



European IP Helpdesk

Stay ahead of the innovation game.

**Webinar: IP Commercialization and
Licensing - Advanced**

16.06.2021





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: 47 ambassadors from 28 EU countries





Helpline



- Free-of-charge, first-line IP support
- Personal and “to the point”
- Answer within 3 working days
- Email, phone and web
- In: English, Spanish, French, German, Italian and Polish
- Confidential





Communication Formats & Outreach Tools

Home Services Regional helpdesks IP management and resources News & Events About

European Commission > IP Helpdesk

Intellectual Property Helpdesk

View published New draft History Translate Unpublish

China Europe India

EU INDUSTRY DAYS 2021 20 October 2021 #EUIndustryDays

Website

Publications

I. Trademark Basics

What is a trademark? A trademark is any sign capable of distinguishing the goods and services of one company from those of its competitors.

By sign, we understand letters, words, numbers, colours, drawings or a combination of these. Please take into account that the list of signs that can constitute a trademark may vary from country to country and is, usually, non-exclusive.

Abstract concepts and ideas or general characteristics of goods, are not specific enough to qualify as signs.

In order to be registrable as a trademark, the sign must meet the following requirements:

Distinguishing character: The services from the areas affected by trademarks to be "non-descriptive" is immediately perceived as a trademark.

Capable of representation: "capable of registration" and Intellectual Property Office (EUIPO) appropriate form using general Register in a clear, precise, and both the consumers and the public can determine the scope of protection of the trademark.

The EUIPO does not admit abstract, letter and logo marks for registration because the current class of trademarks does not allow for a clear and durable way of representing such a mark.

Different types of marks

Individual mark: This is the most "generic" kind of trademark that indicates the commercial origin of the protected goods and/or services.

Collective mark: This refers to a mark that indicates that the goods or services produced by that mark originate from members of an association, rather than from just one company. Collective marks may be used together with the individual mark of the producer of a given good.

KEY INGREDIENTS IN A PATENT

It takes a variety of different ingredients to prepare a good business agreement. Each business is unique, depending on the specific needs which are agreed. It is all the ingredients that make up the agreement.

You need to pick the right ingredients... in the appropriate quantity and with the right treatment.

See a peek into our cooking pot and learn more about key ingredients in a business.

Getting Started!

A brief introduction to Intellectual Property Strategy

Being in a new business environment, you need to know what you are doing. This is a guide to help you understand the basics of Intellectual Property (IP) and how it can help you succeed in your business.

The European IP Helpdesk is managed by the European Commission's Executive Agency for Small and Medium-sized Enterprises (EASME), with policy guidelines 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 EASME or the European Commission. Neither EASME nor the European Commission are liable for any damage, as well as for the consequences of its use.

Training

Importance of IP for SMEs

20 April 2021

Your Guide to IP Management in International Business

STAY AHEAD OF THE INNOVATION GAME

Audio-visual Content

European IP Helpdesk

199 Abonnenten

ÜBERSICHT VIDEOS PLAKATE KANÄLE KANALINFO

IP Valuation

711 Aufrufe vor 1 Jahr

Knowing your intellectual property's value is essential for your business, for example, when merging with another company, selling or licensing intellectual property rights, attracting investors or for accounting and taxation purposes.

Watch our animated clip to learn more about IP valuation.

Eigene Playlists

Presentations & Interviews ANIMATED CLIPS

KOMPLETTE PLAYLIST ANZEIGEN KOMPLETTE PLAYLIST ANZEIGEN

Social Media

LinkedIn

European IP Helpdesk

Stay Ahead of the Innovation Game

Einzelnen anzeigen

Ebenfalls angesehen

- Clara Fentich - Senior Project Manager bei EUIPO, Gießen
- J. Stasch - als ein Berater für IP experts - in Site English poor reports de la "re... (Industrie) für IP Experts
- Stefan Geller - CEO bei BRANDTage GmbH
- Ledy Novak - IP Manager bei EUIPO, Karlsruhe
- China IP Helpdesk - Providing Support for European SMEs in China (IP Helpdesk)
- DARSA TATAI, Ph.D. - Founder & CEO, WEI Digital Center (I.T. Author, advisor, speaker on strategic growth, networking & innovation)
- Ejlen Jürgens - Patent Strategist / Enterprise Europe Network (EEN) IP Helpdesk, Antwerpen
- Enterprise Europe Network - Business Support Network



Europe - Upcoming events

16
JUN

2021

TRAINING AND WORKSHOPS

EU - Webinar: IP Commercialisation & Licensing - Advanced

 Live streaming available

23
JUN

2021

TRAINING AND WORKSHOPS

EU - Webinar: Effective IP and outreach strategies to help increase the impact of research and innovation

 Live streaming available

29-30
JUN

2021

EXHIBITIONS


Export Tag 2021

18
JUN

2021

TRAINING AND WORKSHOPS

EU|BIC Training Track: Intellectual Property Rights

 Live streaming available

30
JUN

2021

TRAINING AND WORKSHOPS

EU - Webinar: Impact and Innovation in EU funded projects - A guide for proposers


 Live streaming available

07
JUL

2021

TRAINING AND WORKSHOPS

EU - Webinar: Maximizing the Impact of Horizon 2020 project results

 Live streaming available





Training modules with a Horizon (2020/ Europe) focus

1. IP Management in Horizon – the basics
2. Consortium Agreements
3. Impact and Innovation in Horizon
4. IP Management in Horizon with a specific focus on MSCA activities
5. Effective IP & Outreach strategies to support the „Pathway to Impact“
6. Maximise the impact of Horizon project results
7. IP Management in Horizon projects in specific fields of technology: ICT, Life Sciences, Food, Cultural Heritage,...
8. Freedom-To-Operate within the context of Horizon
9. Complementary topics: Technology Transfer, Patent Search, IP Commercialisation, Licensing,..



Training cooperation 2021



1st part of the year

1. [9th of March 2021 - Introduction to PVR](#)
2. [26th of May 2021 - IP rights in Agri-food Sector Part I: a Guide to Geographical Indications, Trademarks, Patents & Plant Variety Denominations](#)
3. [8th of June 2021 - New ways to create plants and the challenges of their IP protection](#)

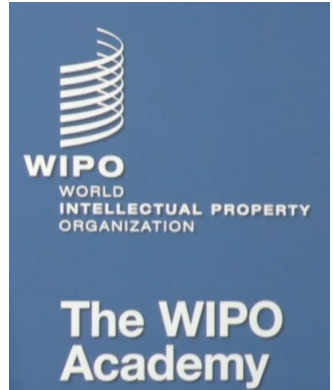
2nd part of the year

4. 16th of September 2021 - Research and development projects
5. 28th of September 2021 - IP rights in Agri-food Sector Part II: conflicts and synergies among Geographical Indications, Trademarks, Patents & Plant Variety Denominations
6. 21st of October 2021 - “Growers’ Guide to Intellectual Property Protection for Plants”
7. 02nd of November 2021 - Enforcement
8. 23rd of November 2021 - Quality Audit Service (QAS)



SME innovation support services!

1. [European IP Helpdesk Ambassadors and EEN](#)
2. [EUIPO learning portal](#)
3. [WIPO Academy](#)
4. [The Ideas Powered for business SME Fund](#)
5. [IPA4SME](#)
6. [Horizon IP Scan](#)
7. [\(IP Booster\)](#)
8. [Horizon Results Booster](#)
9. [Leadership4SMEs](#)
10. [EPO Academy](#)
11. [4IPCouncil](#)





Ambassador Scheme

- **Cooperation scheme** with the Enterprise Europe Network (EEN)
- **Building IP capacities** among European SMEs
- **Overcoming language barriers**
- **Publications** are made available in other languages than English
- Making the topic **more accessible**
- Exchange and feedback from ambassadors on **needs of SMEs**
- Local **awareness** and **training events**



Webtools | Leaflet | © OpenStreetMap contributors | Disclaimer

Ambassadors team

Currently, we have 47 ambassadors from 28 European countries:

Get in touch with our European IP Helpdesk Ambassador coordination team by sending an email at: ambassadors@iphelpdesk.eu



European IP Helpdesk | LATIN AMERICA IP SME HELPDESK | INDIA IP SME HELPDESK | CHINA IP SME HELPDESK | SOUTH-EAST ASIA IP SME HELPDESK

My role as Ambassador – connecting people

Easy and informed first-line support	IP and Tech Transfer (Head of TLO at INESC TEC)	Network (European IP Helpdesk + EEN + ASTP)	<i>I have always a friend that can help you</i>
Value-driven innovation	Economics and Management (Professor at University of Porto)	Science and R&D (PhD in Biomedical Sciences + MSc in Biotechnology)	Understand the need and problems

EU INDUSTRY WEEK 2021 #EUIndustryWeek



STAY AHEAD OF THE INNOVATION GAME



Recording

Please note that the whole presentation, including the Q&A session, is recorded. The presentation will be sent to you after the webinar.





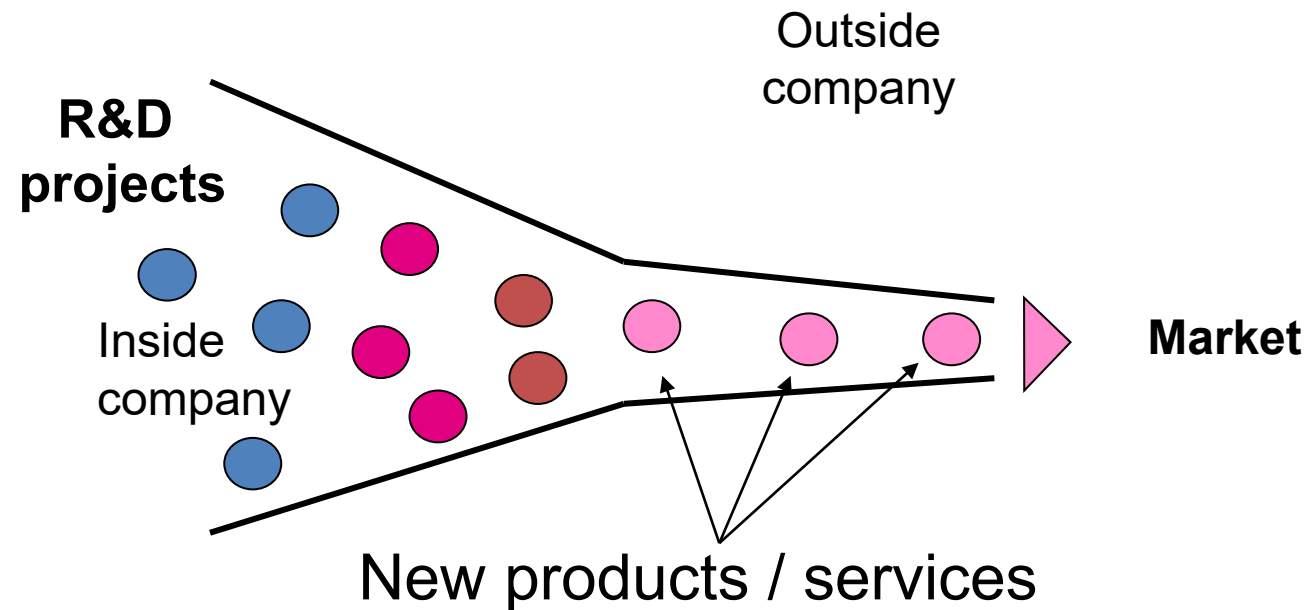
Overview

- Basics of licensing (recap)
- Key terms
- Negotiation





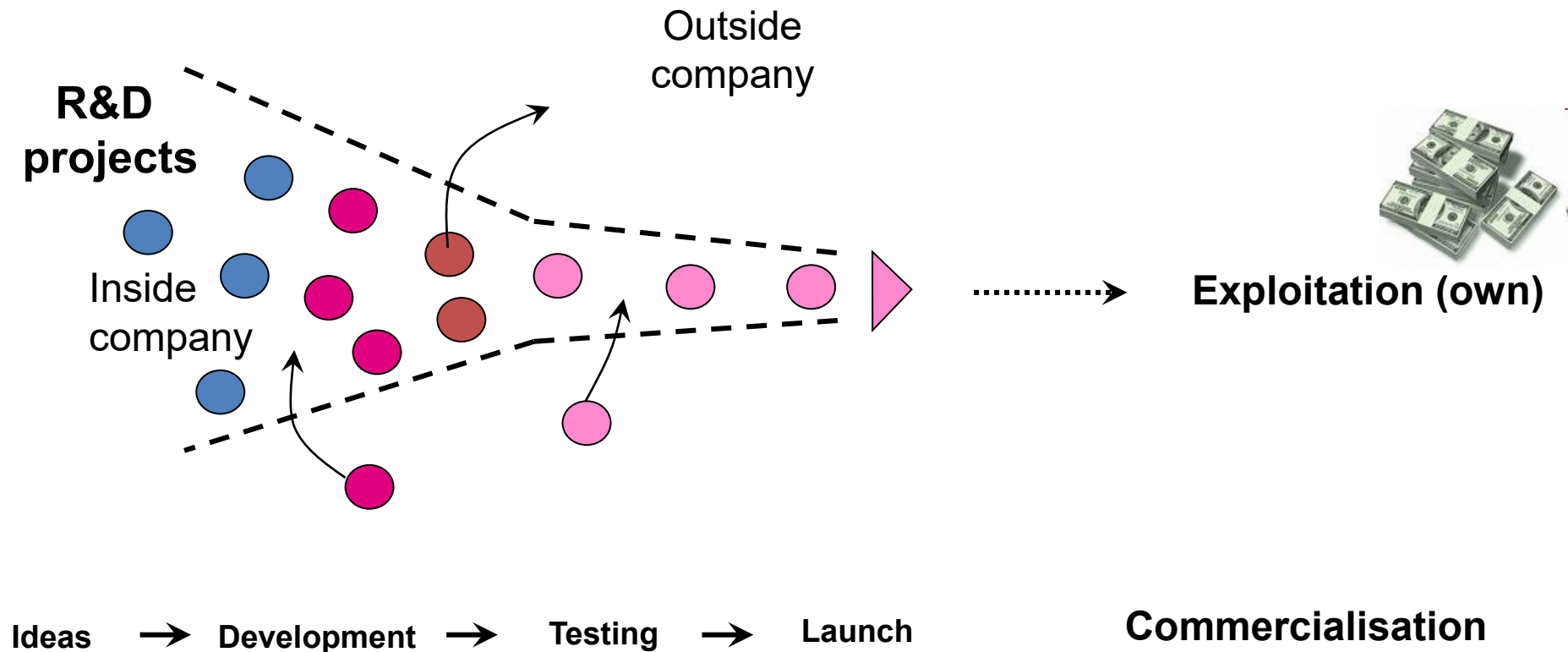
Closed Innovation



Ideas → Development → Testing → Launch

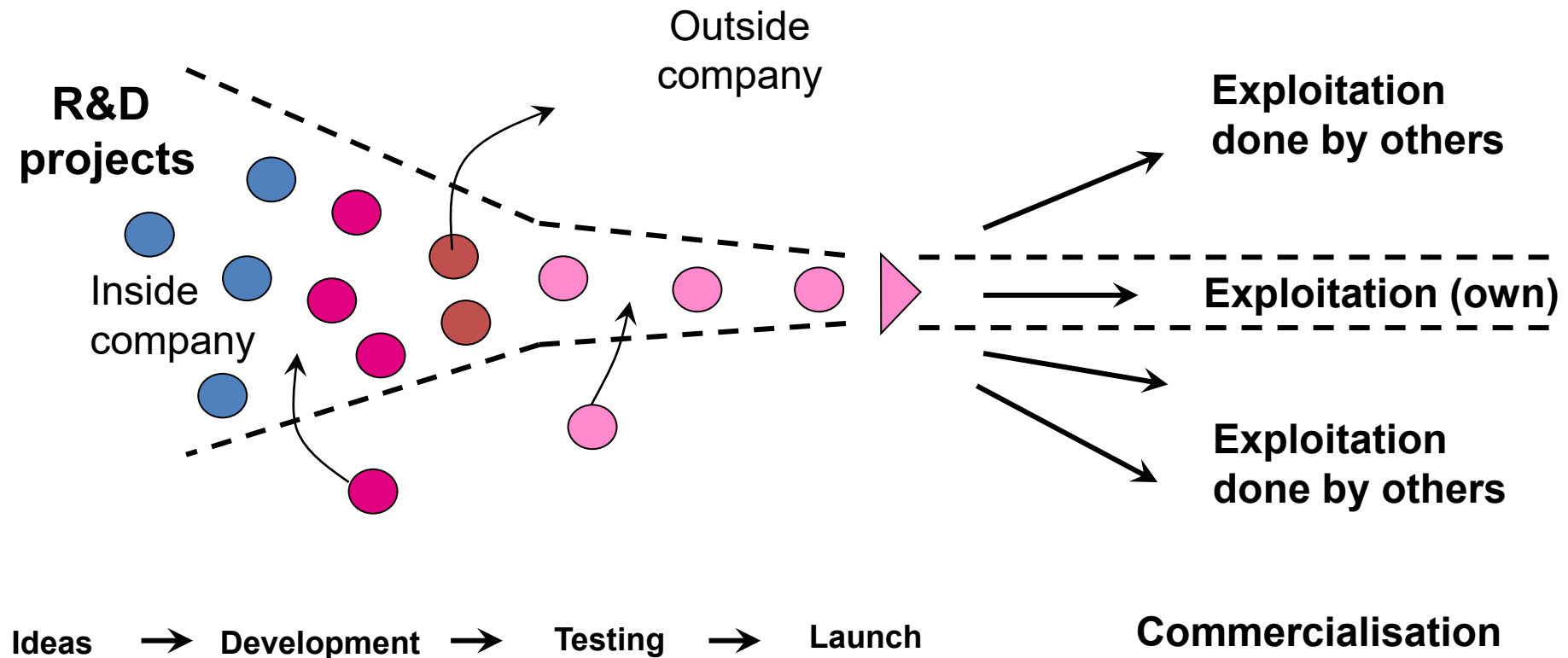


Open Innovation



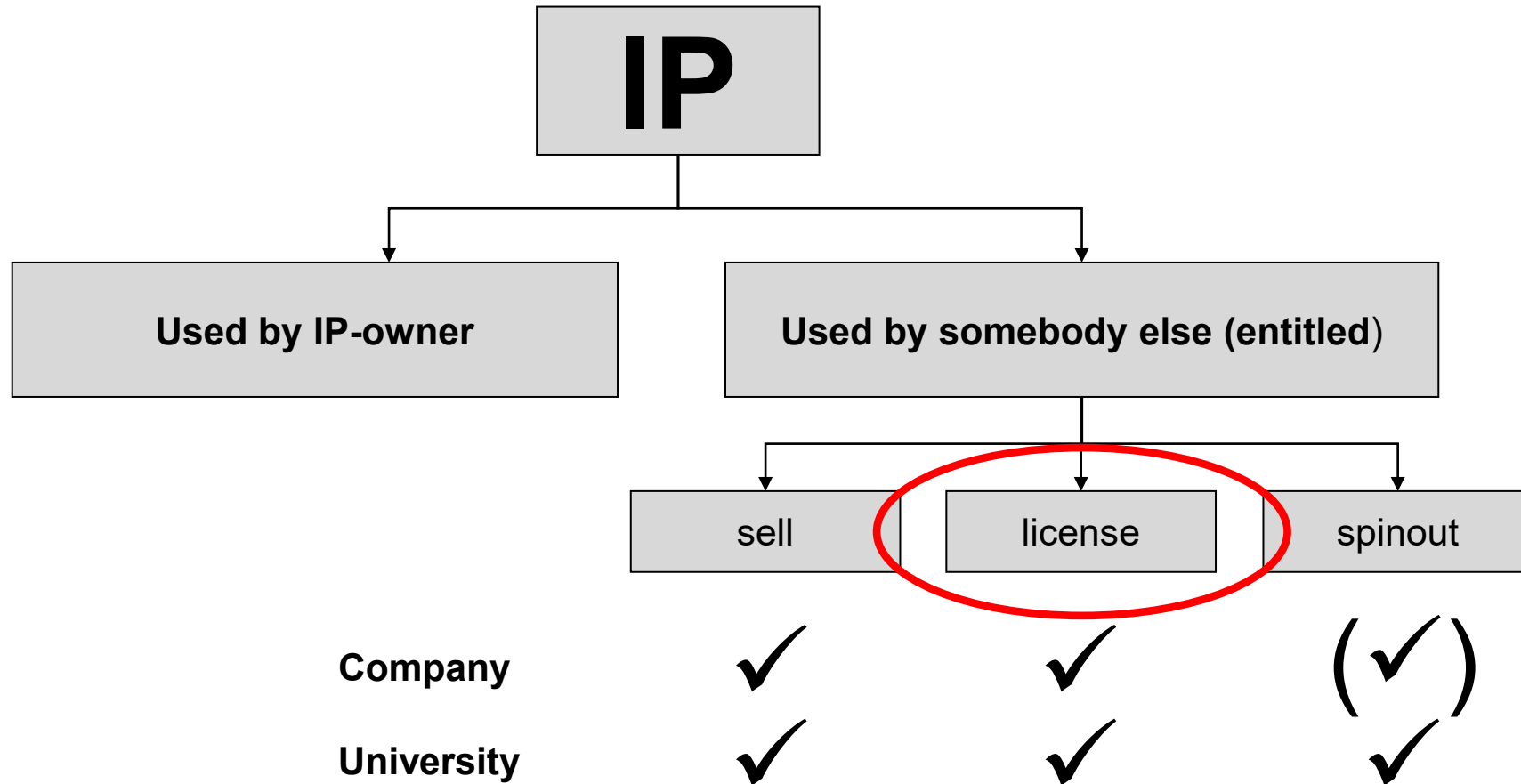


Open Innovation





IP Commercialisation



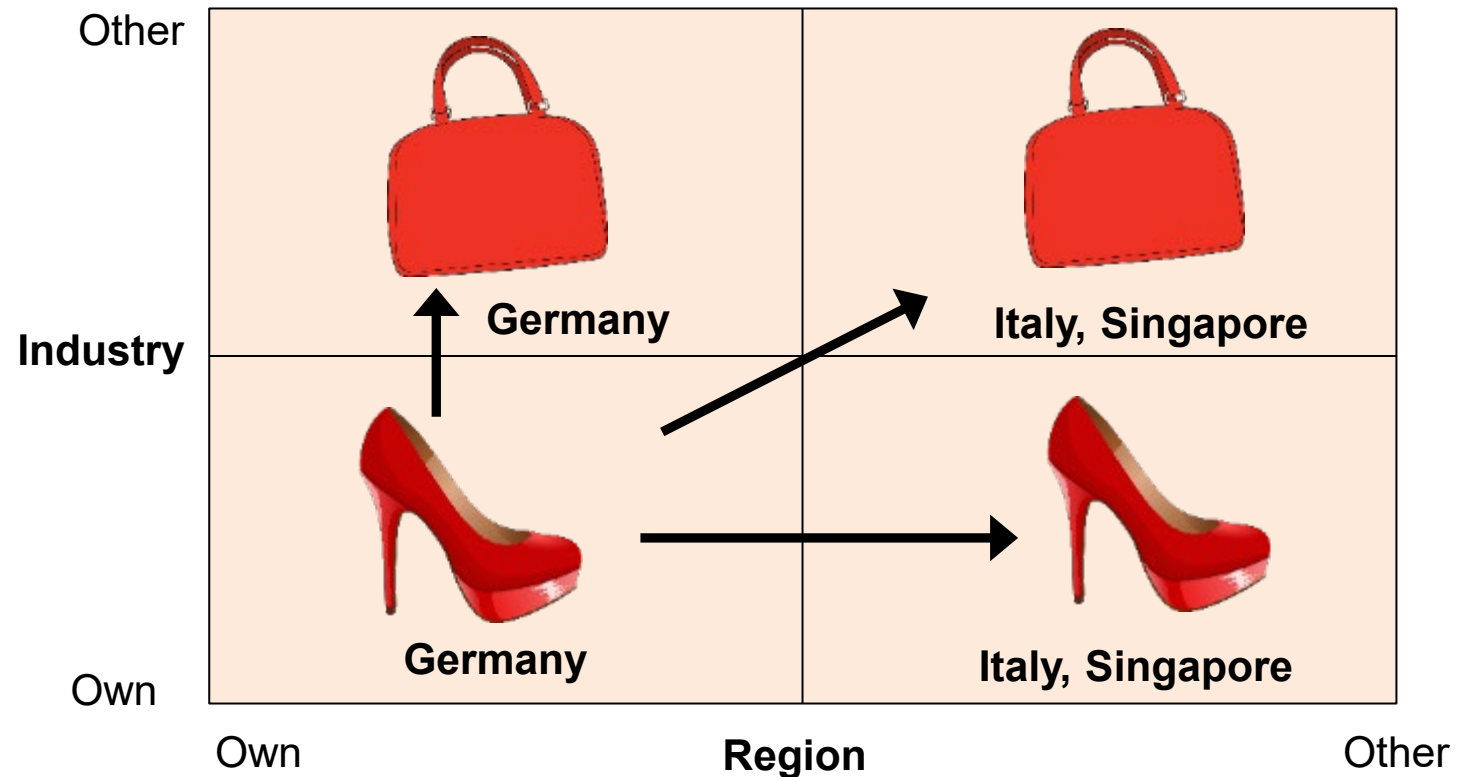


When does external commercialisation make sense?

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



Some reasons for external commercialisation – new markets





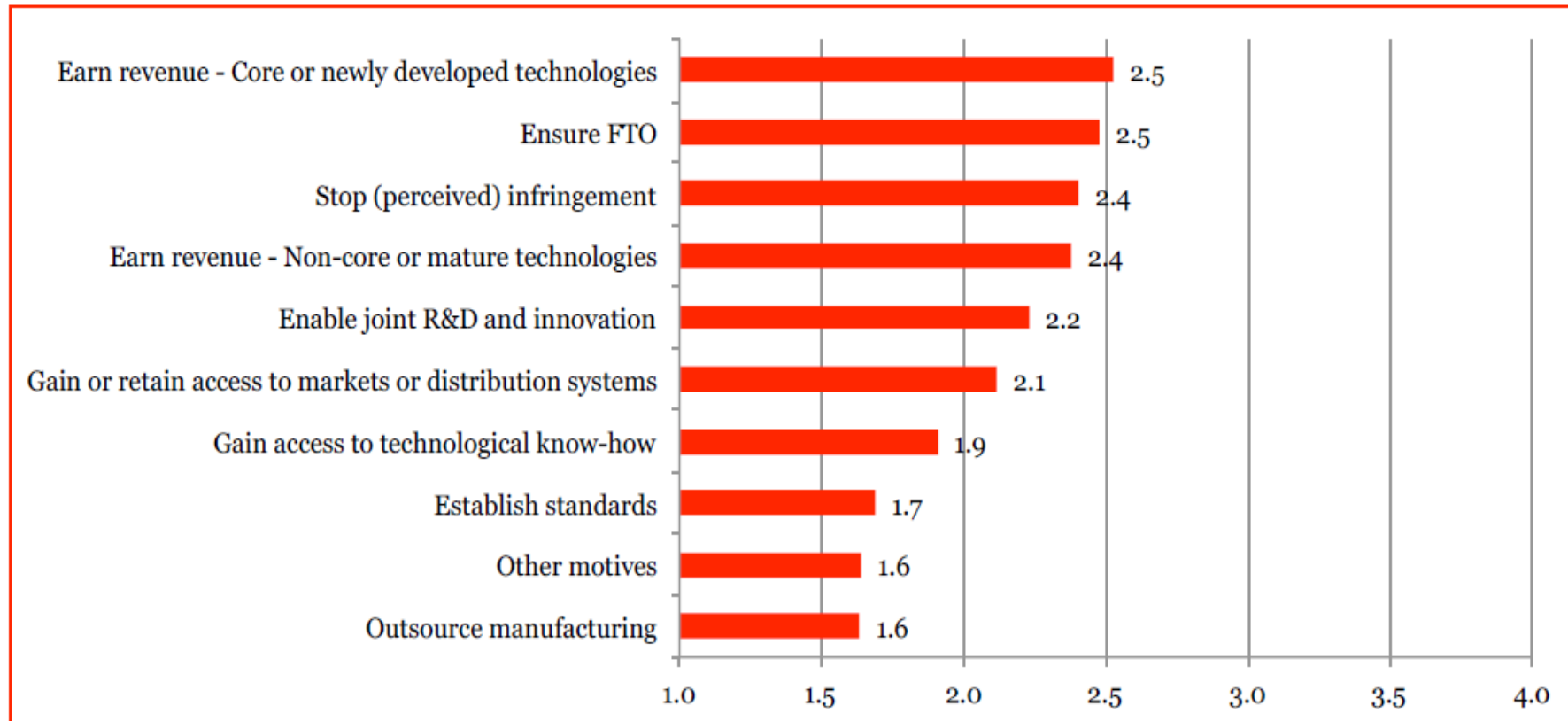
Some more reasons for licensing

- 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

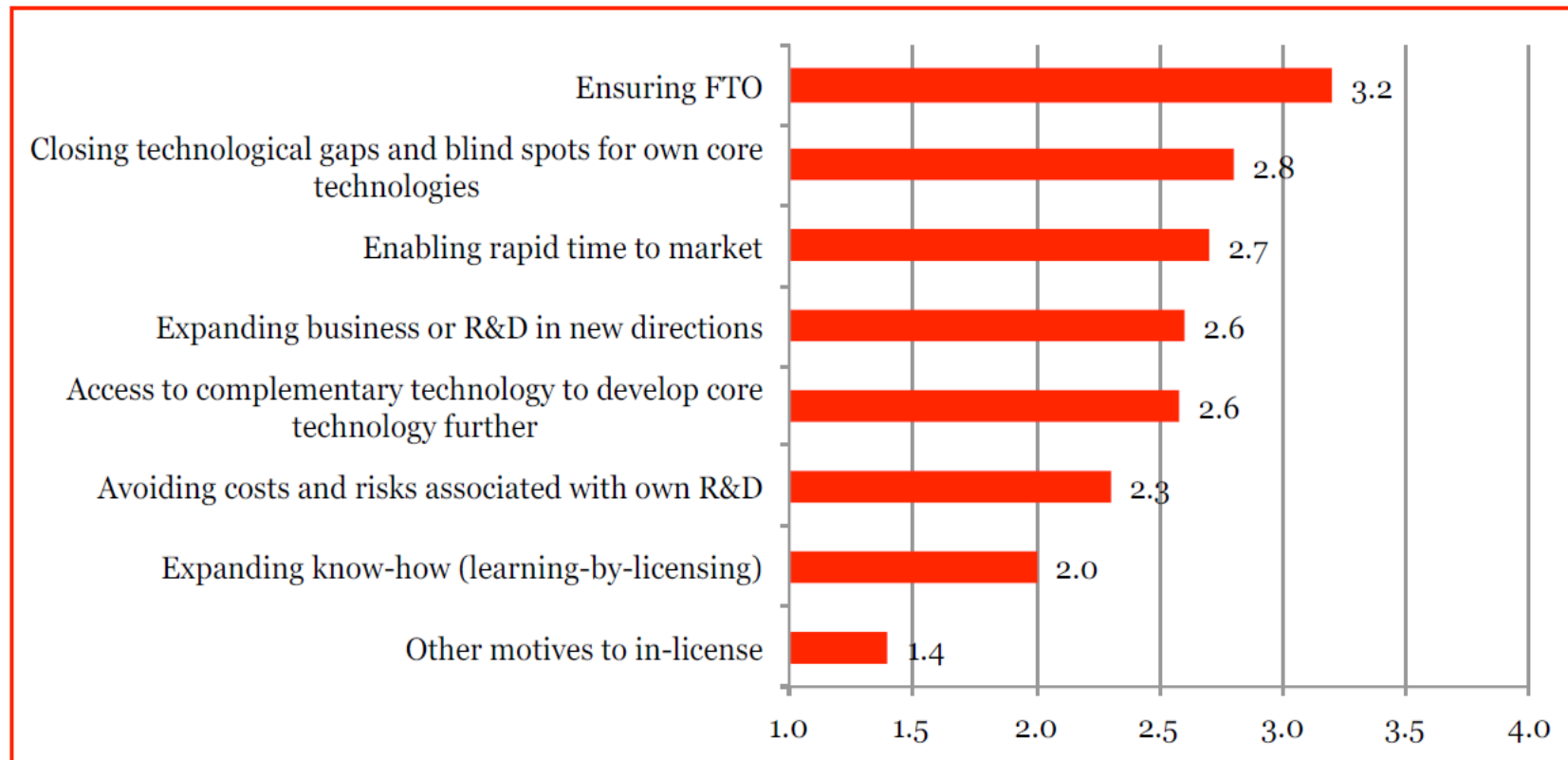


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



Motives for 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



An IP license

- Indirect exploitation of intellectual property (commercialisation)
- 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



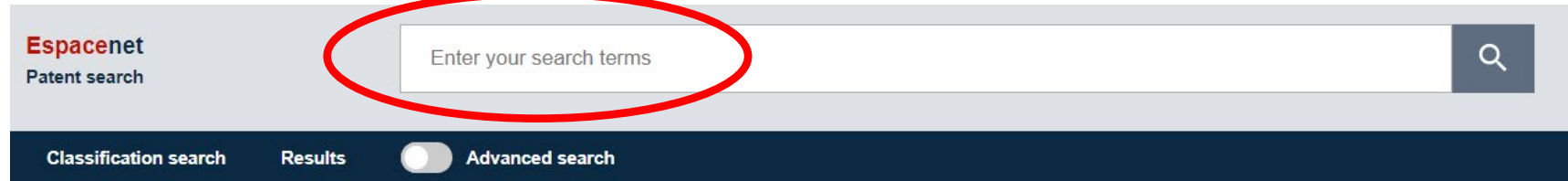
Before the negotiation: Due Diligence

- Information regarding the licensor (licensee)
- Information regarding the technology and its context (eg. business environment)
- Information regarding the legal status of rights (eg. ownership, validity, territorial coverage)
- (NDA)

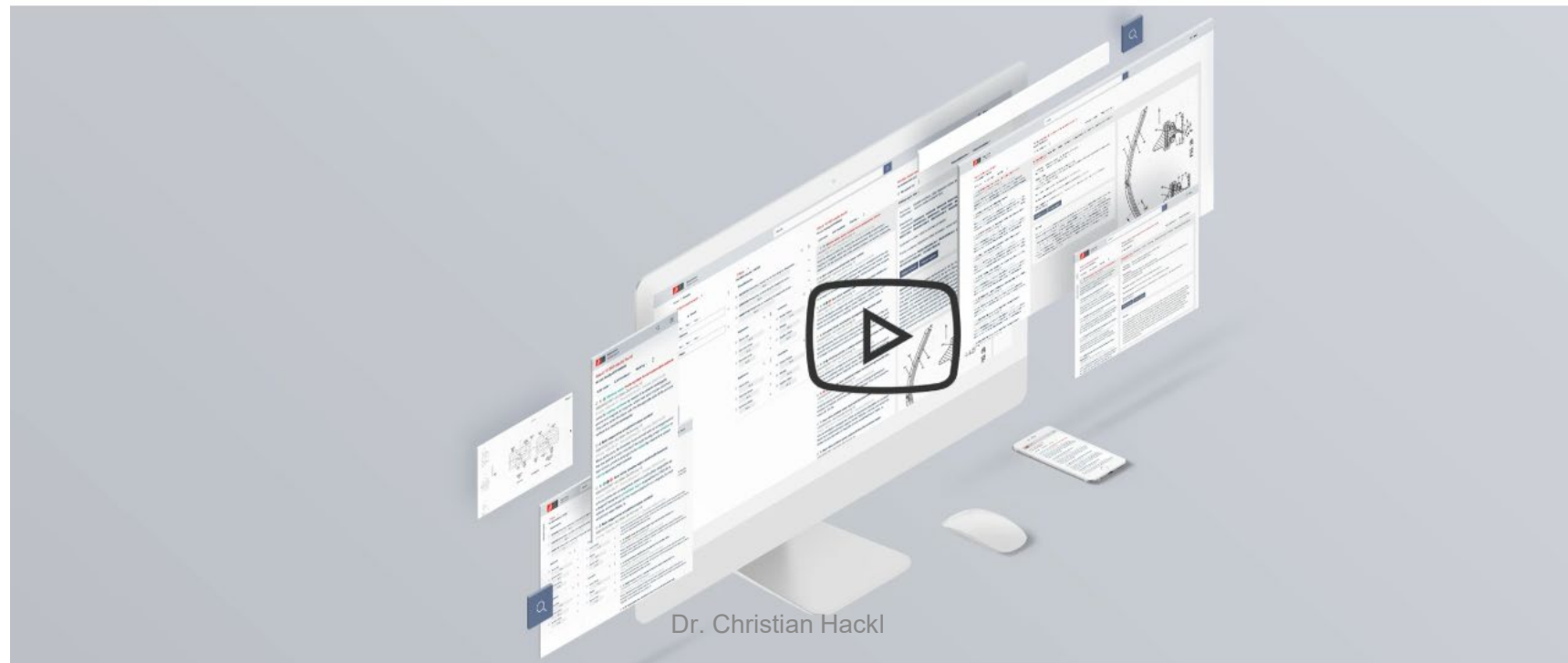


The Espacenet database (over 110 million docs)

www.espacenet.com



Espacenet: free access to over 110 million patent documents





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

2. Grant

- Scope
- Territory
- Exclusivity



License agreement – Overview II

3. Financials

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

4. Further topics

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



1. Definitions / subject

- Purpose
 - “Introduction”, background, goals
 - Helpful for persons not involved in the making
- The parties (licensor and licensee)
 - Details (name, address, legal form)
- Definition of terms
 - Terms used throughout the agreement (eg. “sales”)
- Technology/IP
 - List of technology / patent(s) (IPRs)
- Ownership
 - Does the licensor own the IP?

New training: „Licensing -
Advanced“



2. Grant

- **Scope**
 - Fields of use (eg. research and/or make, use, sell, import, modify)
 - Right to sublicense
- **Territory**
 - Specific countries (depending on protection)
- **Exclusivity**
 - Exclusive license
 - Sole license
 - Non-exclusive license

Business needs

In combination with limitations (time, numbers...)



3. Financials

- Upfront payment
 - One-time payment (early on)
- Ongoing payments
 - Royalties (x% of y)
- Milestone payments
 - For special achievements, reflecting increased value (eg. pharma, patent granted)
- Minimum / adjustments
 - Minimum amount of license fee
 - Adjustment of royalties over time (up or down)
 - Patent expenses (historic and ongoing)

Sharing risk and
benefits



4. Further topics I

- Improvements
 - Rights to future improvements included?
 - Additional payments?
 - Timing of access?
- Know-how and training
 - Definition and extent
 - Included in license (additional payments)?
- Confidentiality
- Reporting and audits
 - What kind of reporting when?
 - Rights for audits?



4. Further topics II

- Warranties and liabilities
 - Define what risks both parties are willing to take
 - Eg. licensor guarantees that he is owner of IP, no previous license (tested technology?)
 - Licensor wants to be indemnified by licensee (eg. loss, damage, hurt)
- IP protection and infringement
 - Definition of responsibility – transfer of control
 - Eg. depending on exclusive versus nonexclusive license
 - Cost (outcome)



4. Further topics III

- Term and termination
 - For life span of patent or certain time (renewal option)
 - In combination with other parameter (eg. exclusivity)
 - Reasons for termination by licensee or licensor (typically more restricted, eg. licensee fails to pay license fees, going bankrupt, not reaching milestones)
 - Any obligations surviving the end of the agreement (eg. confidentiality)



Licensing agreement

- A strategic choice
- A long standing relationship
- Combination and interdependency of different aspects
 - Legal
 - Technical
 - Financial



Negotiating licensing agreements

- Confidentiality agreement
- Be sufficiently prepared to negotiate, eg.
 - Business needs
 - Negotiation strategy (goal, compromise and must-have)
 - Think about other party
- Explain your position, seek “objective” criteria
- Search for a win-win agreement
- Discuss the agreement as a whole
- Time is always important



Helpful tool: Term Sheet

- Summary of key terms agreed on (so far)
- Helps to keep an overview
- Helps to focus on main issues (and not missing any)
- Use plain language
- Not a LoI (Letter of Intent) or MoU (Memorandum of Understanding)
- Optional: internal version for
 - planning (goals and fall-back options)
 - communicating within your team (or with legal counsel)



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

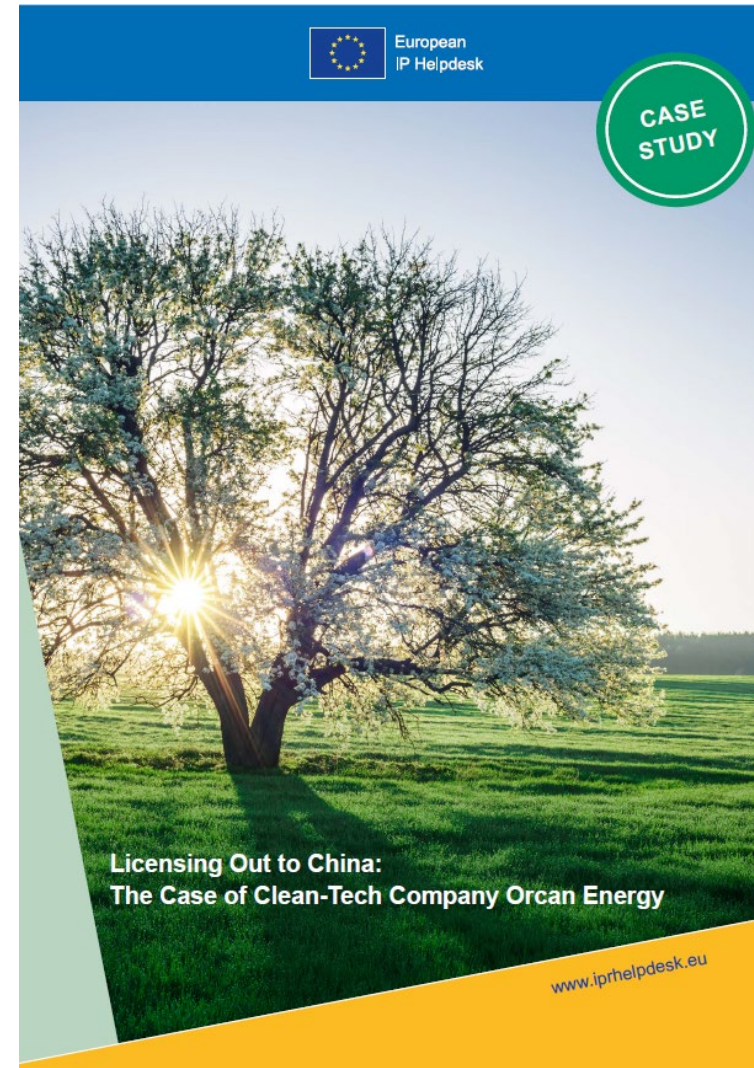
A renewable energy company founded in 2008, Orcan Energy offers standard components for heat power generators that recycle waste heat by turning it into electricity, using the Organic Rankine Cycle (ORC), a process similar to that used in steam engines. Having started as a spin-off from the Technical 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.





Case study II: Orcan Energy

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





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