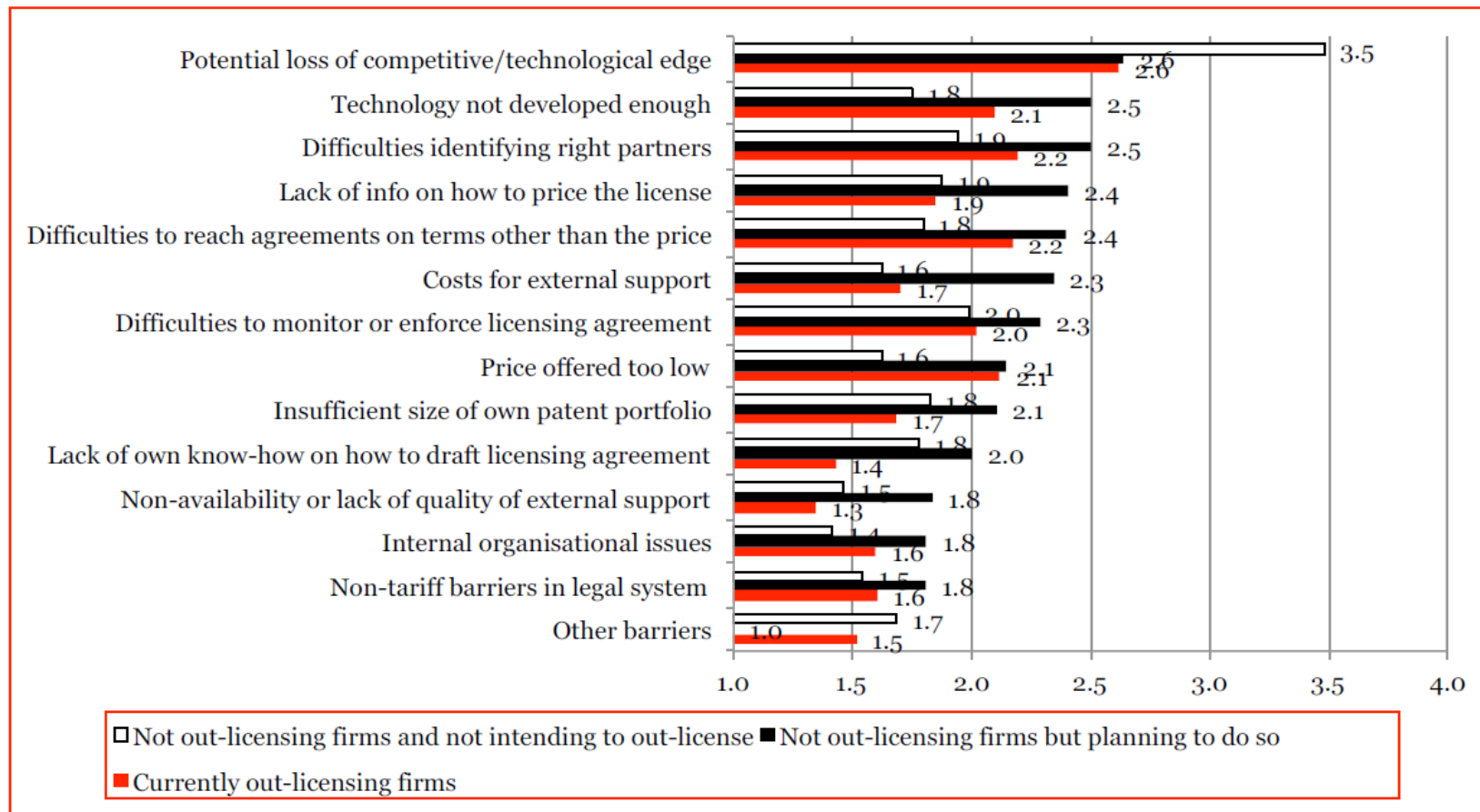


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



Barriers to outlicensing patents

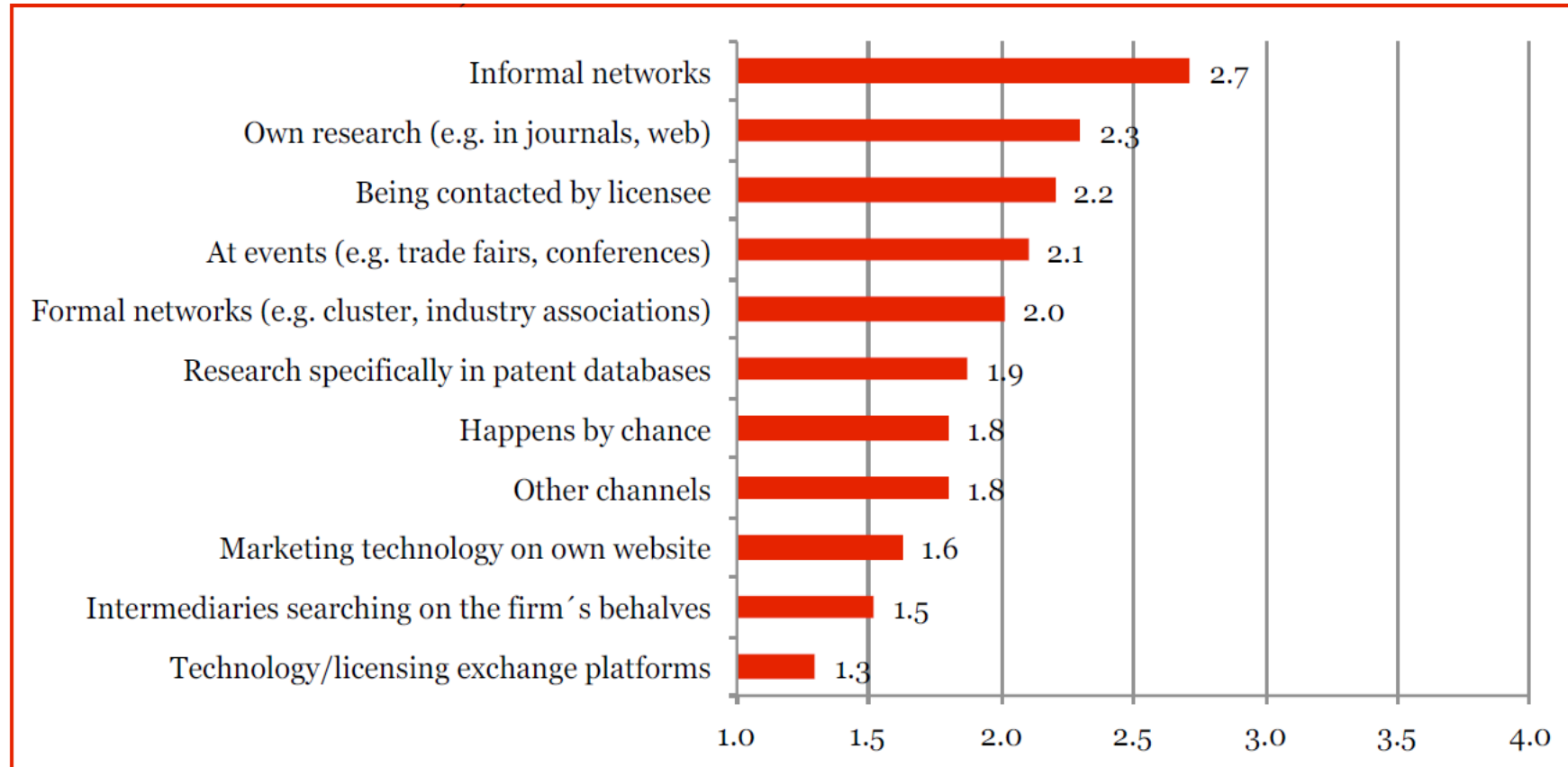


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



Channels to find potential licensees

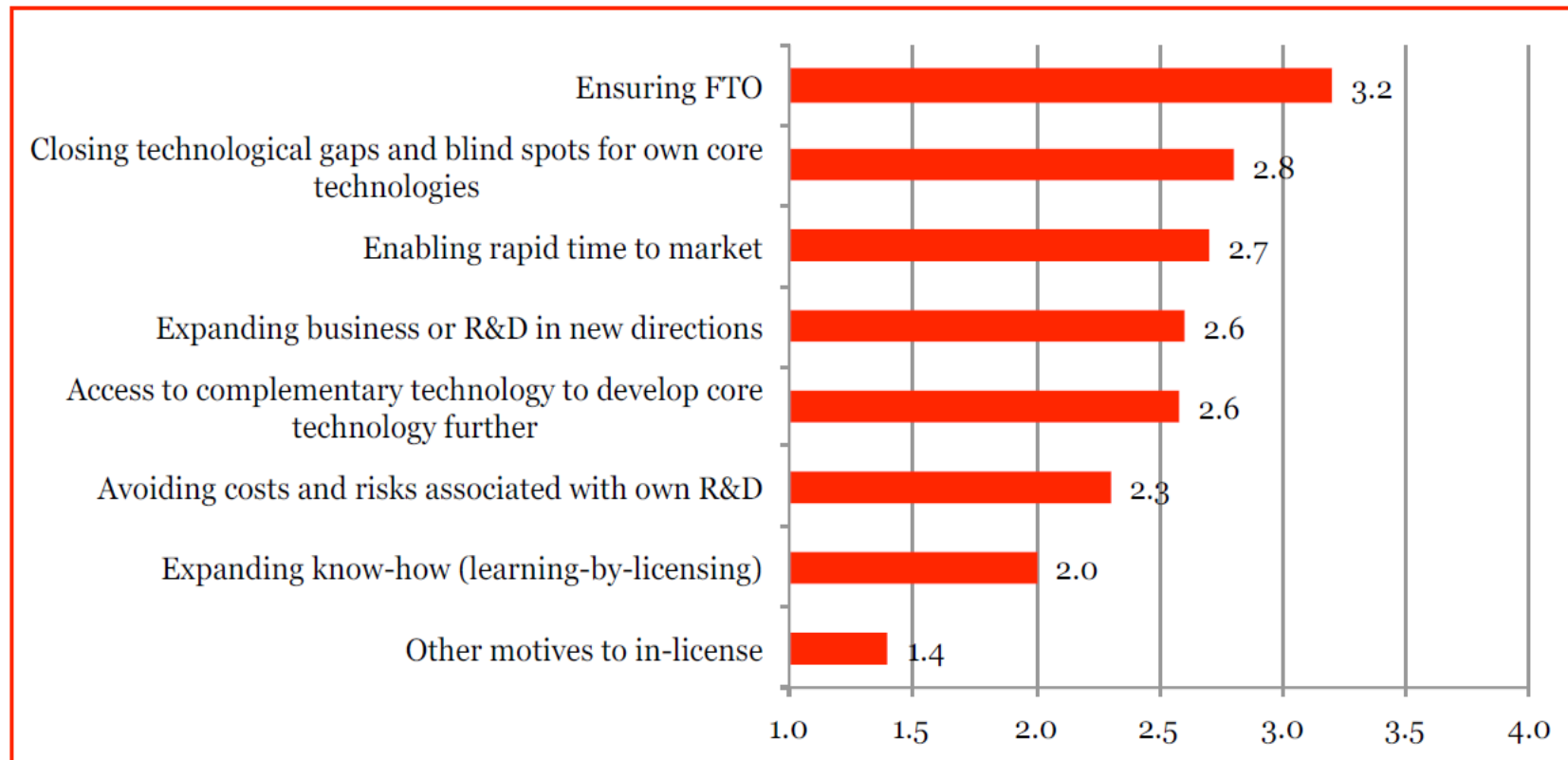


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



Motives for inlicensing patents

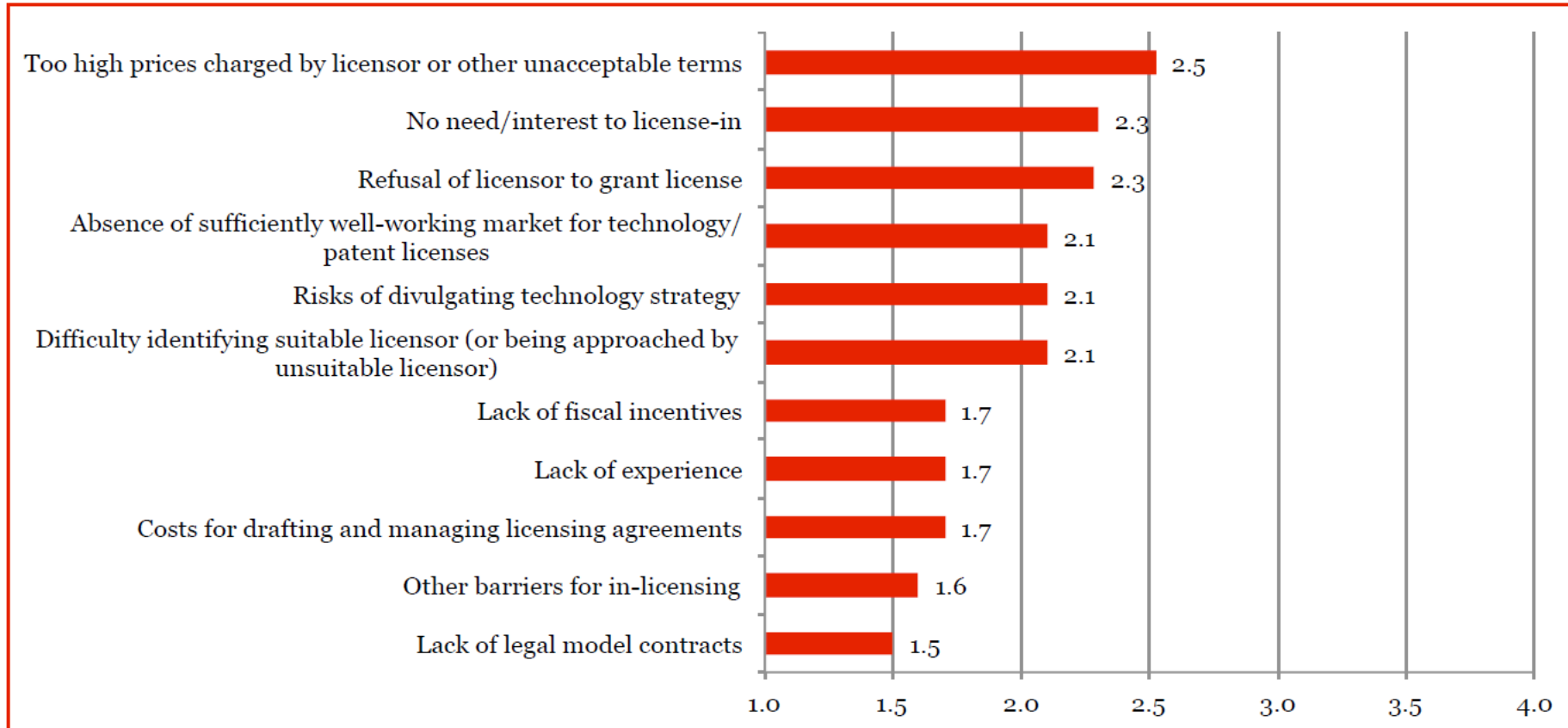


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



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?



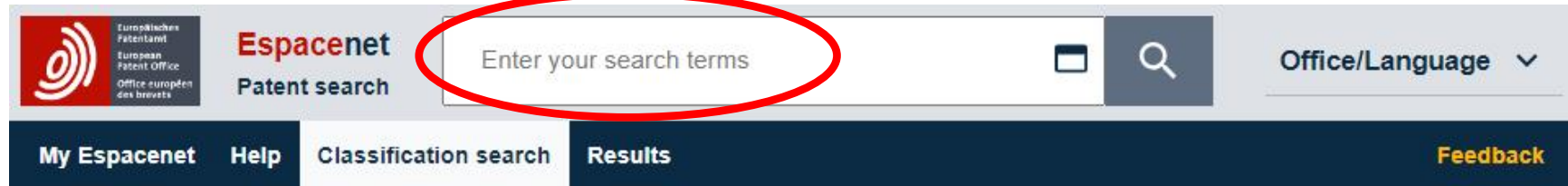
Due diligence in patents

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



The Espacenet database (over 150 million docs)

<https://worldwide.espacenet.com>



Espacenet: free access to over 140 million patent documents

**Also for identifying
potential partners**





The Espacenet database (over 150 million docs)

Europäisches Patentamt
 European Patent Office
 Office européen des brevets

Espacenet
 Patent search

Deutsch English Français
 Contact
 Change country

<< About Espacenet Other EPO online services >>

Search Result list My patents list (0) Query history Settings Help

Smart search
Advanced search
 Classification search

Quick help

- [How many search terms can I enter per field?](#)
- [How do I enter words from the title or abstract?](#)
- [How do I enter words from the description or claims?](#)
- [Can I use truncation/wildcards?](#)
- [How do I enter publication, application, priority and NPL reference numbers?](#)
- [How do I enter the names of persons and organisations?](#)
- [What is the difference between the IPC and the CPC?](#)
- [What formats can I use for the publication date?](#)
- [How do I enter a date range for a publication date search?](#)
- [Can I save my query?](#)

Related links +

Advanced search

Select the collection you want to search in [i](#)

Worldwide - collection of published applications from 90+ countries

Enter your search terms - CTRL-ENTER expands the field you are in

Enter keywords in English

Title: [i](#) plastic and bicycle

Title or abstract: [i](#) hair

Enter numbers with or without country code

Publication number: [i](#) WO2008014520

Application number: [i](#) DE19971031696

Priority number: [i](#) WO1995US15925

Enter one or more dates or date ranges

Publication date: [i](#) yyyymmdd

Enter name of one or more persons/organisations

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

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

Quick access

[Discussion forum](#)
[Classic Espacenet](#)



The Espacenet (n docs)

The screenshot shows the Espacenet 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 tabs, there is a breadcrumb "Home > Results" and a language selector "Query language: en de fr". The main search area is divided into two sections: "AND" and "OR". The "AND" section has two rows of filters: "Title" and "Title or abstract", each with a dropdown menu and a search input field. The "OR" section has three rows of filters: "Publication number", "Application number", and "Priority number", each with a dropdown menu and a search input field. The "Priority number" input field contains the value "2024".



The Espacenet (on docs)

Logo: Bundespatentamt / European Patent Office / Office européen des brevets

Espacenet Patent search

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
- Main topics



Licensing agreements

- The parties (licensor and licensee)
- Purpose
- Definitions and subject matter
- Rights granted and restrictions
- Improvements
- Confidentiality
- Royalties, reports and audits
- Representations and warranties
- Infringement
- Term and termination

Training: „Licensing -
Advanced“



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!



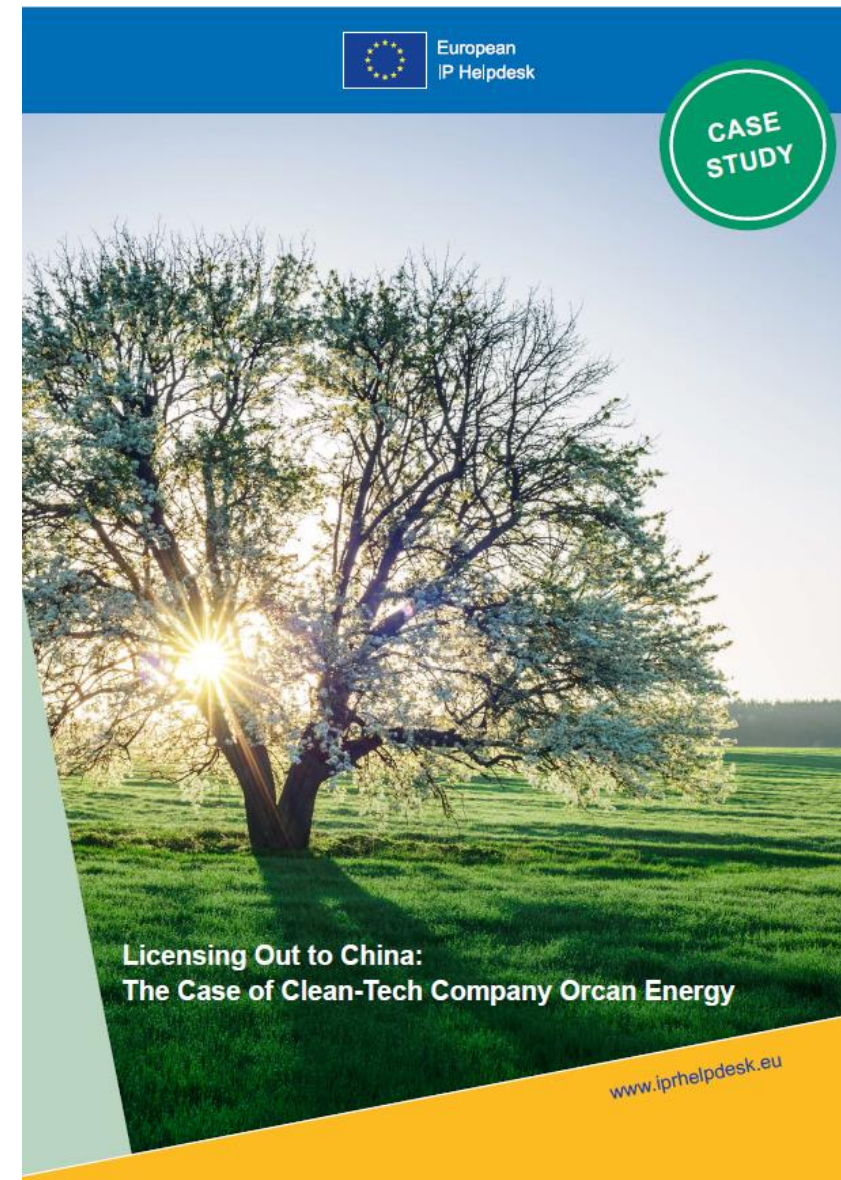
Update





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@iprhelphdesk.eu
- Twitter [@iprhelphdesk](https://twitter.com/iprhelphdesk)
- LinkedIn [/european-ipr-helpdesk](https://www.linkedin.com/company/european-ipr-helpdesk)





All pictures are used under:
Pixabay licence
Unsplash licence
Freepik

Thank you!

The European IP Helpdesk is managed by the European Innovation Council and SMEs Executive Agency (EISMEA), with policy guidance provided by the European Commission's Directorate-General for Internal Market, Industry, Entrepreneurship and SMEs (DG Grow). The information provided by the European IP Helpdesk is not of a legal or advisory nature and no responsibility is accepted for the results of any actions made on its basis. Moreover, it cannot be considered as the official position of EISMEA or the European Commission. Neither EISMEA nor the European Commission nor any person acting on behalf of EISMEA or of the European Commission is responsible for the use which might be made of this information.

© European Union (2024)

