



European IP Helpdesk

Stay ahead of the innovation game.

European IP Helpdesk Webinar:
Technology Transfer
Dr. Christian Hackl
Senior IP Advisor

Oct. 26, 2022



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



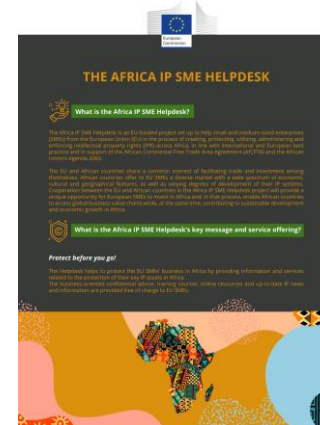
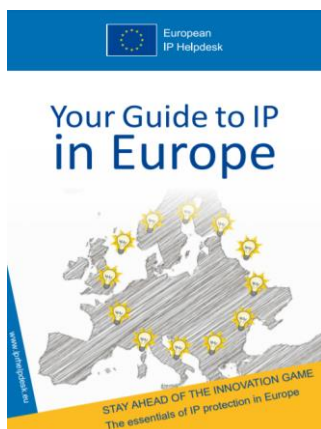


The EC IP Helpdesks





EC IP (SME) Helpdesk Hub – Gateway to Information



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



Patent Protection for EU funding Beneficiaries


19

JAN

2022

TRAINING AND WORKSHOPS

EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Medical Technologies

 Live streaming available


16

MAR

2022

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EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Artificial Intelligence

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EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Green technologies

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EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Digital communication

 Live streaming available


17

NOV

2022

TRAINING AND WORKSHOPS

EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Biotechnology

 Live streaming available

Patent protection for EU funding beneficiaries

An IP training series offered by the European Patent Office and the European IP Helpdesk



European
IP Helpdesk





From Lab to Market – IP & successful TT Training series

02
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TRAINING AND WORKSHOPS

EU - Webinar CIOPORA coop: Enforcement practices for Plant Variety Rights in the EU

Live streaming available

03
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TRAINING AND WORKSHOPS

EU - From Lab to Market - Successful Technology Transfer Journeys - Case: fos4x

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TRAINING AND WORKSHOPS

EU - Webinar: Effective IP and Outreach Strategies Help Increase the Impact of Research and Innovation

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INFO DAYS

Horizon IP Scan - Info Session

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TRAINING AND WORKSHOPS

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

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TRAINING AND WORKSHOPS

EU - Webinar: IP in EU funded projects with a special focus on MSCA

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EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Biotechnology

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TRAINING AND WORKSHOPS

EU - Webinar: Freedom to Operate

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Registration: www.ec.europa.eu/ip-helpdesk/lab_market



Ambassador Scheme

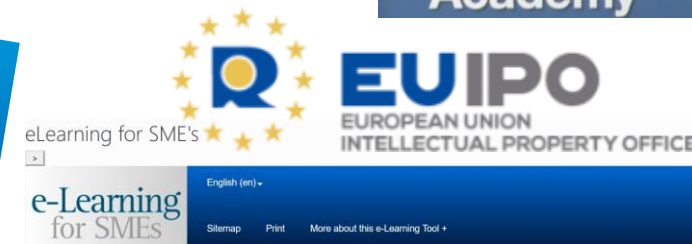
- **Cooperation scheme** with the Enterprise Europe Network (EEN): 44 ambassadors – 27 countries
- **Building IP capacities** among European SMEs
- **Overcoming language barriers**
- Making the topic **more accessible**
- Exchange and feedback from ambassadors on **needs of SMEs**
- Local **awareness** and **training events**





Further learning opportunities:

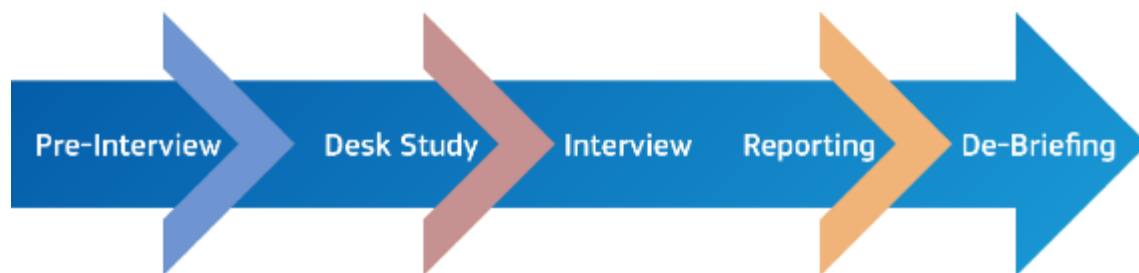
1. [European IP Helpdesk Ambassadors and EEN](#)
2. [EUIPO learning portal](#)
3. [EUIPO – Ideas Powered for business website](#)
4. [WIPO Academy / Diagnostics](#)
5. [The Ideas Powered for business SME Fund](#)
6. [IPA4SME](#)
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Horizon IP Scan

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



14 JUL
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www.horizon-ipscan.eu

Horizon IP Scan





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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 and Managing Director of a start-up (renewable energy)



Roadmap

- I. What is Technology Transfer?
- II. Stages of Technology Transfer
- III. Actors + Assistance
- IV. Case Studies





Roadmap

- I. **What is Technology Transfer?**
- II. Stages of Technology Transfer
- III. Actors + Assistance
- IV. Case Studies





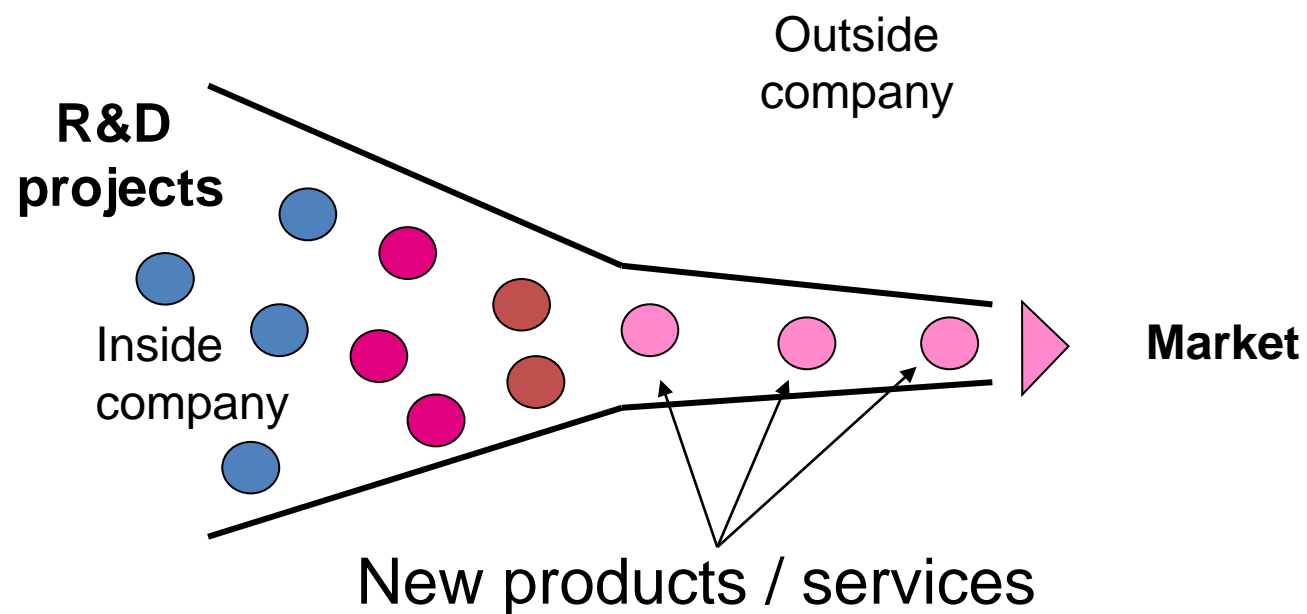
I. What is Technology Transfer?

“Technology transfer is the process of transferring (scientific) ideas / findings or technologies from one organization to another for the purpose of further development and commercialization.”

Based on definition of AUTM (Association of University Technology Managers)



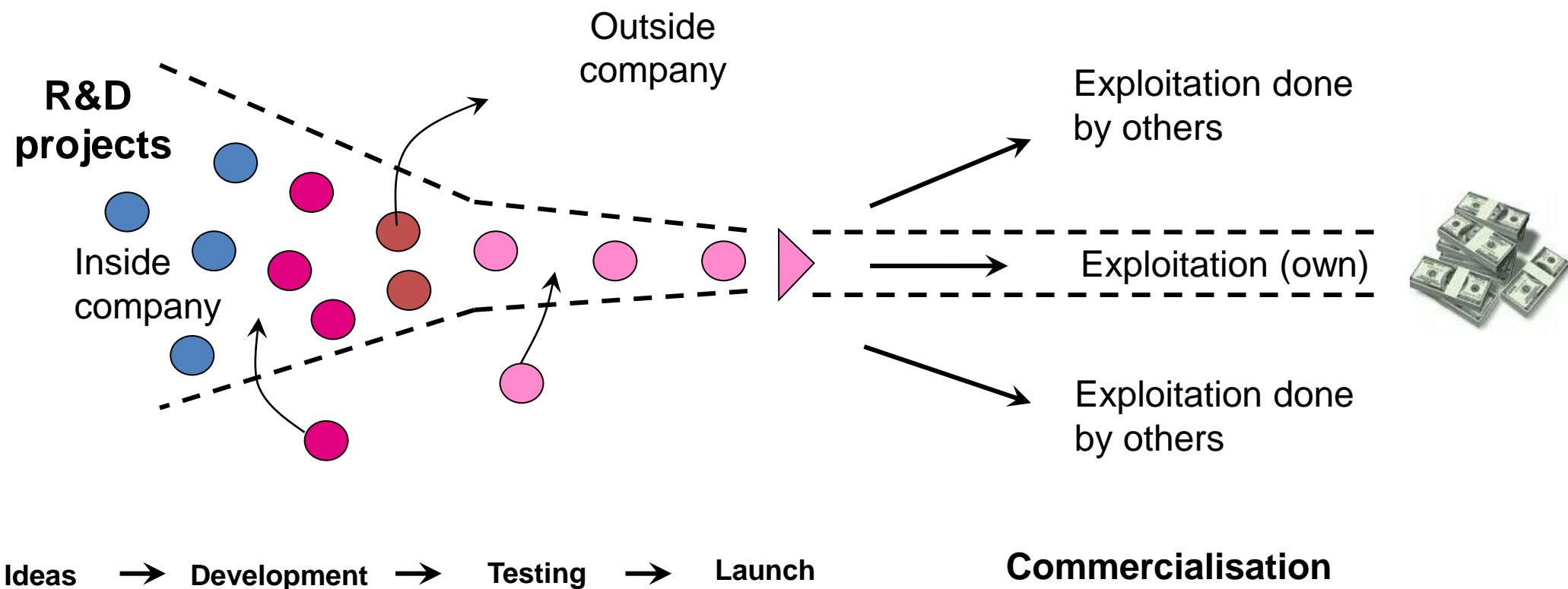
Closed Innovation



Ideas → Development → Testing → Launch

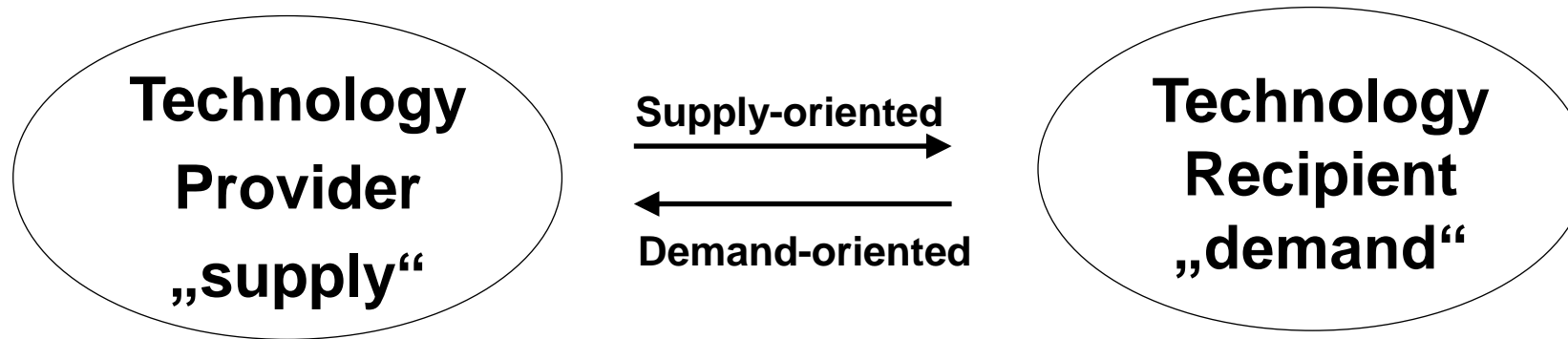


Open Innovation

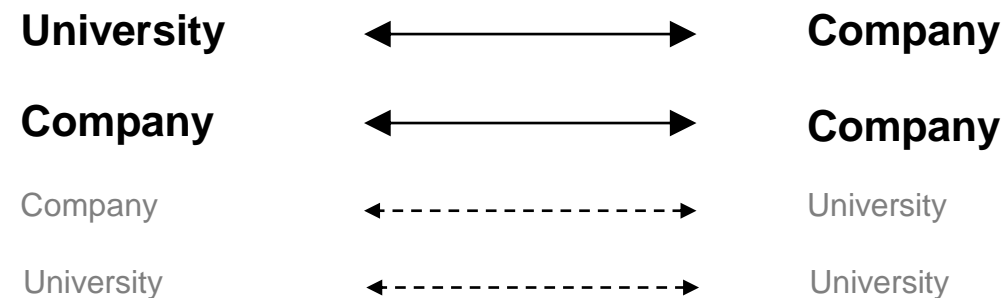




Technology - Transfer



Types of Partnership:





Examples for Technology Transfer

- Perceptual audio coding technology
 - Fraunhofer Institute for Integrated Circuits
- Formula of carbohydrates and electrolytes to stimulate fluid absorption...
 - University of Florida
- Method for rating web pages objectively and mechanically, effectively measuring the human interest and attention devoted to them
 - Stanford University





Advantages of Technology Transfer

Reasons for collaborating with a partner:

- Access a technology / know how
- Share risks / costs
- Speed up product development
- Reduce time-to-market

- Generate profits
- Access new markets
- Commercialise ideas



Barriers to Technology Transfer

Potential problems for technology transfer:

- Missing information on available technologies / know-how
- Missing information on available potential partners
- Missing infrastructure / skills to adapt technology / know-how
- Missing funds
- Missing (common) interests
- Missing communication / trust

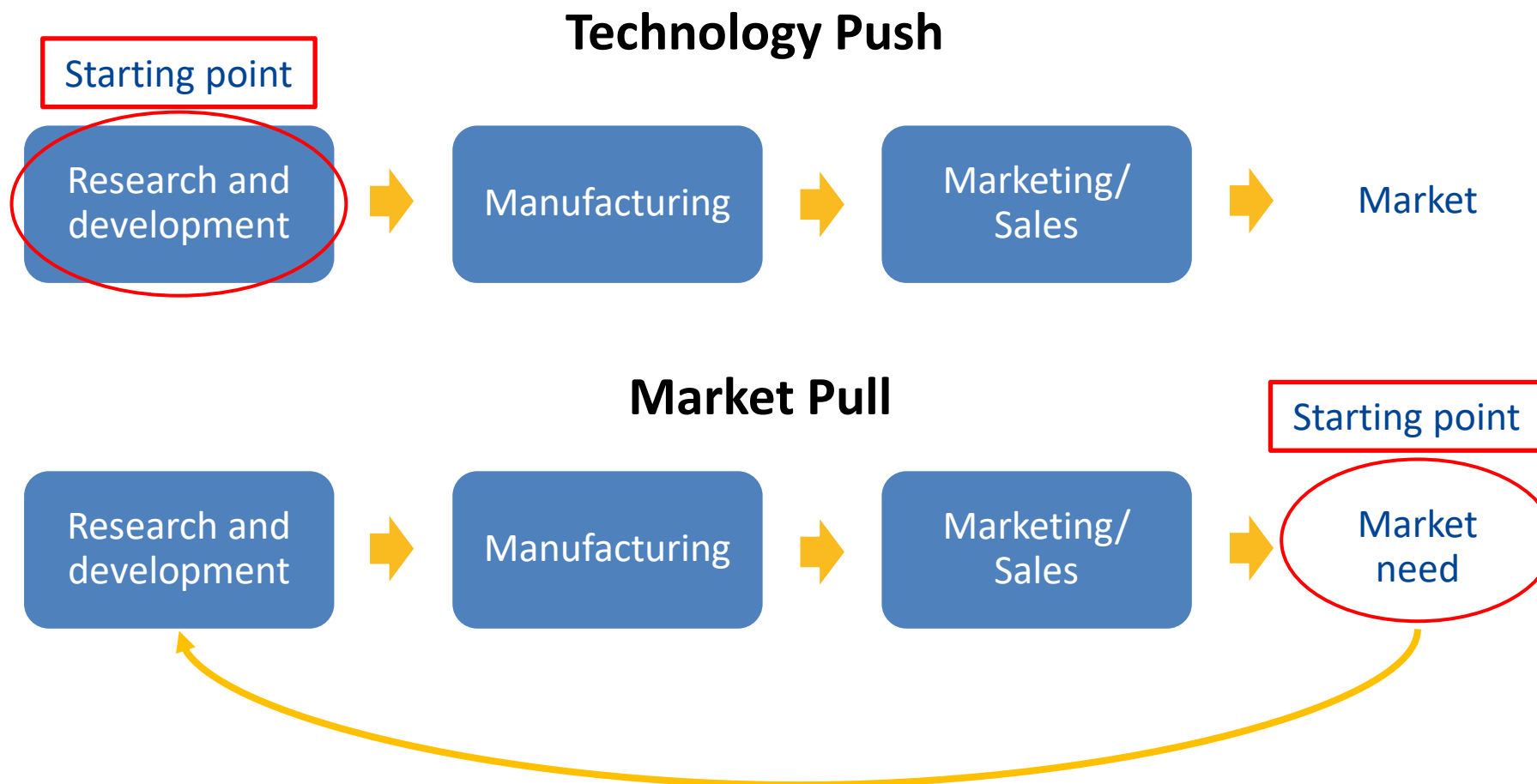


Why do universities engage in Technology Transfer?

- Universities can only cover first part (research) but not later stages (commercialization)
- Licensing revenue
- Regulations
- Reputation of university / researchers (attract talents and money)
- Economic development



Technology Push vs Market Pull (I/II)





Roadmap

- I. What is Technology Transfer?
- II. Stages of Technology Transfer**
 - I. Search for technology**
 - II. Screening of technology
 - III. Contractualisation
- III. Actors + Assistance
- IV. Case Studies





Information as basis for Tech Transfer

- Challenge: lack of information:
 - Potentially relevant technology / know-how
 - Owner of potentially relevant technology / know-how
- Lack of information in 2 directions:
 - Supply-oriented: who is interested in a certain technology (recipient/demand)
 - Demand-oriented: who is offering a certain technology (offer/supply)
- Support is coming in 2 forms:
 - Tools
 - Actors



Information as basis for Tech Transfer

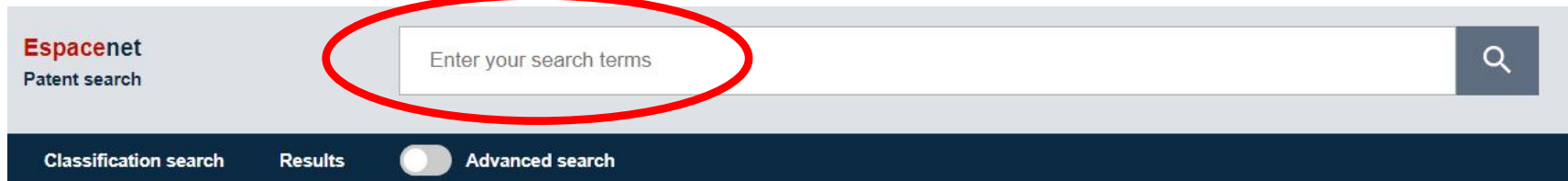
Finding relevant information is key

- Use specific tools to identify potential partners
- Use patent information
- Using these tools range from easy to complex (specialists available)



The Espacenet database (over 130 million docs)

<https://worldwide.espacenet.com>




Espacenet: free access to over 110 million patent documents

Also for identifying
potential partners





The Espacenet database (over 130 million docs)



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Enter name of one or more persons/organisations

Applicant(s): ⓘ Institut Pasteur

Inventor(s): ⓘ Smith

Quick access

Discussion forum

Classic Espacenet



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The Espacenet database (over
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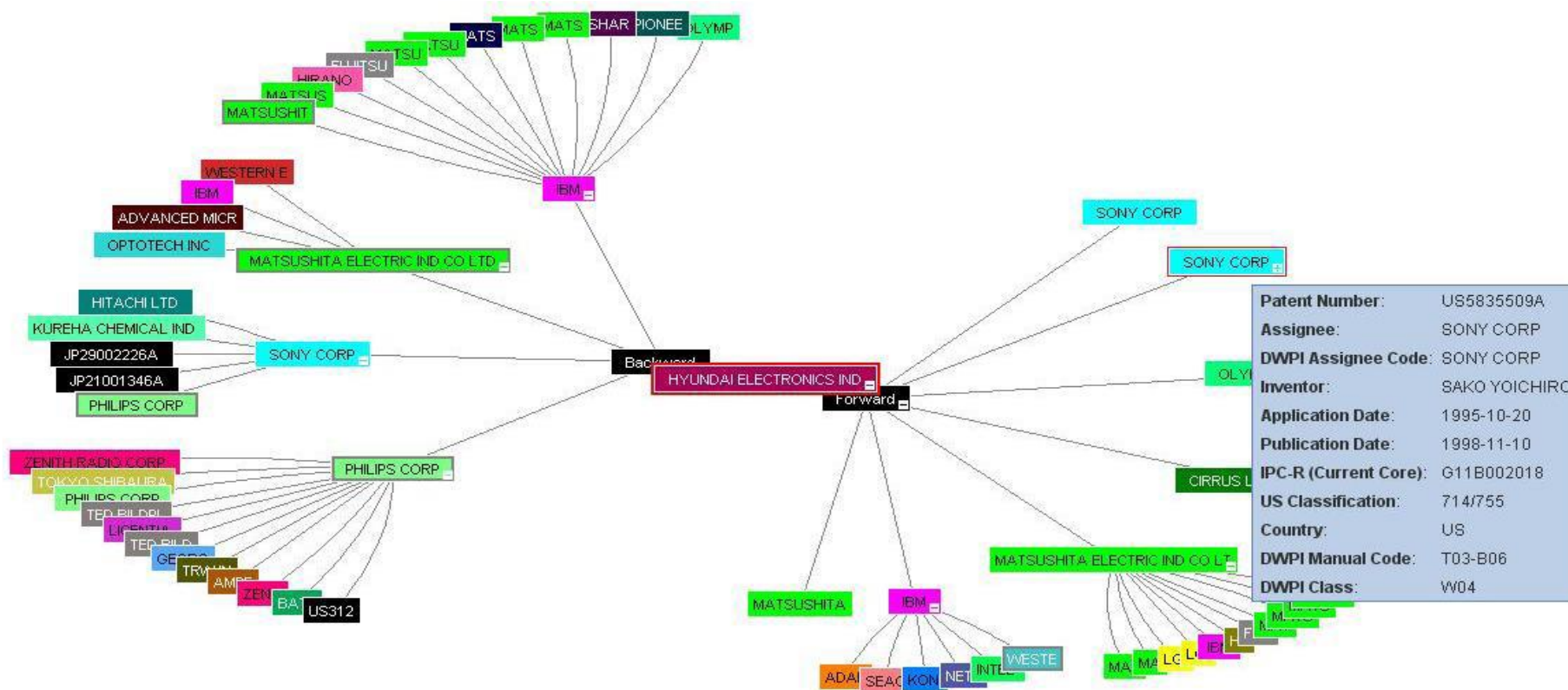
Description ▾ Any ▾ → Group

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Information gathering

Example of tools: Forward and backward citations





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Screening of technology

**2 main criteria for evaluation
(of potentially interesting technology for you):**

1. Legal
2. Market



Screening of technology – 2 main perspectives

**Technology
Provider
„supply“**

Is it possible to go for patent
(IP) protection?
(new, inventive, commercial
application)

Does it make sense to go for
patent (IP) protection?

***Webinar on
IP-Assessment***

**Technology
Recipient
„demand“**

Is there valid IP-
protection?

Does the protected
technology/know-how meet
your business needs?
Is there “good” IP-protection
(“good”= fitting business needs)?

Legal

Market




Screening of technology

What (other) topics would you evaluate (focus: demand-side)?

- Legal
- Market
- Technology
- Finance
- Fit to business (strategy)



*Webinar on
IP-Assessment*



IP assessment - how to
improve informed
decision making

Thursday 02.06
Tuesday 07.06
Thursday 09.06

The poster features an illustration of a person's hands holding a magnifying glass over a newspaper, with a smartphone and a coffee cup nearby.

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IP assessment



Screening of technology – IP Valuation

Once a potential partner (supply or demand) has been identified, one critical step is to assess the value of a technology, through the value of intellectual assets.

***Coming soon:
Webinar on IP Valuation***



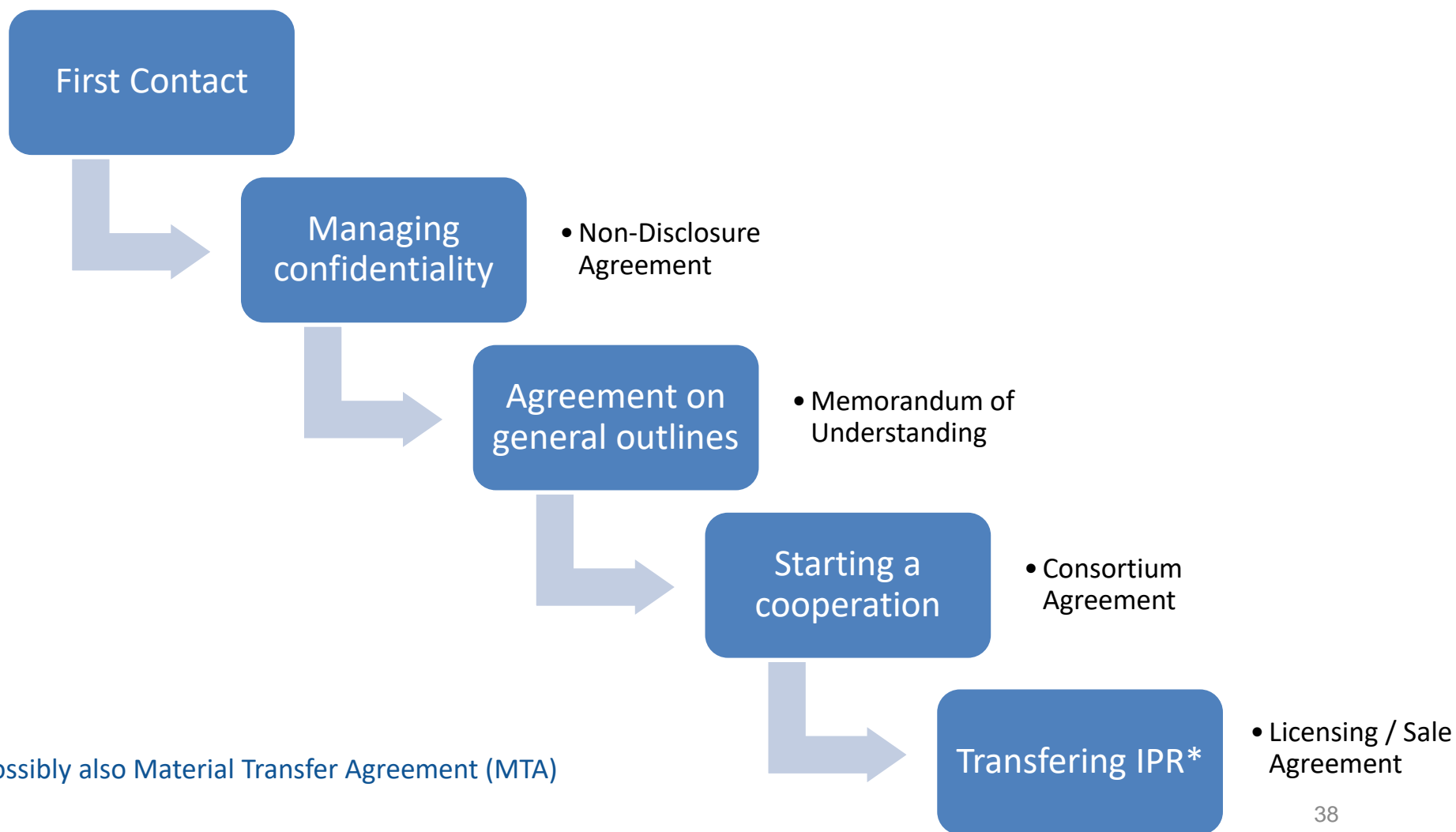
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Contractualisation of a transaction





Contractualisation of a transaction – Non Disclosure Agreement (NDA)

- Sometimes called a Confidential Disclosure Agreement (CDA)
- Legal document between two or more parties
- Agrees that information will be held confidential for a specific period of time
- Should describe how confidential information is identified, handled and stored
- Generally includes a clause about information becoming public knowledge



Contractualisation of a transaction – Memorandum of Understanding (MoU)

- Also named “Letter of Intent” (LoI)
- Documents the intent of two or more parties
- (Mostly) legally non-binding
- Documents main terms (goals, roles, responsibilities, financial obligations) of negotiations
- Often first step towards final contract



Contractualisation of a transaction – Consortium Agreement

- Agreement between two or more partners to collaborate collectively
- Defines roles and responsibilities among consortium partners
- Should explicitly describe how project results (IPR) will be shared and commercialized (including responsibility)
- Should document background IP and ownership



Contractualisation of a transaction – Material Transfer Agreement (MTA)

- A legal agreement that governs the transfer of tangible materials between two organizations
- Defines the rights of the originator of the materials and ownership of any derivative works
- Usually used with biological samples (but also with material samples or chemicals)
- Can be used for transfer between universities, industrial partners or research centers



Options for transfer of IPR

- Transfer of Ownership
 - Selling IPR to other entity
 - One-time transaction
- License
 - Allowing an other entity to use IPR
 - No transfer of ownership
 - Ongoing partnership
- Spin-off
 - Part of existing organization (e.g. student of faculty of university) form a new and independent entity
 - IPR (held by existing organization) form important constituent of spin-off; therefore, access rights for IPR have to be defined



Transfer options - 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



Transfer options - an IP license

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- The Licensor maintains the ownership of the IP

Webinar on Commercialisation and Licensing



Transfer options - an IP license



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

Permission to use IP

Payments



Licensee
*(e.g.
company)*



Splitting rights in a partnership

A key issue...

- Determines the subsequent options for Technology Transfer
- Determines the possible profitability of the project

...But the priorities diverge:

- Academic: desire to publish, often owner of the IPR
- Industry: secrecy and commercialization; desire to be unique user of the IPR



Splitting rights in a partnership – joint ownership in IPR

No common European legal concept of joint ownership

Patents in Europe (in general)

- **Right to exploit the IP for your own benefit** without accounting to the others
- But cannot grant a licence or assign interest of the IP without the consent of the other owners

→ You can use the IP yourself but cannot authorize others to use it without the consent by all co-owners



Splitting rights in a partnership – manage ownership in IPR

Prior to the start of the project: Consortium Agreement

- **Definition** of the background and IPR of each partner
- **Access** to the background IPR during and after the project
- **Protection and exploitation** of the results:
 - Secrecy or patent application?
 - Who is in charge of the application, the extension and the renewal of the rights?
 - Which part of the revenues goes to which partner?



Managing ownership - conclusion

- Splitting the rights in a partnership is a crucial point
 - The more you discuss and set-up the repartition of the rights in advance, the better will go on the cooperation with your partners
- ➔ Don't hesitate to dedicate time to discuss this issue - it is not lost time, it ensures the future success of the cooperation



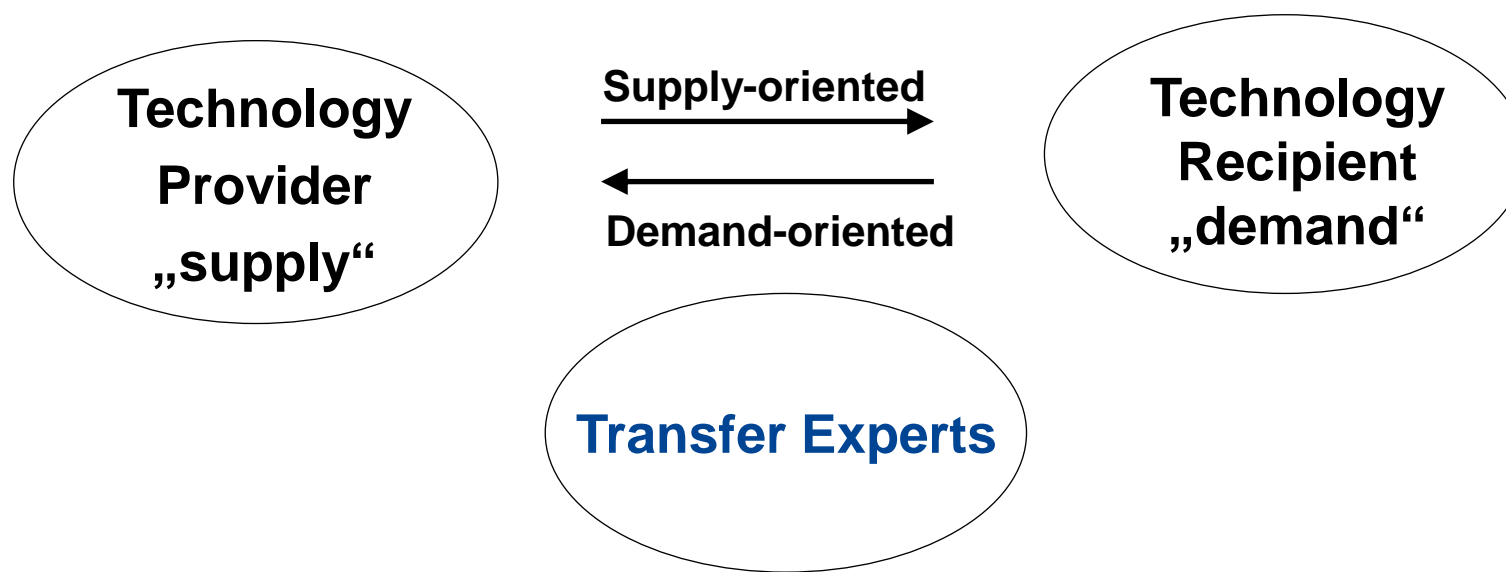
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Professionals experienced in different aspects of Technology Transfer



- Technology Transfer Offices
- Regional actors
- Consulting companies
- Specific programmes/service initiatives



Actors & Assistance - where can I go to get information and help?

Professionals experienced in different aspects of technology transfer can be found in ...

- **Technology Transfer Offices** (University or Public Research Organisations)
- **Regional actors** (e.g. innovation centers, chambers of commerce, incubators)
- **Consulting companies** specialized in technology transfer
- **Specific programmes/service initiatives** like the European IP Helpdesk



Technology Transfer Office

- Typically a (small) office set up by a university or research center to manage the protection and commercialization of technologies developed by its staff (supply oriented)
- Will usually perform technology marketing and licensing activities
- May also support start up efforts. Some TTOs may even manage seed capital funds



Regional actors (Innovation Center, Technology Park or Incubator)

- Typically established by a region / state to foster innovation and support public /private research initiatives
- Principally concerned with connecting actors with resources and the communication of new technology opportunities
- May have experts available to provide advice (development of business plans, start up funding, etc.) but usually does not work with very early stage technologies



Consulting company

- May have been created by university or research organization (spin-out) or established by former university TT managers
- Usually staffed with specialists who have different technical backgrounds (scientific expertise, IP expertise, business development, etc.)
- Usually offer full range of services (IP protection, market assessment, marketing, etc.), can work demand-oriented
- Will generally receive some type of compensation upon signing of successful license agreement



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Case study: fos4x (TTF case studies)

https://www.epo.org/learning/materials/sme/innovation-case-studies/technology-transfer-case-studies_de.html

Seminar: Nov 3rd fos4x

Registration:

https://intellectual-property-helpdesk.ec.europa.eu/news-events/events/eu-lab-market-successful-technology-transfer-journeys-case-fos4x-2022-11-03_en

Dr. Christian Hackl

EPO TECHNOLOGY TRANSFER CASE STUDIES | FOS4X

Sensors for blades – stress reduction for wind turbines

Encouraged by an IP-savvy university institute director with an entrepreneurial spirit and positive feedback from industry sponsors, a team of young researchers decided to bring their fibre optic measurement technology to market. Access to the university's patent portfolio and research facilities, together with the business experience acquired by one of the co-founders, paved the way to the creation of fos4X. The young company decided early on to focus on applications for wind turbines, and their patents turned out to be crucial in a market of mostly large players. The company was acquired in 2020 by PolyTech on the basis of its innovative technology and IP portfolio.



fos4X provides streaming analytics using fibre-optic sensors on the rotor blades of wind turbines



Case study: Orcan Energy (SME case studies)

[https://www.epo.org/learning/
materials/sme/sme-case-
studies.html](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.

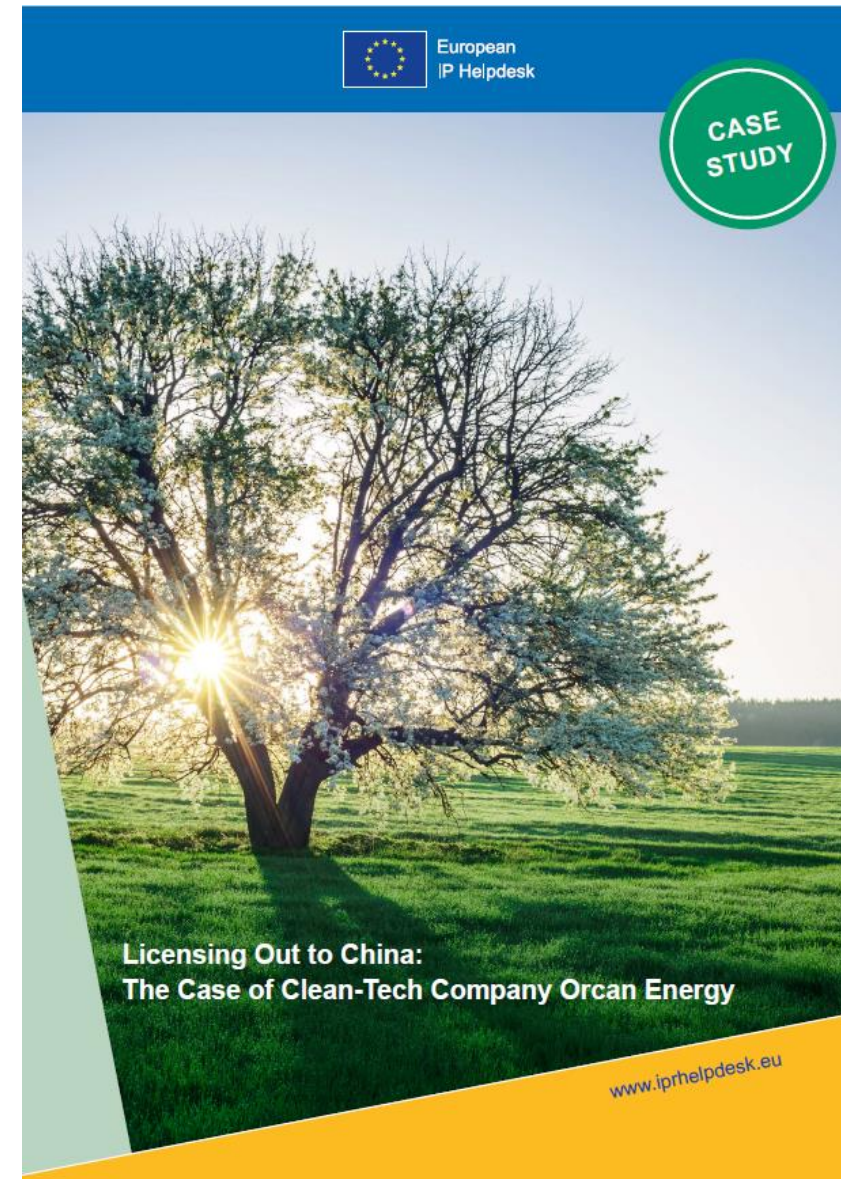




Case study II: Orcan Energy

<http://iprhelphdesk.eu/news/case-study-orcan-energy>

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





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