European IP Helpdesk

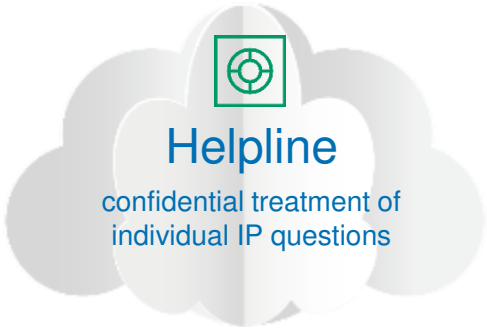
Stay ahead of the innovation game.

European IP Helpdesk Services

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

ec.europa.eu/ip-helpdesk



The EC IP Helpdesks

Upcoming webinars

Europa - Upcoming events

11 APR 2023
Training and workshops
EU - Webinar: IP in Business collaborations for SMEs and Start-ups
Live streaming available

19 APR 2023
Training and workshops
EU - Webinar: Effective IP and Outreach Strategies Help Increase the Impact of Research and Innovation
Live streaming available

20-21 APR 2023
Conferences and summits
EU-Startups Summit 2023
Barcelona, Spain

25-28 APR 2023
Conferences and summits
EU Knowledge Valorisation Week 2023
Live streaming available

25 APR 2023
Training and workshops
IP assessment: how to improve informed decision-making

26 APR 2023
Training and workshops
EU - Webinar: IP and Artificial Intelligence - Advanced
Live streaming available

27 APR 2023
Training and workshops
EU - Webinar:IP Commercialisation & Licensing - Advanced
Live streaming available

27 APR 2023
Training and workshops
IP assessment: how to improve informed decision-making

02 MAY 2023
Training and workshops
EU - Webinar: IP & Open Science
Live streaming available

03 MAY 2023
Training and workshops
EU - Webinar: Maximizing the Impact of Horizon 2020 project results
Live streaming available

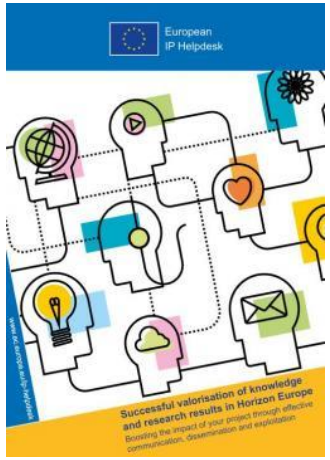
03 MAY 2023
Training and workshops
IP assessment: how to improve informed decision-making

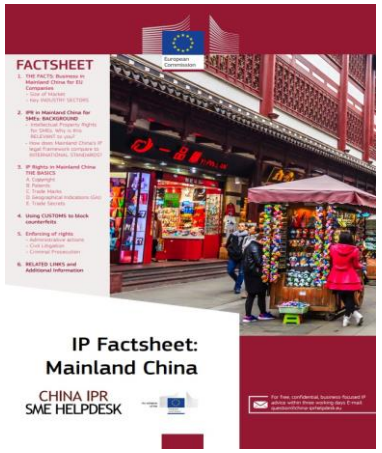
04 MAY 2023
Training and workshops
EU - Webinar: IP for Future and Emerging Technologies
Live streaming available

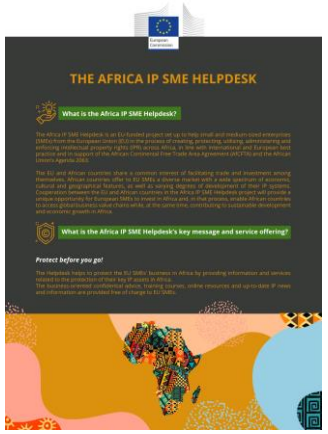
10 MAY 2023
Training and workshops
EU - Webinar: IP in EU funded projects with a special focus on MSCA
Live streaming available

11-12 MAY 2023
Conferences and summits
PATLIB 2023
Live streaming available

EC IP (SME) Helpdesk Hub – Gateway to Information

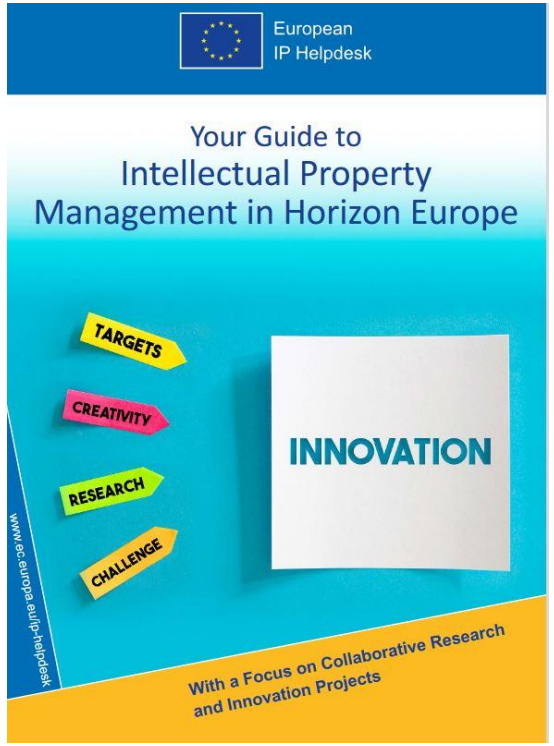






- E-learning modules & more
- Guides / Topic, country, sector-specific factsheets / Infographics
- Case studies

Your Guide to Intellectual Property management in Horizon Europe



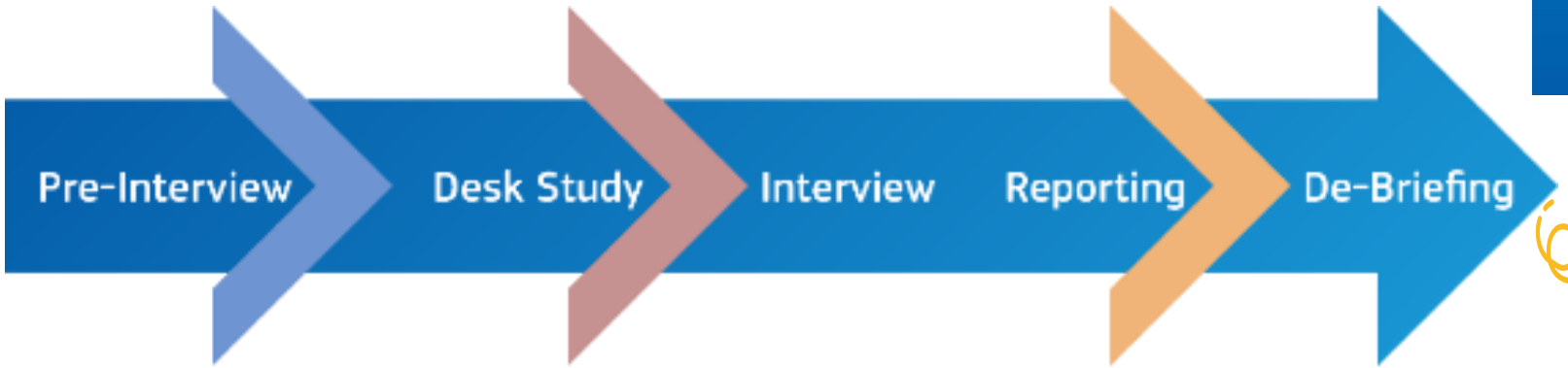
https://op.europa.eu/en/publication-detail/-/publication/43e0204c-6ed3-11ed-9887-01aa75ed71a1/language-en/format-PDF/source-276235204

Ambassador Scheme

- **Cooperation scheme** with the Enterprise Europe Network (EEN): 44 ambassadors – 27 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**

Horizon IP Scan

IP Support Service for SMEs in Collaborative EU-funded Research Projects



www.horizon-ipscan.eu

Horizon IP Scan

European Commission

European IP Helpdesk

www.iprhelpdesk.eu

European IP Helpdesk

Stay ahead of the innovation game.

- 40 years practical experience of early stage technology exploitation
- Experience in Research, Industry and Investment
- Member of ISO and CEN committees developing Innovation and IP Management standards
- Member of Licensing Executives Society

IP in Business Collaborations

Dr Eugene Sweeney, CEO, Iambic Innovation Ltd
Senior IP & Innovation Advisor, European IP Helpdesk
es@iambicinnovation.com
11 April 2023

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Roadmap

- **WHY BOTHER COLLABORATING**
- **IDENTIFYING AND LEVERAGING INTELLECTUAL ASSETS**
- **DEVELOPING SHARED STRATEGIES**
- **MANAGING AND SHARING INTELLECTUAL ASSETS**

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Why collaborate?

All companies need to innovate (or die!)

SMEs have limited resources or capacity

Partnering with others can provide access to new assets and opportunities

3

Where to collaborate?

What are the **gaps** or in the product or service offerings?

How could the product or service be **improved**?

Are there **new products or services** which could help the company?

Working with others can help

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Can you get more value from your IP assets?

- IP which is not yet being used, but could be further developed with others?
- Core IP which could be built on to develop new innovations?
- Applications of IP in other sectors or fields of use?
- **Sharing IP can help**

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Where are new opportunities?

- New geographic territories not yet addressed
- New fields of use
- New market sectors
- **Working with others can help to access these**

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Many types of business collaboration

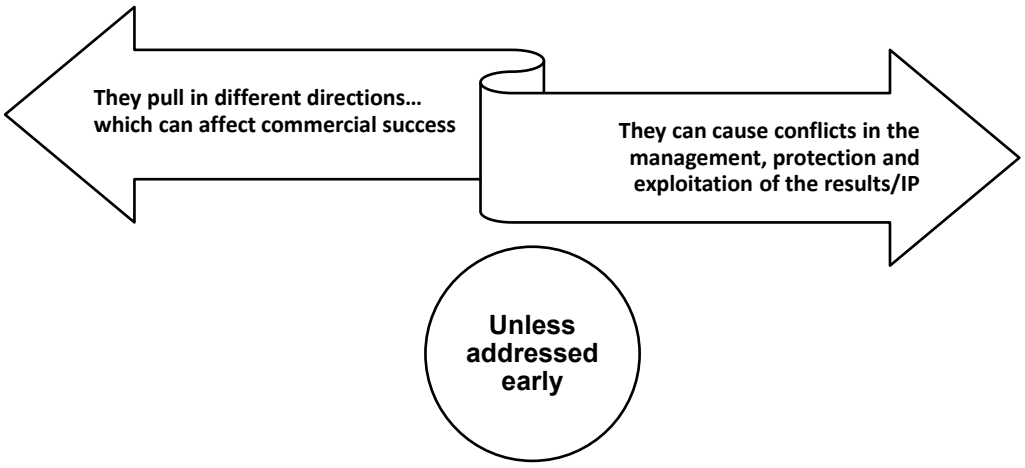
- Research
- Supply Chain
- IP licensing in or out
- IP Cross-licensing
- Joint Venture
- Start up with shared equity
- Shared marketing, different markets (by fields of use or territory)
- etc

Align individual and shared commercial strategies

Agree strategies for managing, protecting and exploiting the IP

7

Different businesses = different motives and cultures



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COLLABORATION
=
GIVE & TAKE
=
"SHARING" ASSETS

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Intellectual Assets

Products of the mind

Assets which can be traded

The KEY assets in any company
Company USPs

Collaboration Inputs & Outputs

- *Inventions*
- *Software code*
- *New methods*
- *Manuals/Reports*
- *Designs (aesthetic/functional)*
- *Databases*
- *Works of art*
- *Music*
- *Videos*
- *Books*
- *Roadmaps*
- *etc*

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Intellectual Property Right (IPR)

- Patents
- Copyright
- Design Rights
- Database Rights
- Trade marks
- Plant Breeders Rights
- Utility Models/petty patents
- Plant varieties
- etc

- Some legal rights come into existence automatically
- Some need registration
- Confidentiality Agreements (Know-how)
- Secrets (Trade Secrets)
- Time limited rights
- National rights

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What is the deal?

- **legal right to prevent** others using their creation (without agreement)
- **commercial purposes (only)**
- for a **limited period**

In return for

- **disclosing details**
- **so others can develop new innovations**

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Who benefits?

The state by avoiding secrecy	• **Improves innovation capacity, stimulates innovation, enriches society**
The creator by being able to prevent unauthorised commercial use	• **Unless they come to an agreement (which may be financial)**
Investors (time, money, facilities, etc) from the limited monopoly	• **To get a return on investment**

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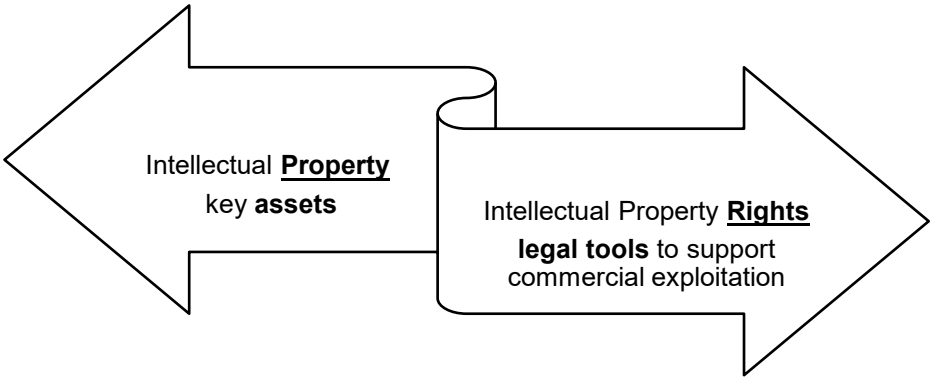
Don’t confuse IA, IP and IPR



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IP Protection is a strategic commercial decision

Are there are commercial opportunities? → Would IP protection support the business? → Benefits greater than costs? → If so, **invest!**

Assessment, protection and exploitation must be considered together

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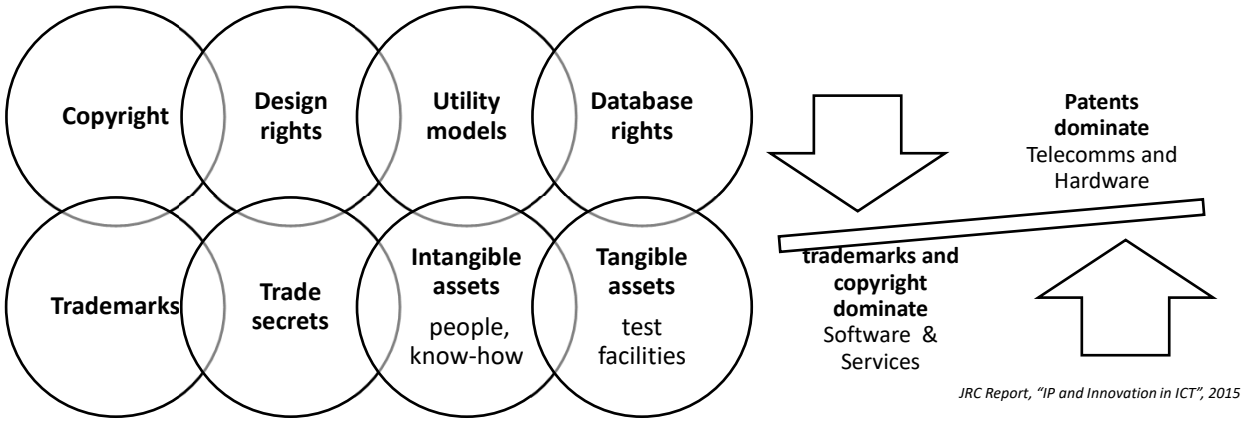
Many ways to protect



JRC Report, "IP and Innovation in ICT", 2015

16

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Ensure all the relevant assets are identified
(as well as all the contributors)

Patentable IP	Copyrightable IP	Designs (design rights)	Trade secrets, etc	Intangible assets
• Computer implemented inventions (software!) • Processes • Products • Apparatus	• Software code • Reports • Engineering drawings • Manufacturing and user guides	• Functional • Eye-appeal	• Formulas • Methods • etc	• **People** • **Know how (e.g. best way to implement)** • **Potential Brand value (supported by Trade or Service Marks**

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THE STRATEGIC USE OF INTELLECTUAL ASSETS IN BUSINESS COLLABORATIONS

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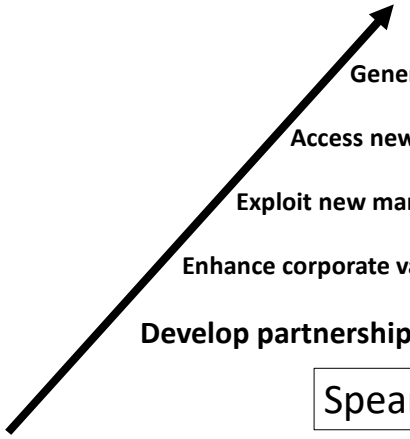
The strategic value of protected IP

Defend position
Secure market share
Protect products or services
Create barriers to entry
Enhance competitiveness
Avoid litigation

Shields



Generate new revenues
Access new technology
Exploit new markets
Enhance corporate value
Develop partnerships and licensing relationships

Spears

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MANAGING THE KEY ASSETS IN COLLABORATIONS

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The 6 pillars of IP Management

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REACHING A COMMON UNDERSTANDING

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What are the collaboration opportunities?

The **opportunities** for **all** the collaborators

Who will address which opportunities (individually or collaboratively)

How the collaboration affects **competitive positioning**

What are the **gaps** in knowledge, competence and assets which the collaboration can reduce

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Needs, Contributions, Benefits, Risks Matrix

Partner	P1	P2
Needs	What are the needs/wants/challenges you want to address?	
Contributions		What do you plan to contribute to the collaboration?
Benefits	What do you want to get out of the collaboration?	
Risks		What are your main concerns or potential risks which might reduce your expected benefits?

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Understand who needs what, when and how?

- **Before the collaboration (negotiation)**
  - Existing knowledge
  - New ideas
- **During the collaboration**
  - Background IP and other assets
  - Management and use of new (shared) IP
  - Exploitation of new (shared) IP
- **After the collaboration ends**
  - Management of collaborative results
  - Management of (collaborative) exploitation

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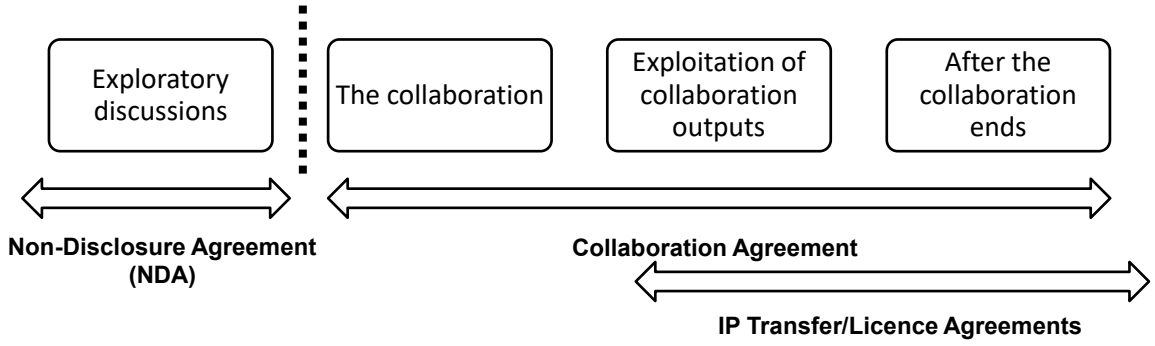
Stages (and agreements) in a collaboration



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Exploratory Discussions

Protected background	• Make collaborators aware of any existing IP Rights • Clarify use during and **after collaboration** (research or **commercial**)
Unprotected, confidential or secret background	• only on a "**need to know**" basis with **NDA** • "**Black box**", or **"Service"** (e.g. **SaaS** rather than software code • Mark as **"confidential"** and **minute** all discussions
New ideas	• Discuss under an **NDA** • Disclose the potential of the ideas, but not the **"how"** (unless agreed)

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Non-Disclosure Agreements

Always have an NDA prior to any discussion related to confidential information (trade secrets, know-how or new ideas)

An NDA **only covers disclosure, NOT commercial transactions**.

Make the **purpose of the disclosure** clear in the NDA

Do not use an NDA beyond exploratory discussions

Confidentiality and trade secret **laws may differ outside Europe**, so ensure NDA serves its purpose – and is "water tight"

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During the collaboration

Clear management responsibilities, structures and procedures for:

- **Accessing** existing IP
- **Capturing, assessing**, and agreeing strategies for **protecting** new IP
- Agreeing terms of **joint ownership**, and its management and exploitation
- **Implementing the exploitation** strategies

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Capturing the collaboration outputs

Which partners contributed (and what) - to determine owners

Other contributors (e.g. students, advisory board members, etc)

Any other external funding or facilities used?

Any relevant confidentiality agreements

Any publications or disclosures already made?

What other IP (3rd party or background) will be needed to use IP?

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Ownership – beware!

Default position without a written agreement

(variations by IP and in national law)

each joint owner owns an **undivided interest** in the whole work.	• It doesn't matter who contributed most
each has the **right to exploit without the other's permission**	• but must pay the other joint owners equal shares of earnings
No right to transfer or grant someone else an **exclusive license**	• Without permission of other joint-owners
If case of **infringement**, one joint-owner can sue the infringer without consent or involvement of the other(s)	• But any damages or compensation recovered will need to be shared

It is always best to have a written agreement!

Processes to agree relative contributions and to take decision

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Assessing and Protecting the Results

- Must reflect commercial strategies of all partners
  - including licensing to 3rd parties)
- Who makes decisions and manages protection?
  - Ensuring all commercial partners have a say
- Who will pay for protection?
  - And how will costs be shared?
- What are the roll-back?
  - How will continuations or lapses be decided?
  - How will infringement be managed?

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Agree exploitation of the collaboration outputs

Agree exploitation strategies and pathways and responsibilities

- **Who exploits** what, where and how?
- How, and **under what terms**, is IP made available for commercial or other use?
- Rights of first refusal for **upgrades/improvement**?
- Who will manage **infringement, litigation**?
- Post-deal **auditing**?

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Different routes to value creation

Routes, vehicles (and drivers)

- Licence
- JV
- NewCo
- NPF
- Etc

Requirements to get you there **(fuel)**

- Finance/Investment
- Prototypes
- Field Trials
- Etc,

Obstacles and **Enablers (tolls)**

- Regulations
- Standards
- IP FTO
- etc

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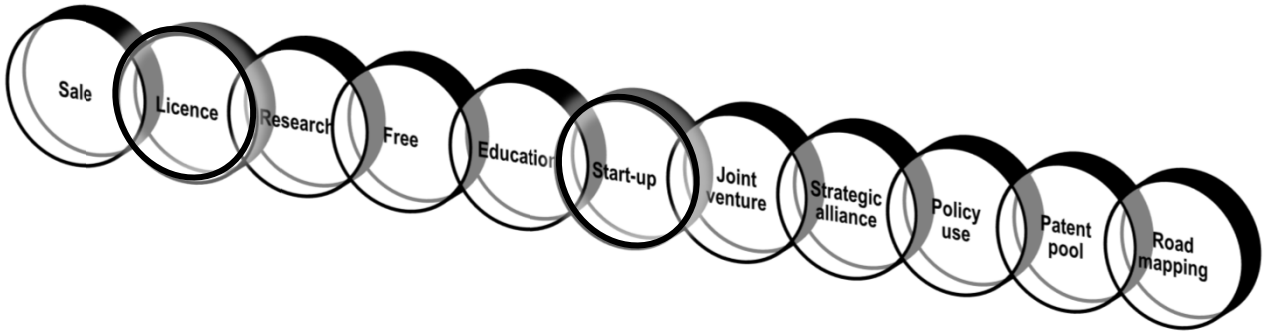
Providing Access to Intellectual Assets

Like physical property, knowledge is a **valuable asset** which can be **traded** – bought, sold or leased, given away free, used in JV's, as collateral, etc…

But, **many more ways of extracting value**…



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Licence or New Venture?

Licence	New Venture?
Licensee has expertise and resource	New Company must acquire expertise and resource
Can address different fields of use and geographical areas	Needs a critical mass of expertise and a committed and enthusiastic team
Established markets & suppliers	New markets for new suppliers
Evolutionary/incremental technology	Revolutionary or platform technology
The IP fits a gap in someone else's portfolio	Delivers a unique business advantage
Low financial commitment – less risk	Needs capital - more risk
Early returns – may grow over time	Returns take longer – but could be large

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Licensing (in general)

Granting right to use Granting the right to use the **protected IP** under agreed terms and conditions

- Field of use
- Geographic territory
- To validate not sell
- Subject to conditions

European IP Helpdesk Bulletin No.1 - IP Licensing

https://op.europa.eu/o/opportal-service/download-handler?identifier=3ae24438-9c73-11e9-9d01-01aa75ed71a1&format=pdf&language=en&productionSystem=cellar&part=

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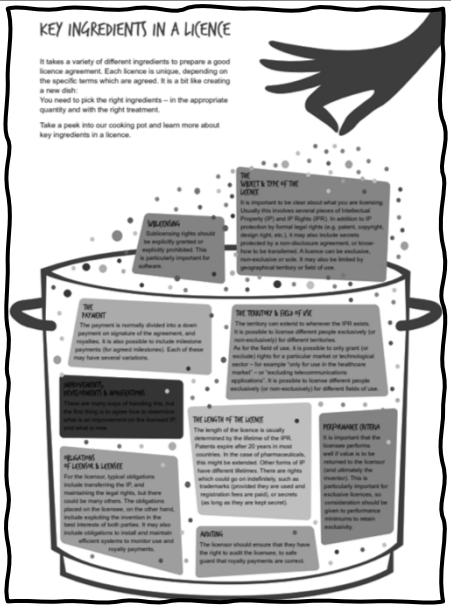
Every clause in a licence agreement is a negotiating point



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SOFTWARE LICENSING

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Software patent *OR/AND* Software copyright

Patent

What it <u>does</u> (regardless of how expressed)

(19) Europäisches Patentamt / European Patent Office / Office européen des brevets

(11) EP 2 097 841 B1

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and mention of the grant of the patent: 25.06.2014 Bulletin 2014/26

(51) Int Cl.: G06F 17/50 (2006.01)

(21) Application number: 07824443.1

(86) International application number: PCT/GB2007/004206

(22) Date of filing: 05.11.2007

(87) International publication number: WO 2008/053239 (08.05.2008 Gazette 2008/19)

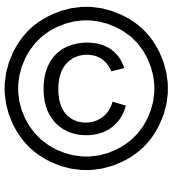
(54) POLYNOMIAL SYNTHESIS
POLYNOM-SYNTHESE
SYNTHÈSE POLYNOMIALE

(84) Designated Contracting States: AT BE BG CH CY CZ DE DK EE ES FI FR GB GR HU IE IS IT LI LT LU LV MC MT NL PL PT RO SE SI SK TR

• JABIR A M ET AL: "MODD: a new decision diagram and representation for multiple output binary functions" DESIGN, AUTOMATION AND TEST IN EUROPE CONFERENCE AND

Copyright

What it <u>is</u> (its expression)



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Licensing Source Code Copyright

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Licensing software - “closed” source

- For commercial reasons
  - Need to generate revenue stream and restrict copying
  - Need to control improvement and evolution
- Supplied as
  - Binary **(No access to source code)**
  - Service
- Terms
  - Rights to install and use (for certain uses)
  - **No modifications**
  - **Restricted (or prohibited) transfer**
- Usually Fee based
  - licensing fees
  - Service fees

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Licensing software – free of charge access to source

- To make market ready
  - Protected by other IPRs
  - **Need to control distribution for commercial reasons**
- Supplied as
  - Software code only
  - Maybe licence to access other IPR
  - With support
- Terms
  - Rights to install
  - Modifications permitted
  - restricted licensee (no transfer)
- Free of charge
  - Commercial use may require licence to other IP Rights

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Licensing software - Open Source

- **Fundamental concept**
  - Access to **source code**
  - **Freedom** to use, install, copy, modify **and redistribute (but not unconditionally!)**
- **Just another type of licence!**
  - Many different versions (~70) and variations (~1500) **So check and choose carefully**
  - Beware clauses which affect commercial use
- **Good for**
  - building community of developers and users
  - **Needs management** how will it be funded?
  - How will it be **sustainable?**

Choose **only if appropriate** and can be **justified** ⇨ **not "policy" or "ideology" decision**

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Two main types of Open Source licence

Permissive Licences (e.g. MIT, Apache, BSD…)	Copyleft Licences (e.g. GPL, MPL, EUPL…)
• Do not control how modified code is licensed • Modifications can be released under any licence, open source or not • Must include attribution, permission and copyright notices	• Additional conditions about derivative works • Same rights included in derivative works (**Strong**) - GPL • No restrictions on derivative works, but original code must have same rights (**Weak**) – EUPL, LGPL, MPL

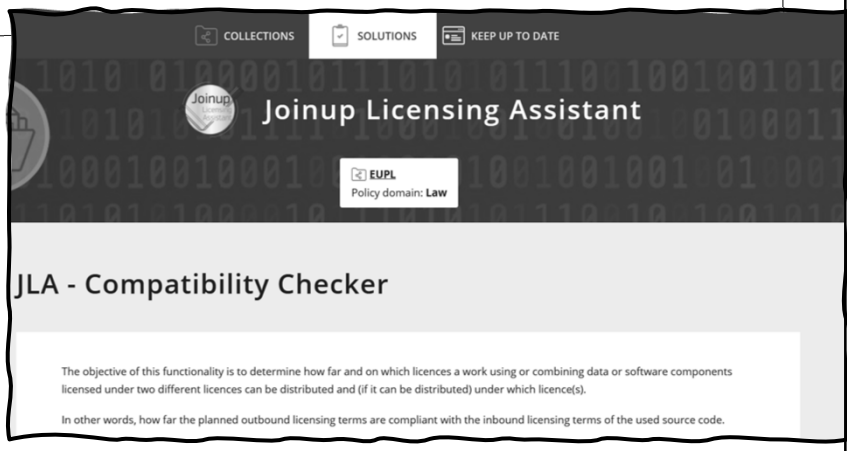
JLA - Compatibility Checker

How compatible are:

the (planned) outbound licensing terms

with the

inbound licensing terms



https://joinup.ec.europa.eu/collection/eupl/solution/joinup-licensing-assistant/jla-compatibility-checker

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THE END OF THE COLLABORATION (IS NOT THE END OF THE IP!)

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Agree what happens after the collaboration ends

- **Terms** of access and use of IP **post-collaboration**
- **Ongoing management of jointly owned IP** and its **protection**
- Who will **manage** and **monitor existing licences**, and **derivative works** including auditing
- How will **infringement and litigation** be managed?

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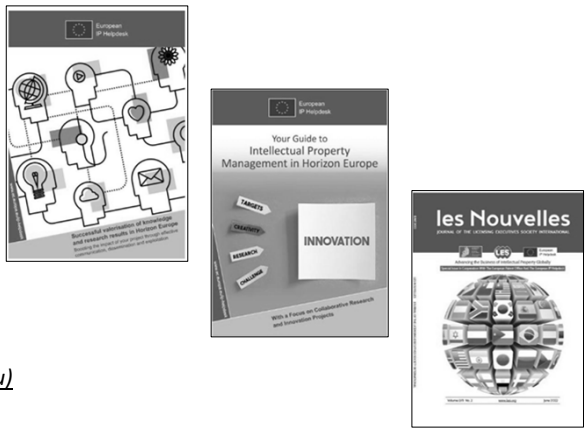
More Help…

"Knowledge Valorisation in R&I Collaborations" Thematic Package from IP Helpdesk

- **Successful Valorisation of Knowledge and Research Results in Horizon Europe**
- **Your Guide to Intellectual Property Management in Horizon Europe**
- **Article: Leveraging Innovation Through Collaboration - IP Challenges And Opportunities For SMEs In The Context Of EU-Funded Collaborative Research Projects**



Knowledge Valorisation in R&I Collaborations (europa.eu)

More Help…

Horizon IP Scan
First-line IP Support Service

- Tailored and free-of-charge
- For start-ups and other SMEs involved in EU-funded collaborative projects
- To show how to protect existing IP when starting a collaboration with multiple partners
- To assist in developing individual and shared strategies to manage and exploit the IP generated during the project

Recorded Horizon IP Scan Info Session at: *https://register.gotowebinar.com/recording/6376832519718074720*

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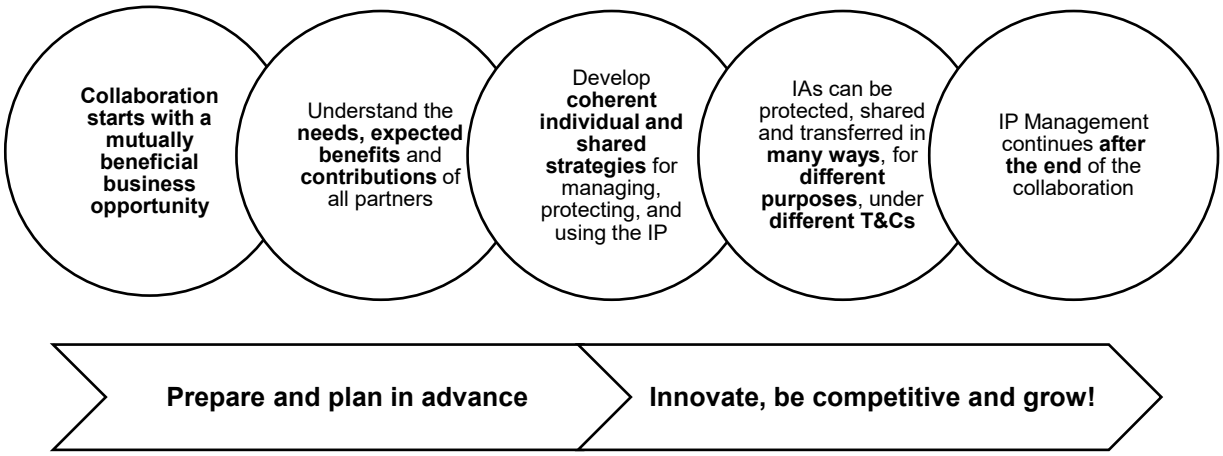
Summary



Presentation produced by Dr. Eugene Sweeney, Iambic Innovation Ltd. April 2023

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