

**IP in Business Collaborations for SMEs and Start-ups**  
**European IP Helpdesk Webinar**  
**22 November 2022**



European  
IP Helpdesk

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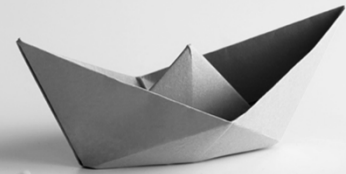
## European IP Helpdesk

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

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22 November 2022



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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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# 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



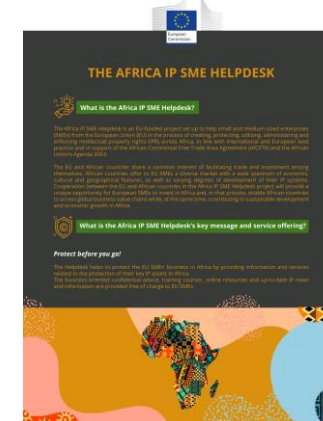
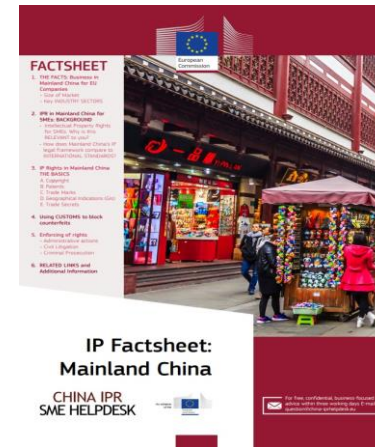
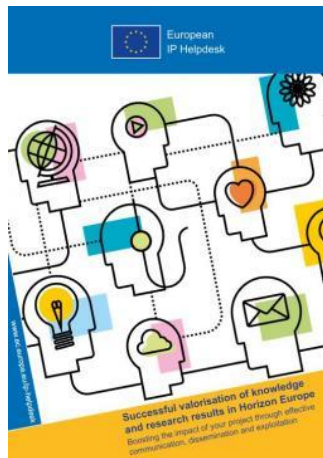


# The EC IP Helpdesks





# EC IP (SME) Helpdesk Hub – Gateway to Information



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

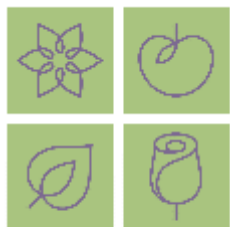


# Training cooperation with the Community Plant Variety Office and CIOPORA



**CPVO**

Community Plant Variety Office



CIOPORA

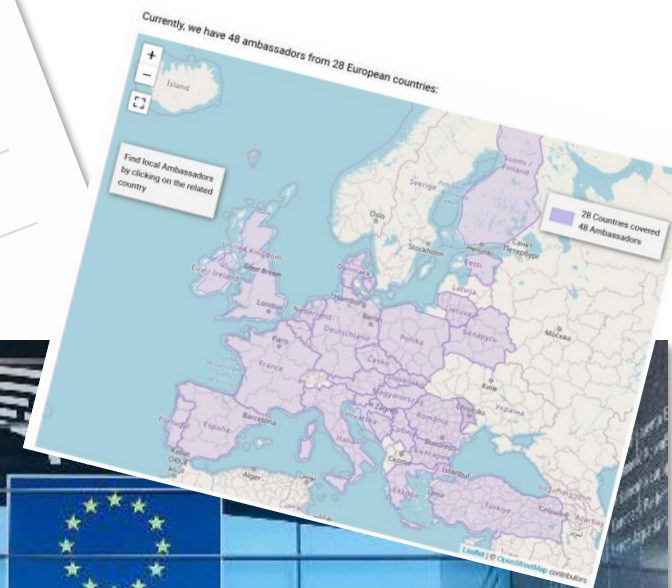
- 17 FEB 2022** TRAINING AND WORKSHOPS  
**EU - Webinar & CPVO coop: The essential role of Quality Auditing examination offices for EU Plant Variety Rights**  
 Live streaming available
- 12 APR 2022** TRAINING AND WORKSHOPS  
**EU - Webinar CPVO Coop: Constraints and opportunities for edited varieties. Is the GMO legal framework impacting the creation of new plants?**  
 Live streaming available
- 21 JUN 2022** TRAINING AND WORKSHOPS  
**EU Webinar - CPVO Coop Webinar: Introduction to Community plant variety rights: creation of new plants and their protection in the EU**  
 Live streaming available
- 08 SEP 2022** TRAINING AND WORKSHOPS  
**EU - Webinar CPVO Coop: The interface between plant variety rights and patents**  
 Live streaming available
- 28 SEP 2022** TRAINING AND WORKSHOPS  
**EU - Webinar & CIOPORA coop: Growers' Guide to Intellectual Property Protection for Plants**  
 Live streaming available
- 10 OCT 2022** TRAINING AND WORKSHOPS  
**EU - Webinar CPVO Coop: What's in a name: plant variety denominations and their interface with trademarks and geographical indications**  
 Live streaming available
- 02 NOV 2022** TRAINING AND WORKSHOPS  
**EU - Webinar CIOPORA coop: Enforcement practices for Plant Variety Rights in the EU**  
 Live streaming available
- 06 DEC 2022** TRAINING AND WORKSHOPS  
**EU - Webinar CPVO Coop: The impact of protected new plant varieties in the European Union market.**  
 Live streaming available





# 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**





# Further learning opportunities:

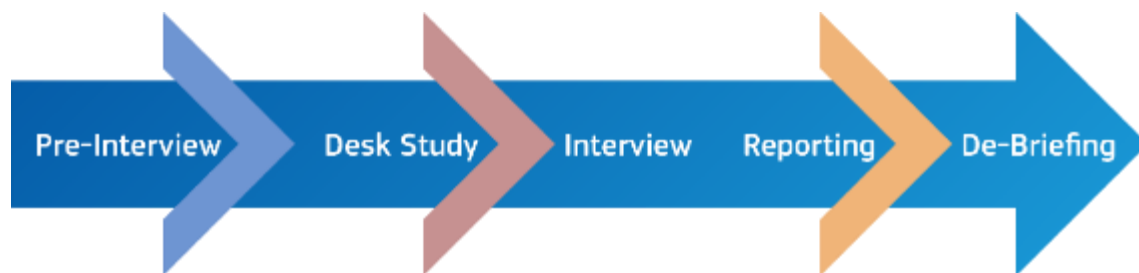
1. [European IP Helpdesk Ambassadors and EEN](#)
2. [EUIPO learning portal](#)
3. [EUIPO – Ideas Powered for business website](#)
4. [WIPO Academy / Diagnostics](#)
5. [The Ideas Powered for business SME Fund](#)
6. [IPA4SME](#)
7. [Horizon IP Scan](#)
8. [\(IP Booster\)](#)
9. [Horizon Results Booster](#)
10. [Leadership4SMEs](#)
11. [EPO Academy](#)
12. [4IPCouncil](#)





# Horizon IP Scan

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



**14**  
JUL  
2022

INFO DAYS  
**Horizon IP Scan - Info Session**

📺 Live streaming available

**17**  
AUG  
2022

INFO DAYS  
**Horizon IP Scan - Info Session**

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**14**  
SEP  
2022

INFO DAYS  
**Horizon IP Scan - Info Session**

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**11**  
OCT  
2022

INFO DAYS  
**Horizon IP Scan - Info Session**

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**14**  
NOV  
2022

INFO DAYS  
**Horizon IP Scan - Info Session**

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**14**  
DEC  
2022

INFO DAYS  
**Horizon IP Scan - Info Session**

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[www.horizon-ipscan.eu](http://www.horizon-ipscan.eu)





# Thank you!

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- [helpline@iprhelpdesk.eu](mailto:helpline@iprhelpdesk.eu)
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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

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## 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

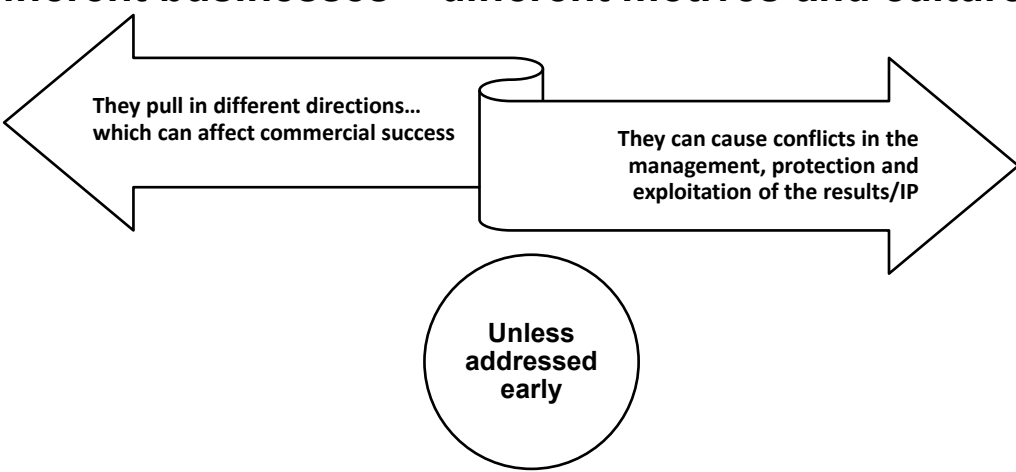
Agree strategies for managing, protecting and exploiting the IP

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## Different businesses = different motives and cultures




They pull in different directions... which can affect commercial success

They can cause conflicts in the management, protection and exploitation of the results/IP

Unless addressed early

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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	Some legal rights come into existence automatically
Copyright	Some need registration
Design Rights	Confidentiality Agreements (Know-how)
Database Rights	Secrets (Trade Secrets)
Trade marks	Time limited rights
Plant Breeders Rights	National rights
Utility Models/petty patents	
Plant varieties	
etc	

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## What is the deal?

<b>legal right to prevent</b> others using their creation (without agreement)	<b>In return for</b>	<b>disclosing details</b>
<b>commercial purposes</b> <u>(only)</u>		<b>so others can develop new innovations</b>
for a <b>limited period</b>		

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## Who benefits?

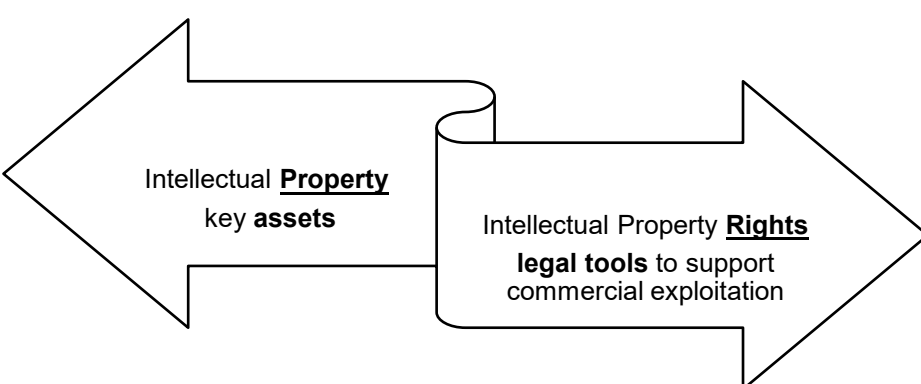
<b>The state</b> by avoiding secrecy	<ul style="list-style-type: none"><li>• Improves innovation capacity, stimulates innovation, enriches society</li></ul>
<b>The creator</b> by being able to prevent unauthorised commercial use	<ul style="list-style-type: none"><li>• Unless they come to an agreement (which may be financial)</li></ul>
<b>Investors</b> (time, money, facilities, etc) from the limited monopoly	<ul style="list-style-type: none"><li>• To get a return on investment</li></ul>

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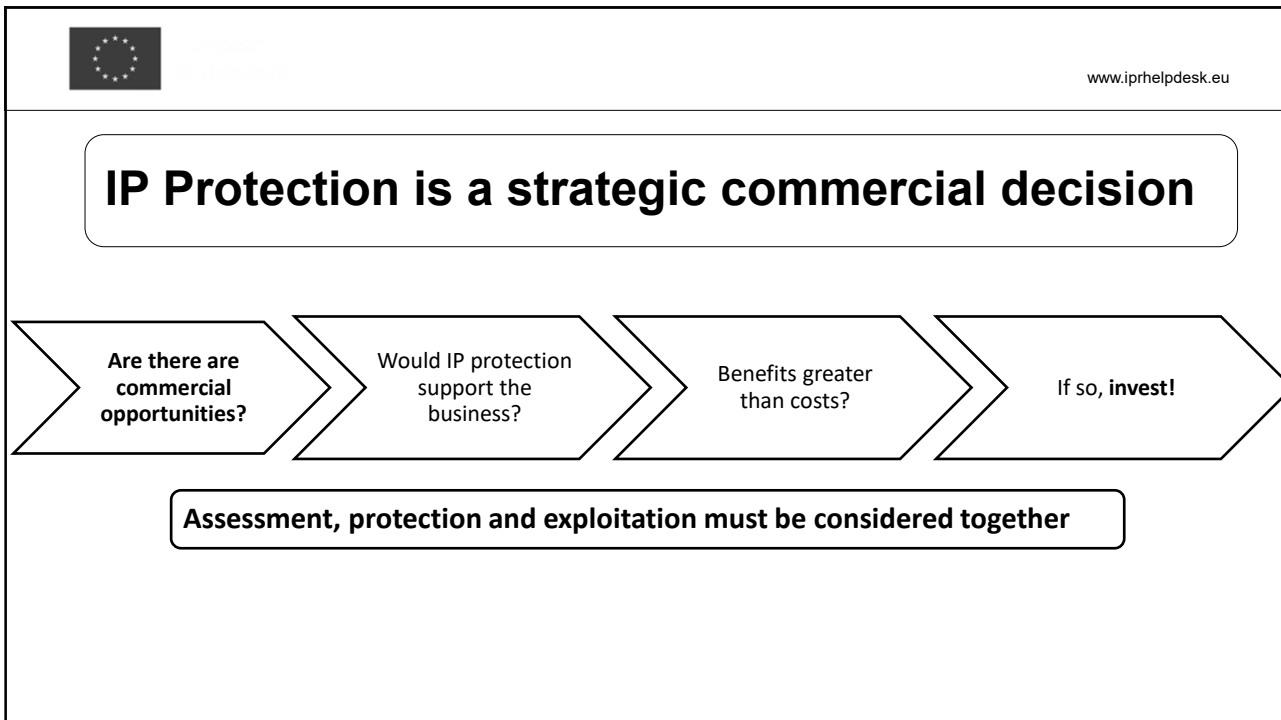
## Don't confuse IA, IP and IPR



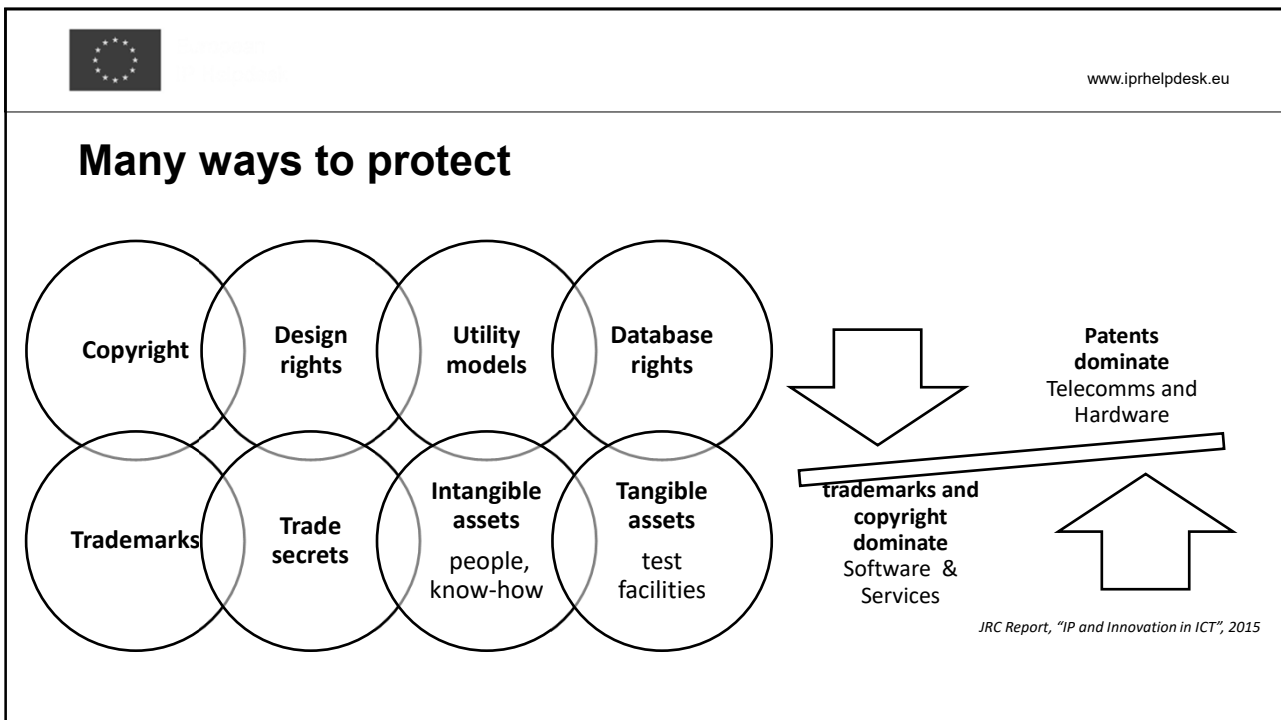
Intellectual **Property**  
key **assets**

Intellectual Property **Rights**  
**legal tools** to support  
commercial exploitation

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

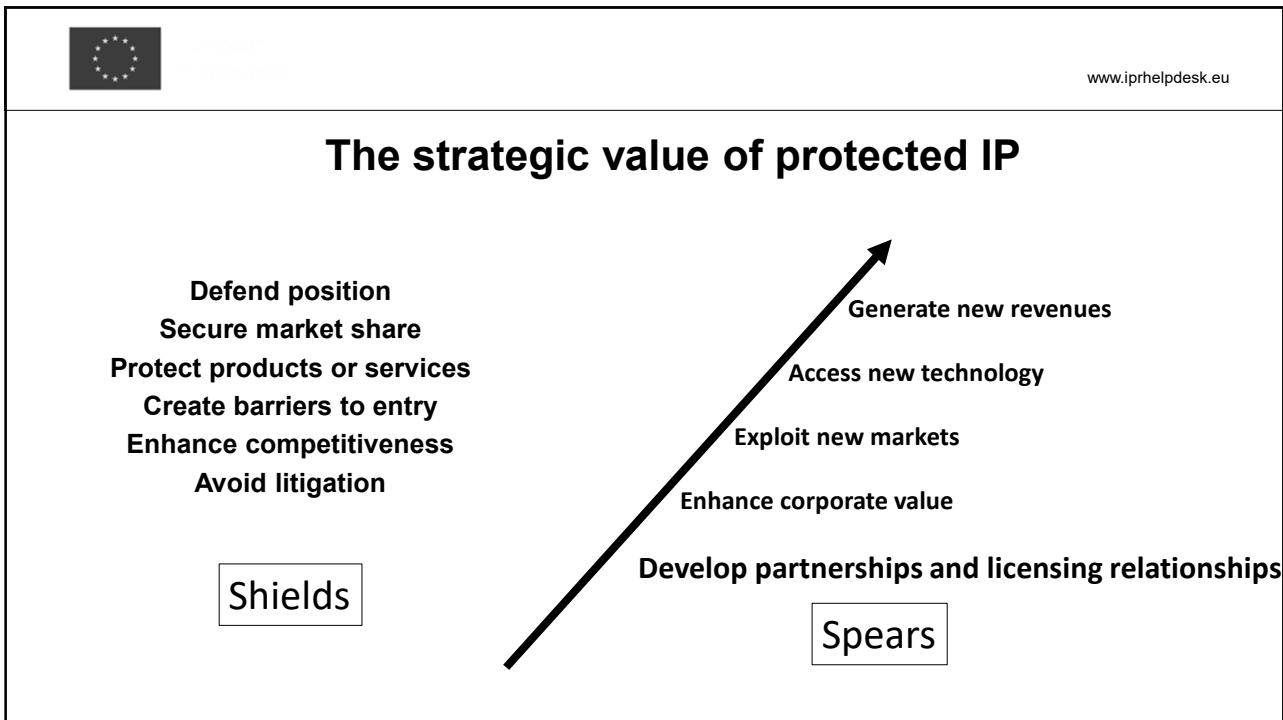
Patentable IP	Copyrightable IP	Designs (design rights)	Trade secrets, etc	Intangible assets
<ul style="list-style-type: none"><li>• Computer implemented inventions (software!)</li><li>• Processes</li><li>• Products</li><li>• Apparatus</li></ul>	<ul style="list-style-type: none"><li>• Software code</li><li>• Reports</li><li>• Engineering drawings</li><li>• Manufacturing and user guides</li></ul>	<ul style="list-style-type: none"><li>• Functional</li><li>• Eye-appeal</li></ul>	<ul style="list-style-type: none"><li>• Formulas</li><li>• Methods</li><li>• etc</li></ul>	<ul style="list-style-type: none"><li>• People</li><li>• Know how (e.g. best way to implement)</li><li>• Potential Brand value (supported by Trade or Service Marks)</li></ul>

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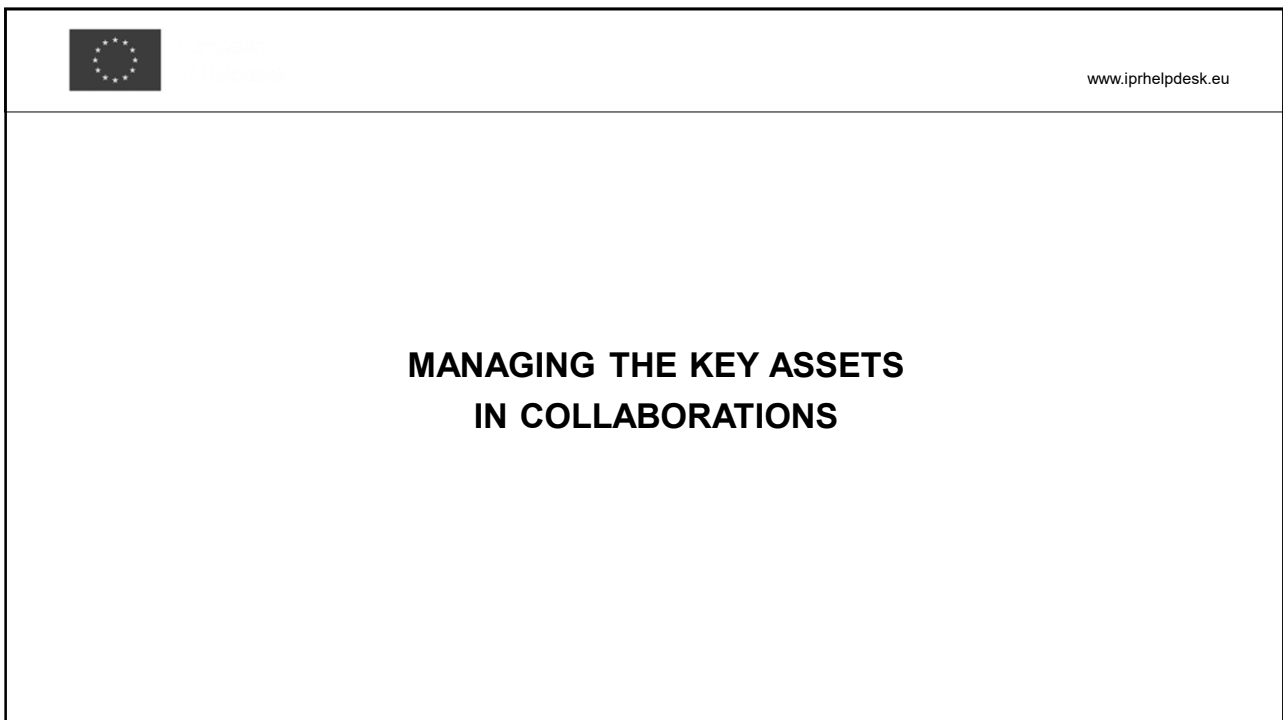


**THE STRATEGIC USE OF  
INTELLECTUAL ASSETS IN  
BUSINESS COLLABORATIONS**

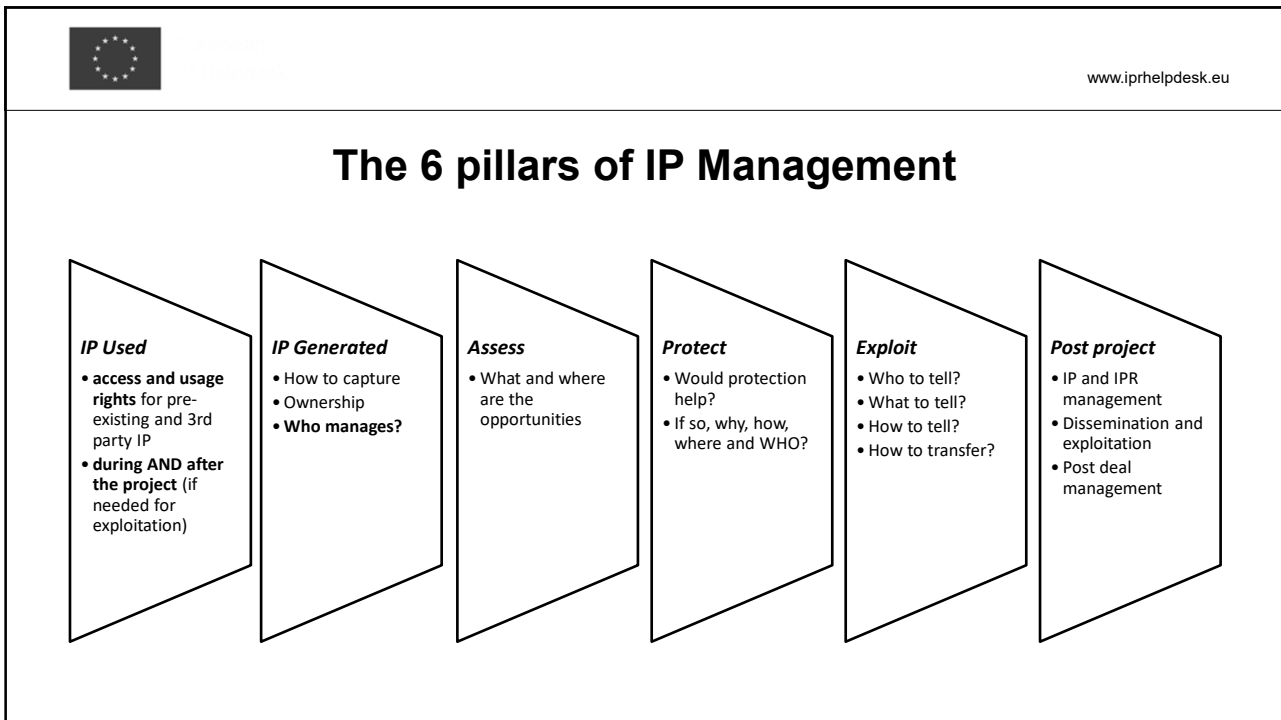
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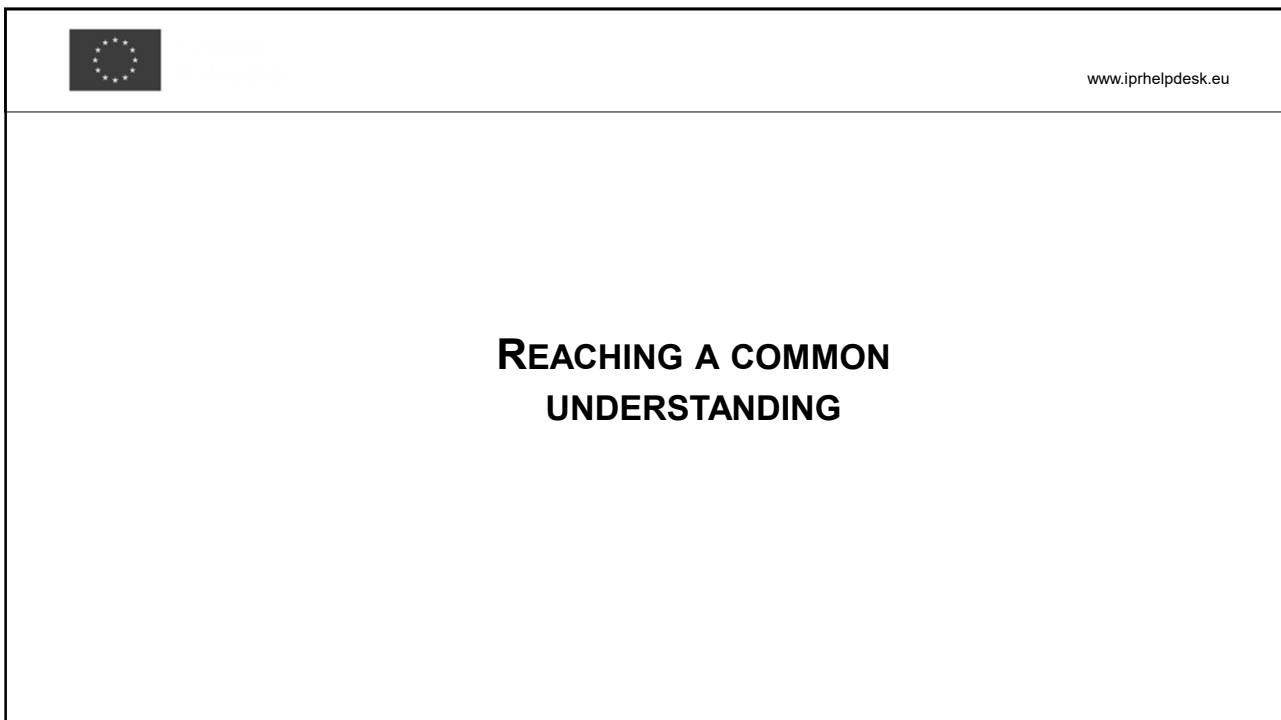
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## What are the collaboration opportunities?

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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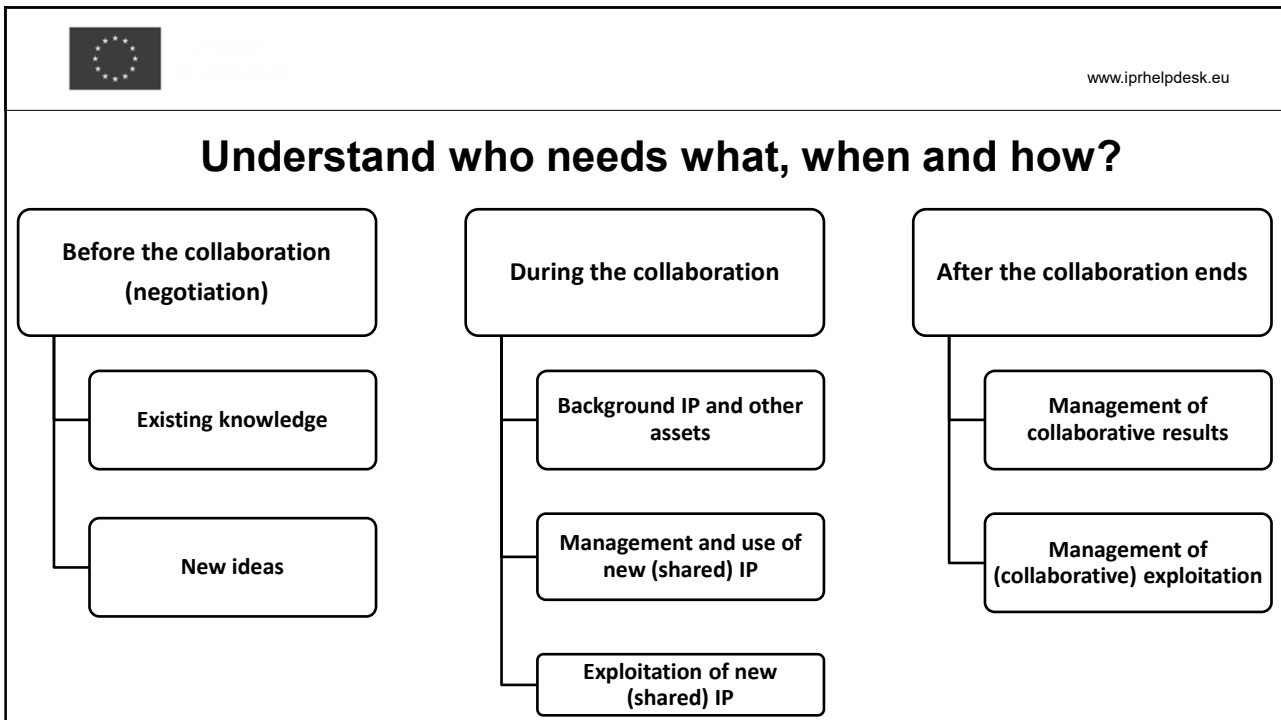


## Needs, Contributions, Benefits, Risks Matrix

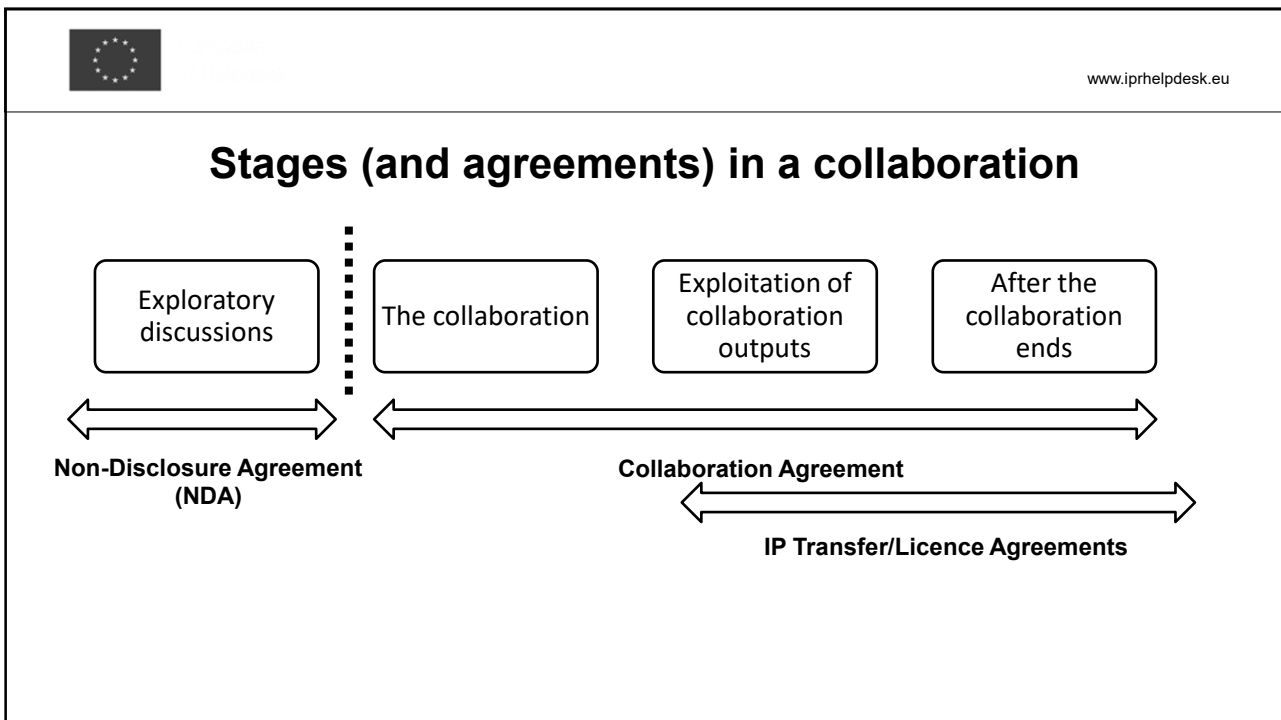
Partner	P1	P2
<b>Needs</b>	What are the needs/wants/challenges you want to address?	
<b>Contributions</b>		What do you plan to contribute to the collaboration?
<b>Benefits</b>	What do you want to get out of the collaboration?	
<b>Risks</b>		What are your main concerns or potential risks which might reduce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

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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 (3<sup>rd</sup> 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)

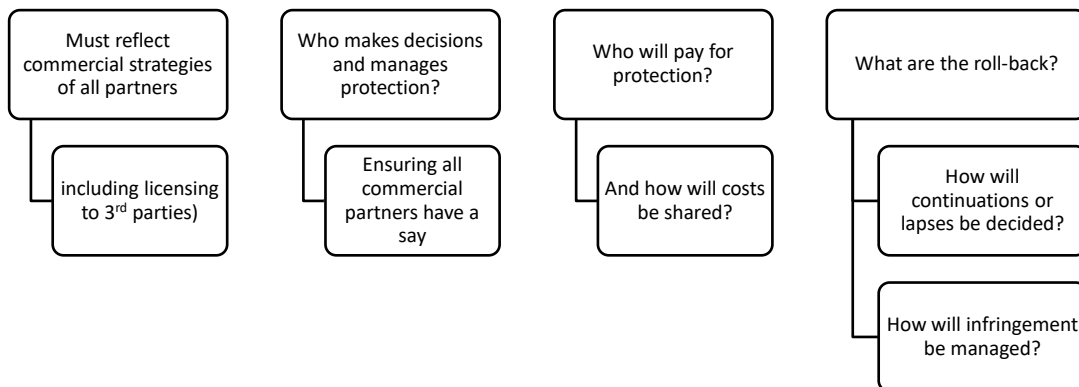
each joint owner owns an <b>undivided interest</b> in the whole work.	• It doesn't matter who contributed most
each has the <b>right to exploit without the other's permission</b>	• but must pay the other joint owners equal shares of earnings
<b>No right to transfer</b> or grant someone else an <b>exclusive license</b>	• Without permission of other joint-owners
If case of <b>infringement</b> , 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



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## Agree exploitation of the collaboration outputs

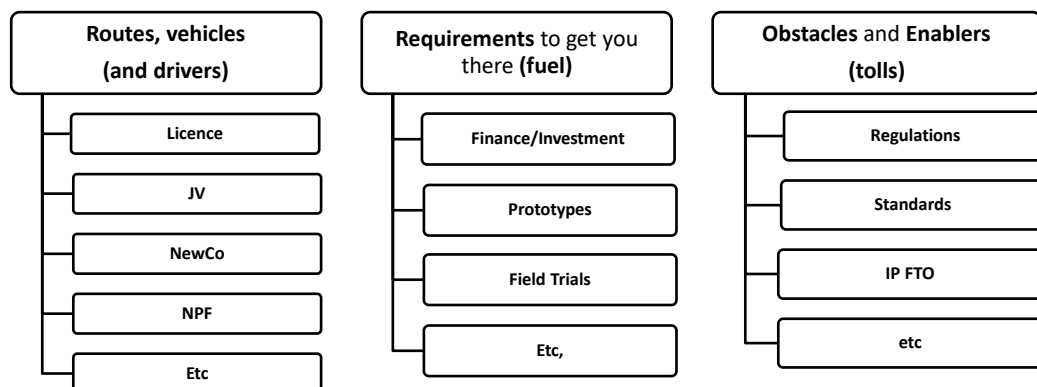
Agree exploitation strategies and pathways and responsibilities

- **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



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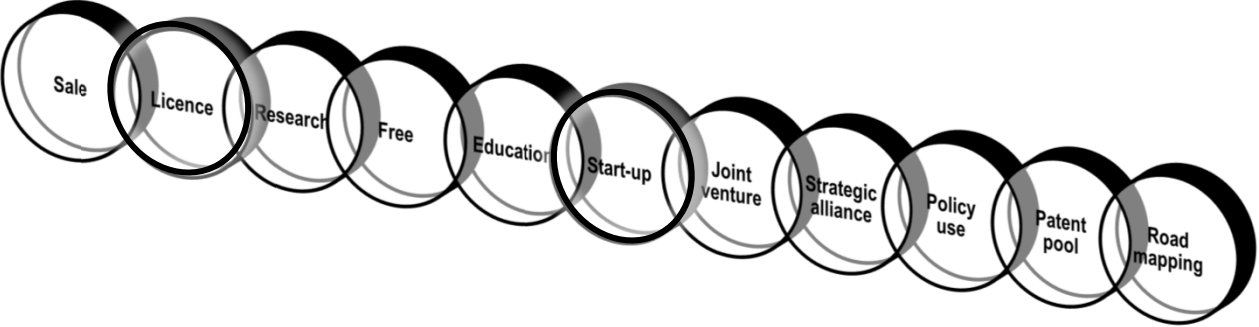


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## Providing Access to Intellectual Assets

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

- Licensee has expertise and resource
- Can address different fields of use and geographical areas
- Established markets & suppliers
- Evolutionary/incremental technology
- The IP fits a gap in someone else's portfolio
- Low financial commitment – less risk
- Early returns – may grow over time

### or New Venture?

- New Company must acquire expertise and resource
- Needs a critical mass of expertise and a committed and enthusiastic team
- New markets for new suppliers
- Revolutionary or platform technology
- Delivers a unique business advantage
- Needs capital - more risk
- 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

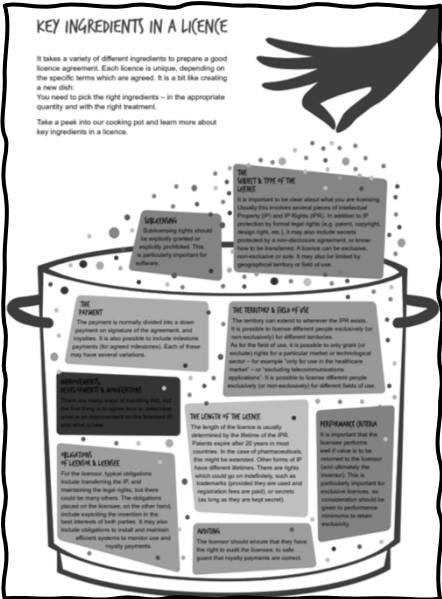
European IP Helpdesk Bulletin No.1 - IP Licensing




<https://op.europa.eu/oportal-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**


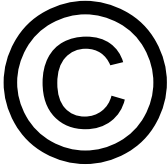


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**Software patent *OR/AND* Software copyright**

<p><b>Patent</b></p> <p>What it <u>does</u> (regardless of how expressed)</p> 	<p><b>Copyright</b></p> <p>What it <u>is</u> (its expression)</p> 
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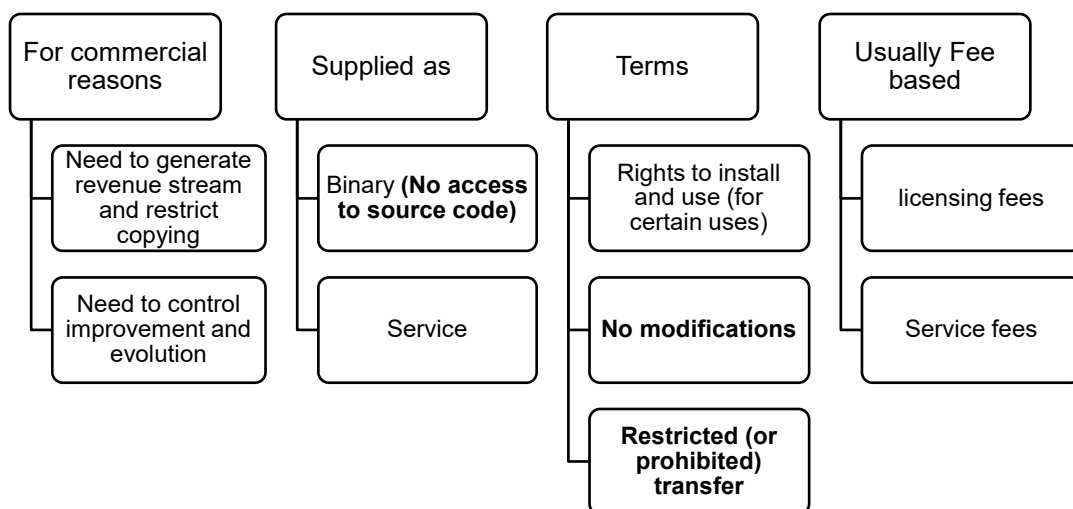


## Licensing Source Code Copyright

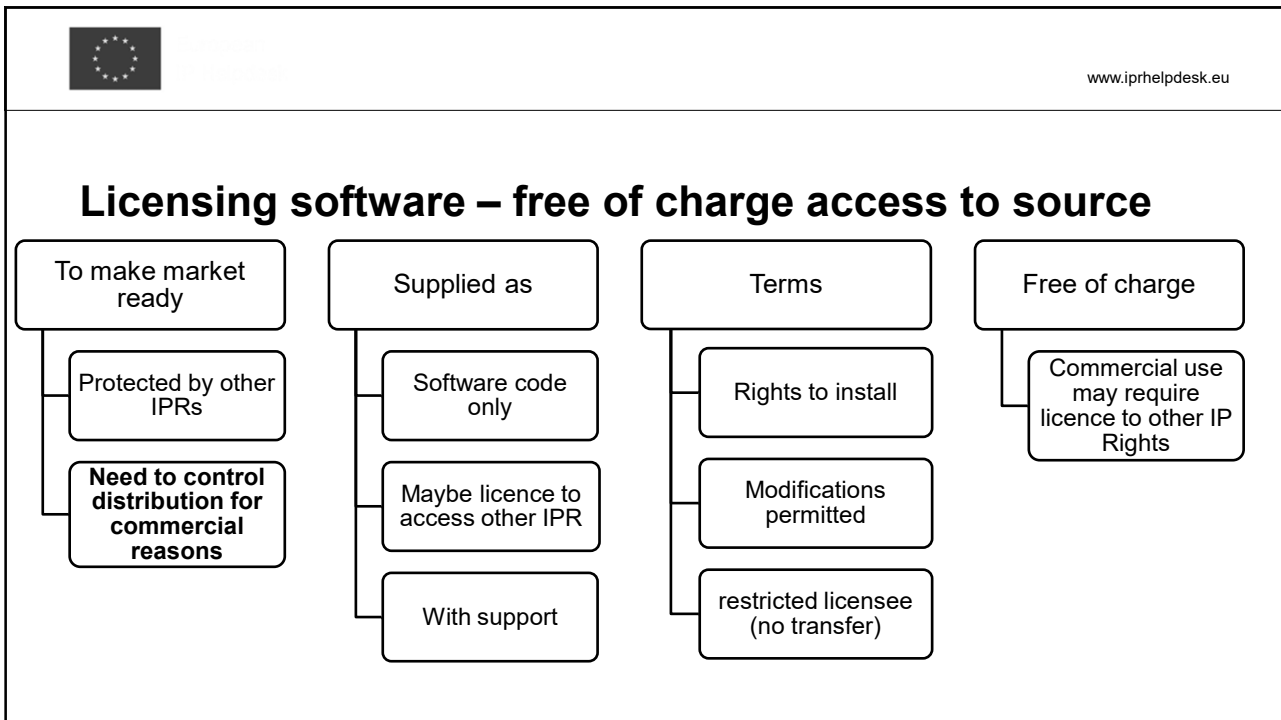
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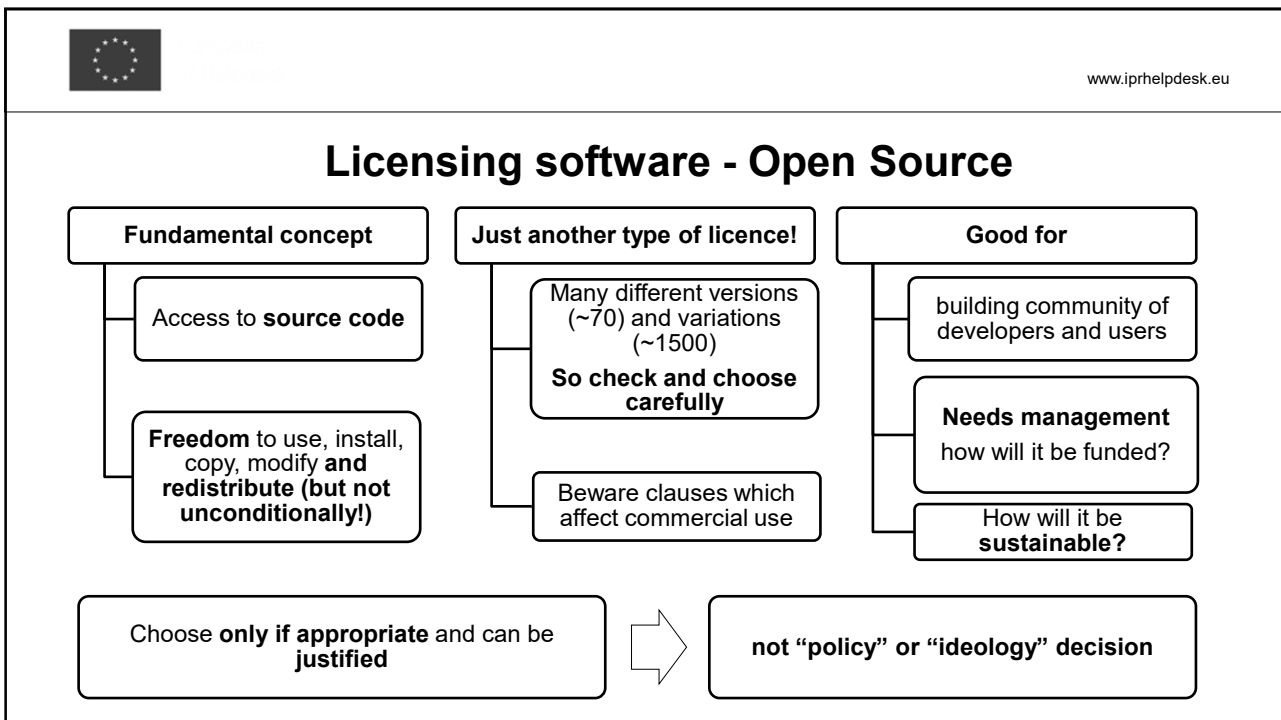
## Licensing software - “closed” source




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## Two main types of Open Source licence

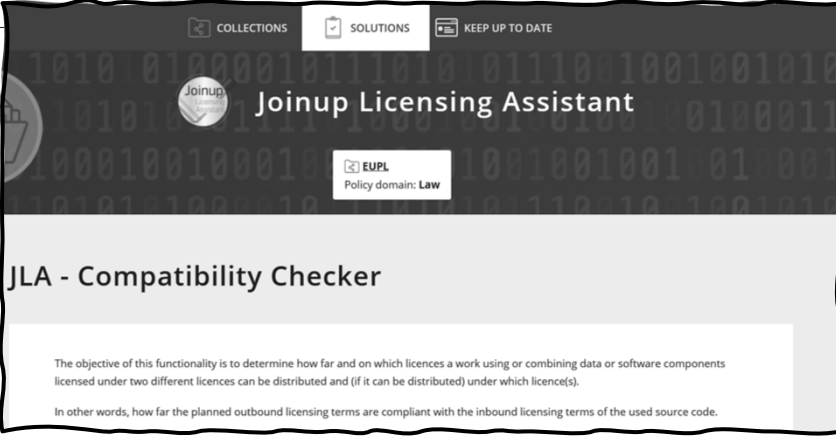
<b>Permissive Licences</b> (e.g. MIT, Apache, BSD...)	<b>Copyleft Licences</b> (e.g. GPL, MPL, EUPL...)
<ul style="list-style-type: none"><li>• Do not control how modified code is licensed</li><li>• Modifications can be released under any licence, open source or not</li><li>• Must include attribution, permission and copyright notices</li></ul>	<ul style="list-style-type: none"><li>• Additional conditions about derivative works</li><li>• Same rights included in derivative works (<b>Strong</b>) - GPL</li><li>• No restrictions on derivative works, but original code must have same rights (<b>Weak</b>) – EUPL, LGPL, MPL</li></ul>

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## 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**

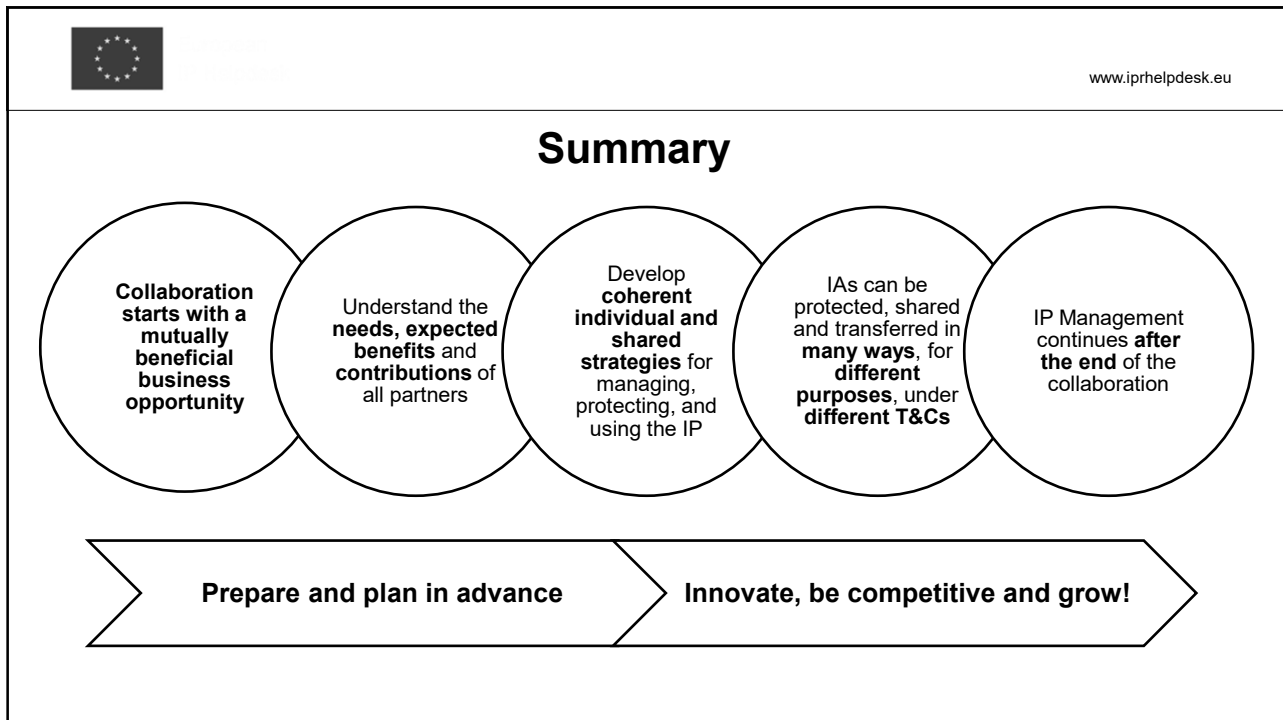
**Terms of access and use of IP post-collaboration**

**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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*Presentation produced by Dr. Eugene Sweeney, Iambic Innovation Ltd. November 2022*

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