



# European IP Helpdesk

Stay ahead of the innovation game.

European IP Helpdesk Webinar:  
Commercialisation and Licensing  
(Basic)

Dr. Christian Hackl

Senior IP Advisor

Feb 15, 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: 48 ambassadors from 28 EU countries



[www.iprhelpdesk.eu](http://www.iprhelpdesk.eu)



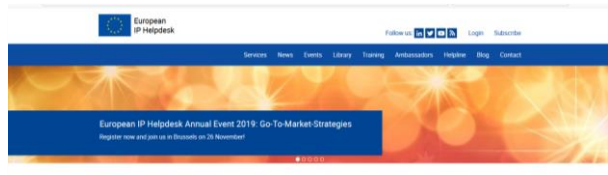


# The EC IP Helpdesks





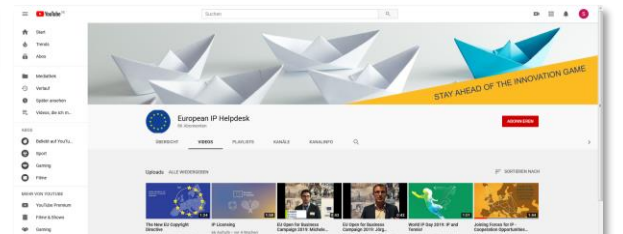
# Communication Formats & Outreach Tools



Website



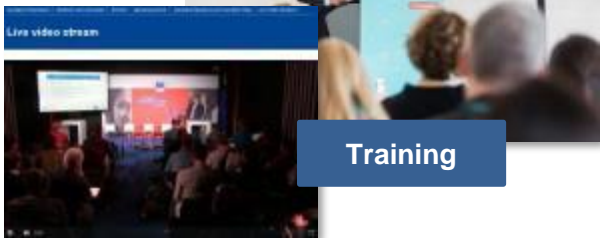
Publications



Audio-visual Content



Training



Social Media





# Ambassador Scheme

- **Cooperation scheme with the Enterprise Europe Network (EEN): 48 ambassadors – 28 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**





- |                          |  |                          |  |
|--------------------------|--|--------------------------|--|
| <b>26</b><br>JAN<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: IP Assessment</b><br>Live streaming available   | <b>01</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: Consortium Agreements</b><br>Live streaming available   |
| <b>02</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: IP in Biotechnology</b><br>Live streaming available   | <b>10</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: Technology Transfer</b><br>Live streaming available   |
| <b>15</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: IP Commercialisation and Licensing</b><br>Live streaming available  | <b>16</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: Impact and Innovation in EU funded projects - A guide for proposers</b><br>Live streaming available |
| <b>22</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: IP in Horizon Projects (H2020/HEurope)</b><br>Live streaming available  | <b>23</b><br>FEB<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: Geographical Indications</b><br>Live streaming available  |
| <b>02</b><br>MAR<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: IP and Artificial Intelligence</b><br>Live streaming available  | <b>03</b><br>MAR<br>2022 | TRAINING AND WORKSHOPS<br><b>Webinar: IP Commercialisation and Licensing</b><br>Live streaming available                                       |
| <b>09</b><br>MAR<br>2022 | TRAINING AND WORKSHOPS<br><b>Webinar: Effective IP and Outreach Strategies Help Increase the Impact of Research and Innovation</b><br>Live streaming available | <b>15</b><br>MAR<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar: Maximizing the Impact of Horizon project (2020/HEU) results</b><br>Live streaming available         |
| <b>16</b><br>MAR<br>2022 | TRAINING AND WORKSHOPS<br><b>EU - Webinar EPO Coop: Patent protection for EU funding beneficiaries - Artificial Intelligence</b><br>Live streaming available   | <b>23</b><br>MAR<br>2022 | TRAINING AND WORKSHOPS   RESCHEDULED<br><b>EU - Webinar: The Importance of IP for SMEs</b><br>Live streaming available                         |





## 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](#)





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[/european-ipr-helpdesk](https://www.linkedin.com/company/european-ipr-helpdesk/)







# Today's speaker

***Dr. Christian Hackl***



- Managing Director of TUM-Tech GmbH (for more than 15 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)



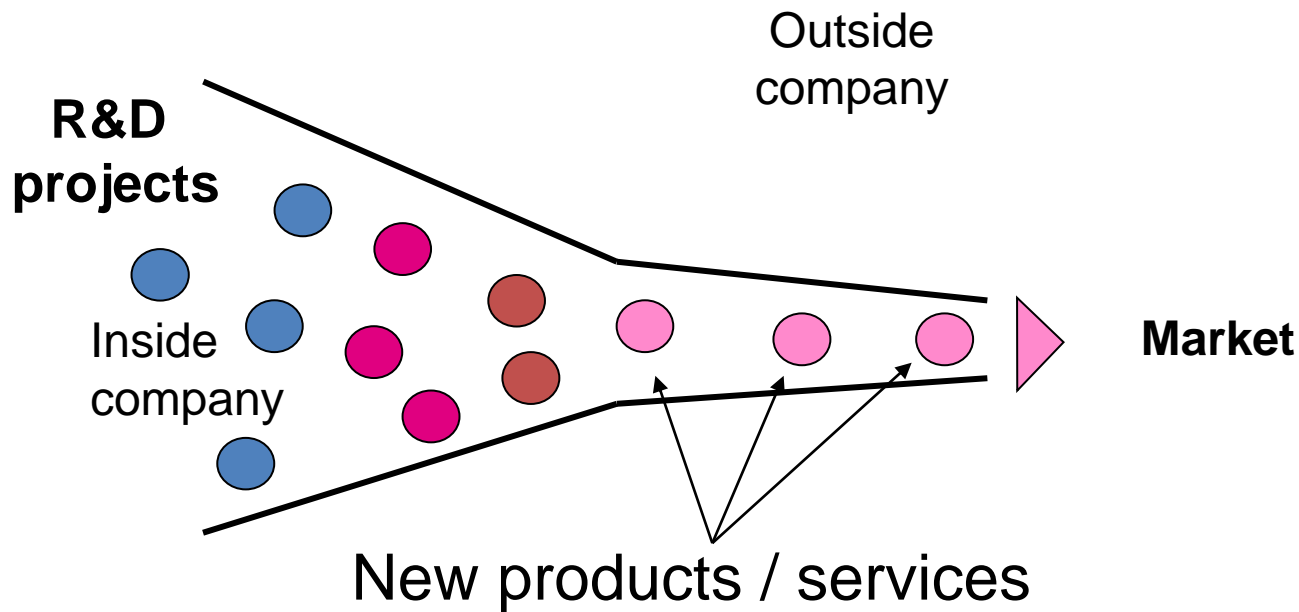
# Overview

- **Open innovation / Commercialisation**
- **What and why (license)**
- **Before negotiating**
- **Core content (licensing agreements) - *Basics***
- **Case study**
- **The negotiation**





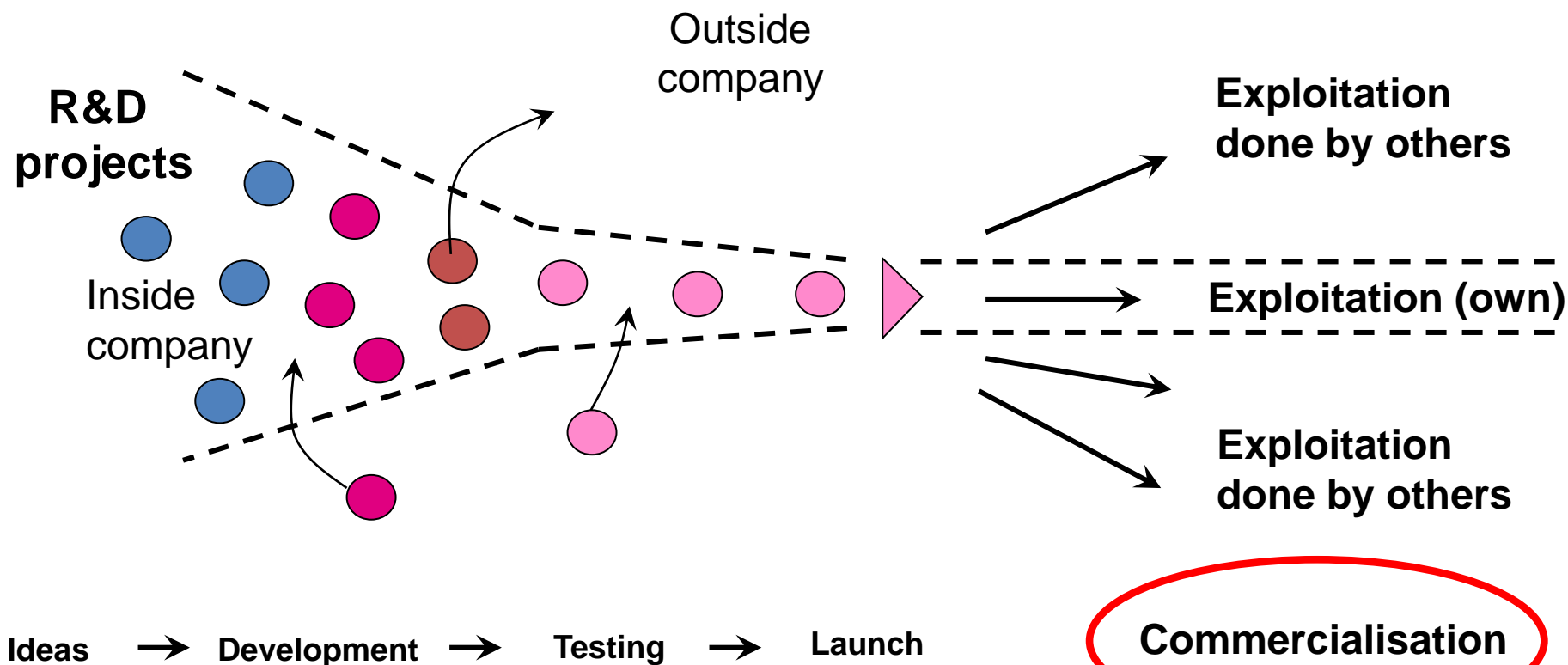
# Closed Innovation



Ideas → Development → Testing → Launch



# Open Innovation

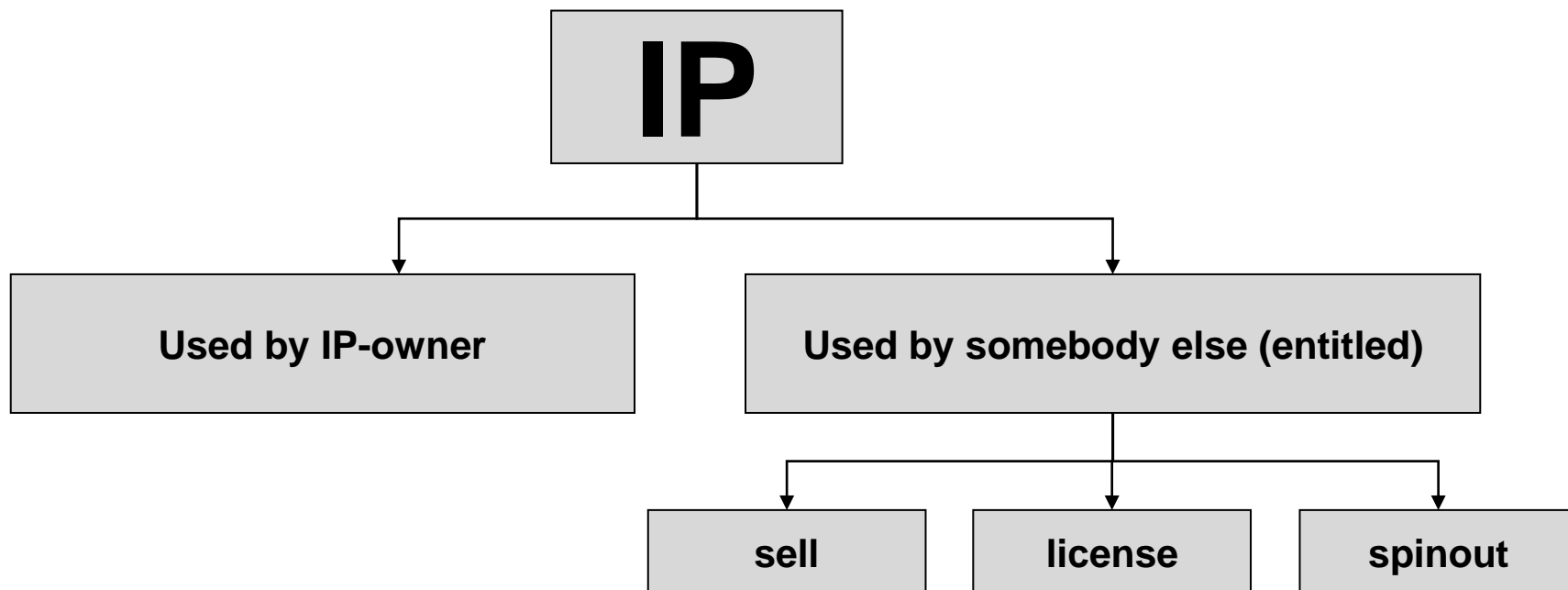


Ideas → Development → Testing → Launch

**Commercialisation**

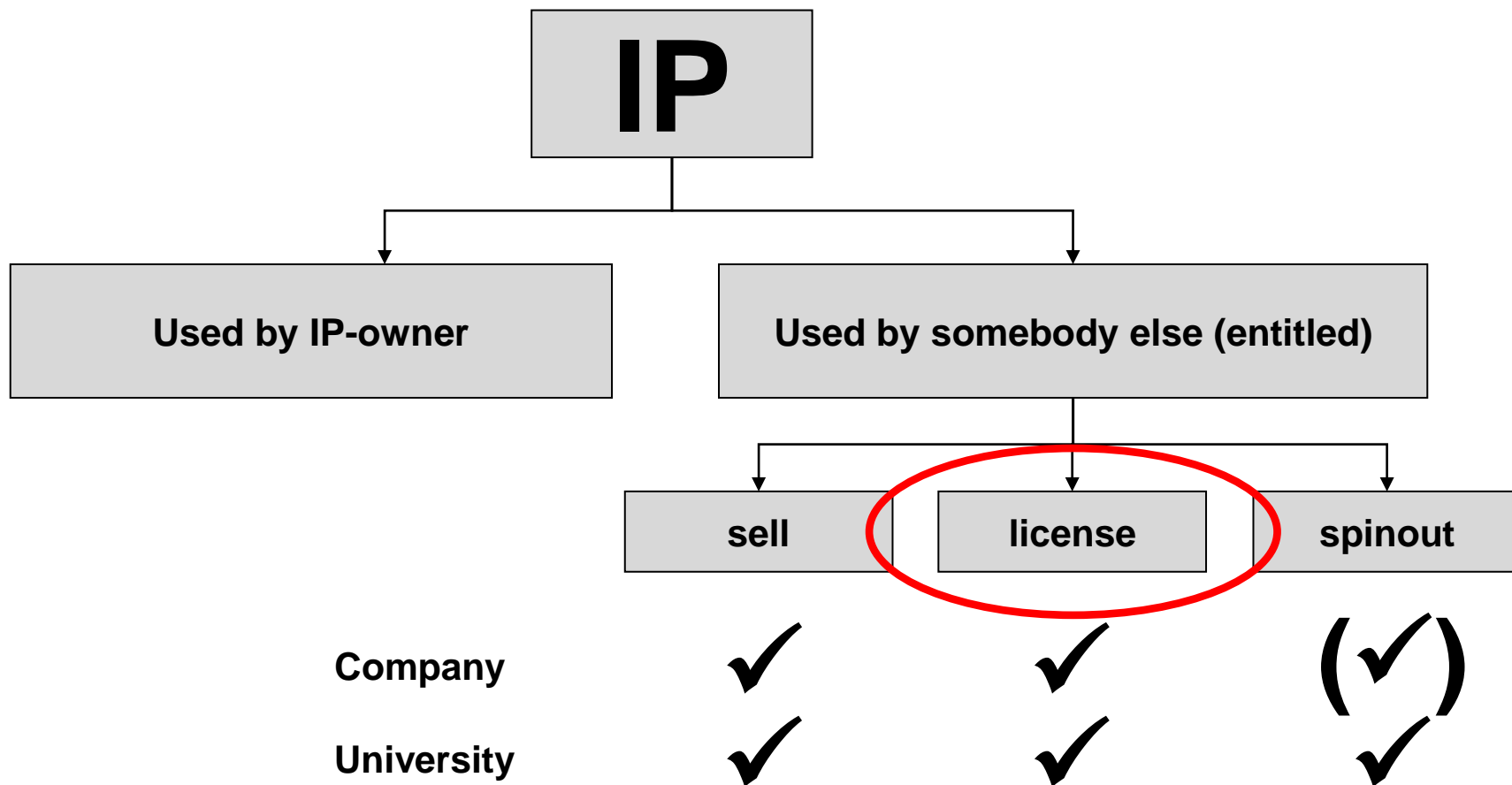


# IP Commercialisation





# IP Commercialisation





## An IP license

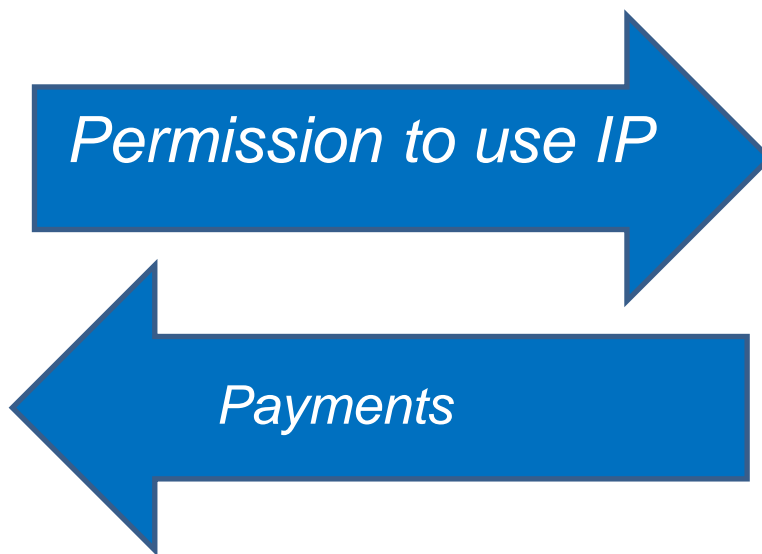
- Indirect exploitation of intellectual property
- Licensing agreement: the owner of IP (Licensor) grants the Licensee the right to use the IP
- The Licensor maintains the ownership of the IP



# What is a license?



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



**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



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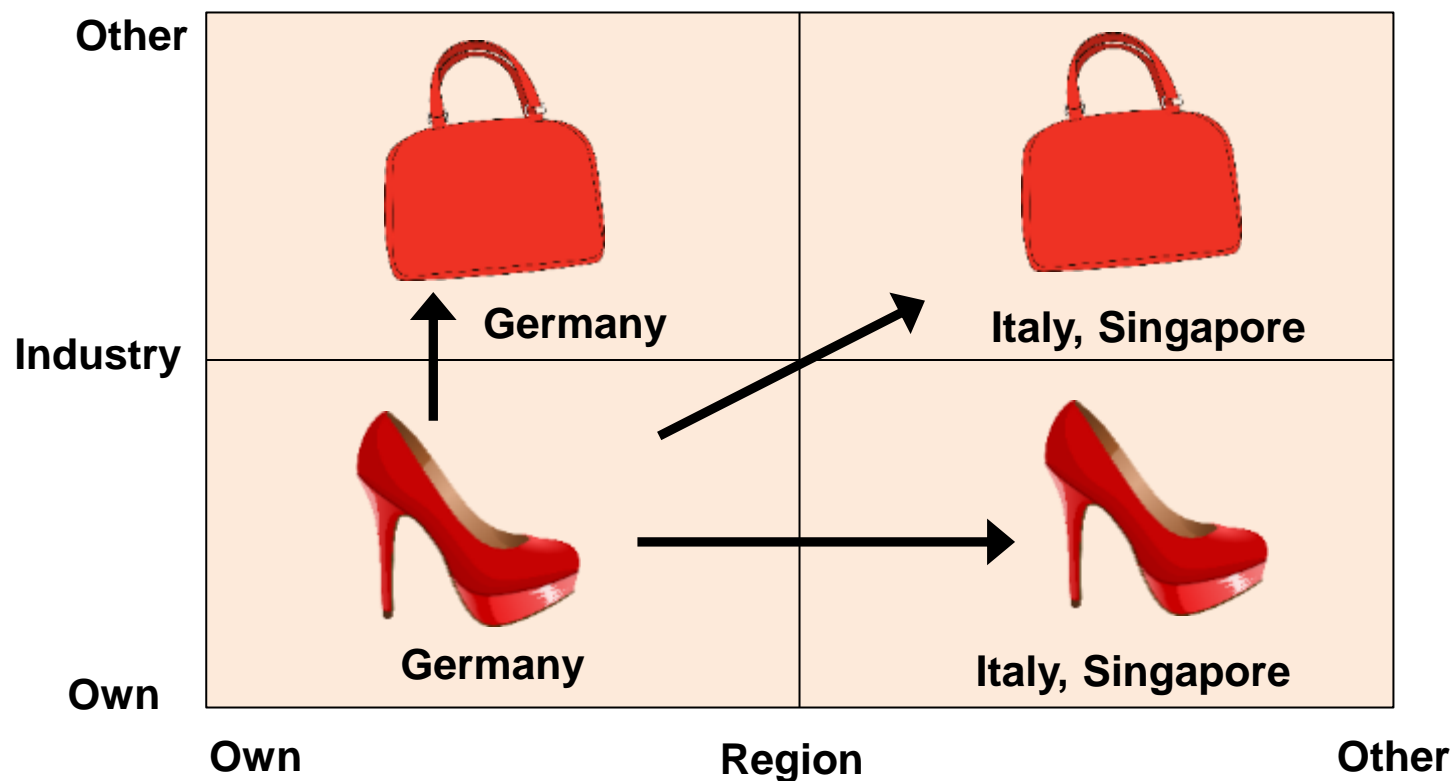


# When does external commercialisation make sense?

- 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





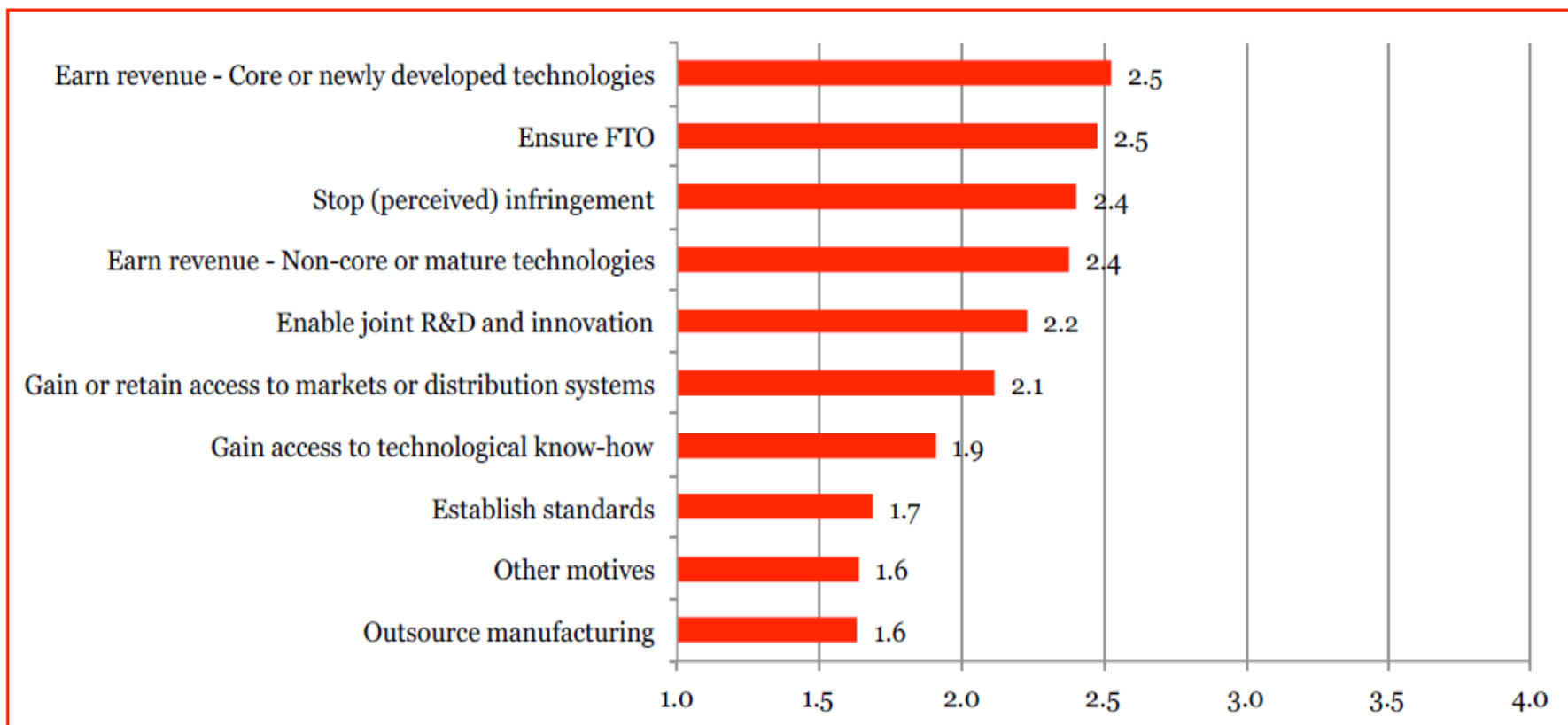
## Some more reasons for licensing

- 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

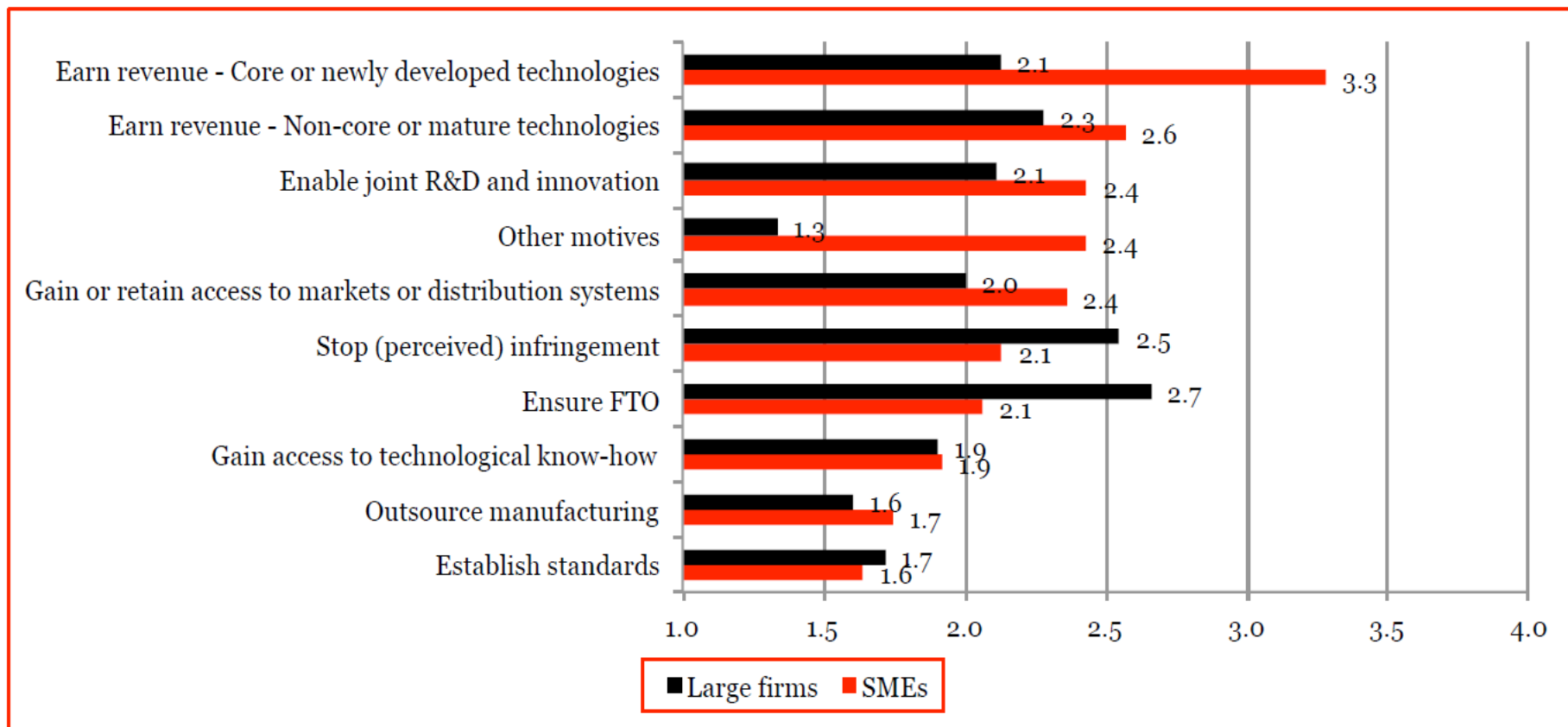


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



# Motives for outlicensing patents (size)

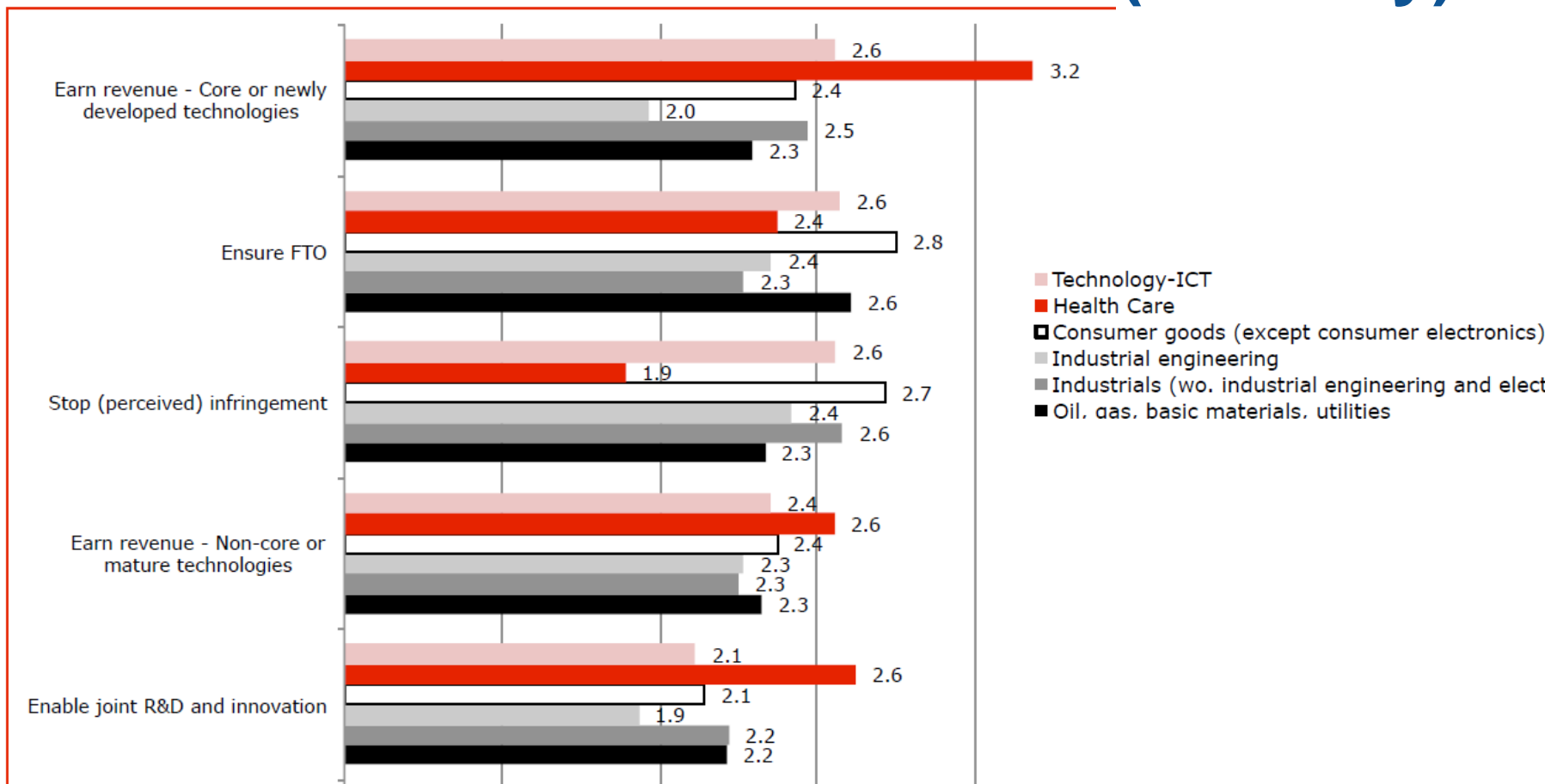


Arithmetic means on a scale from 1='unimportant motive' to 4= 'very important motive'

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



# Motives for outlicensing patents (industry)

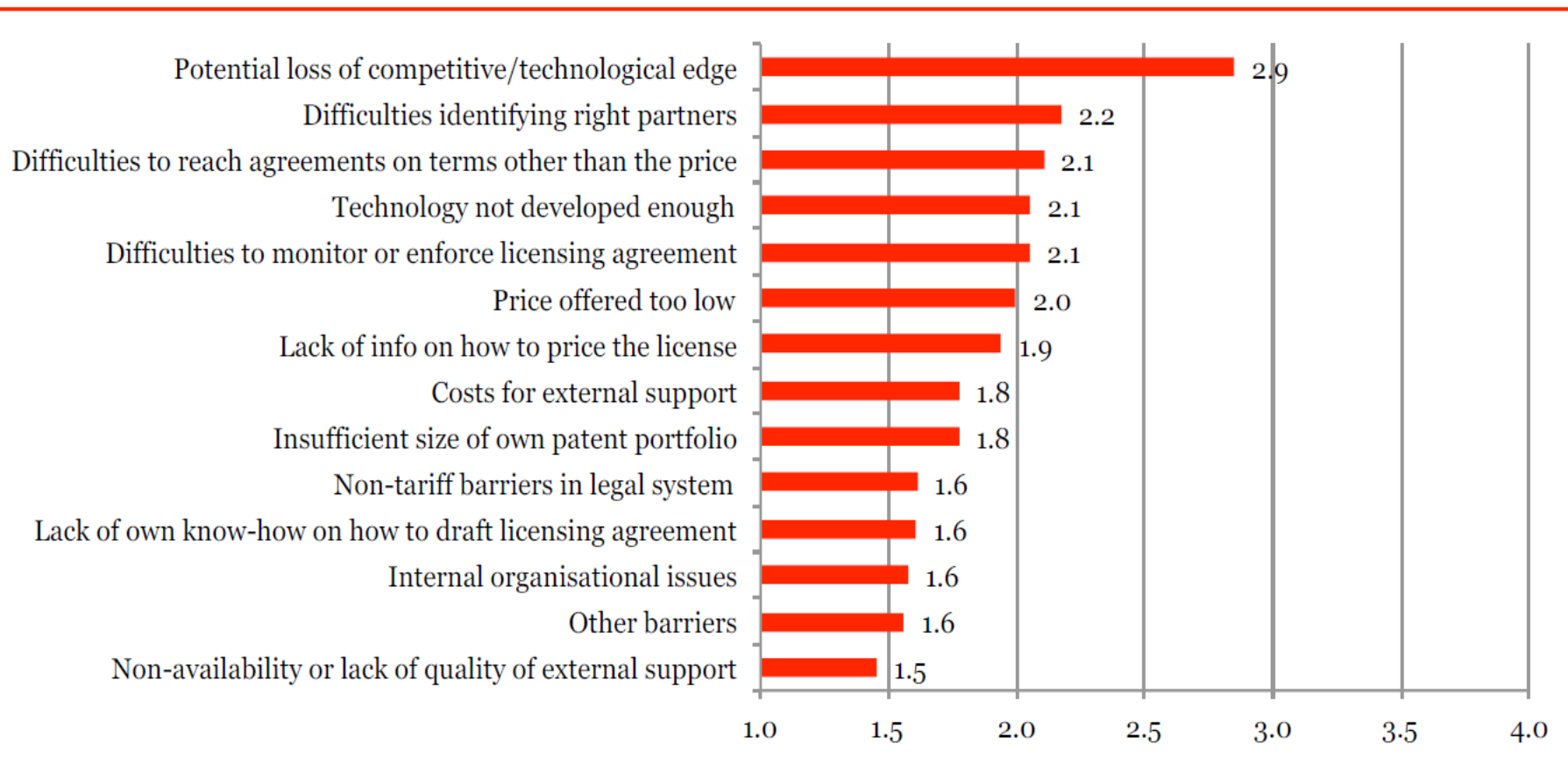


Arithmetic means on a scale from 1='unimportant motive' to 4='very important motive'

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



# Barriers to outlicensing patents

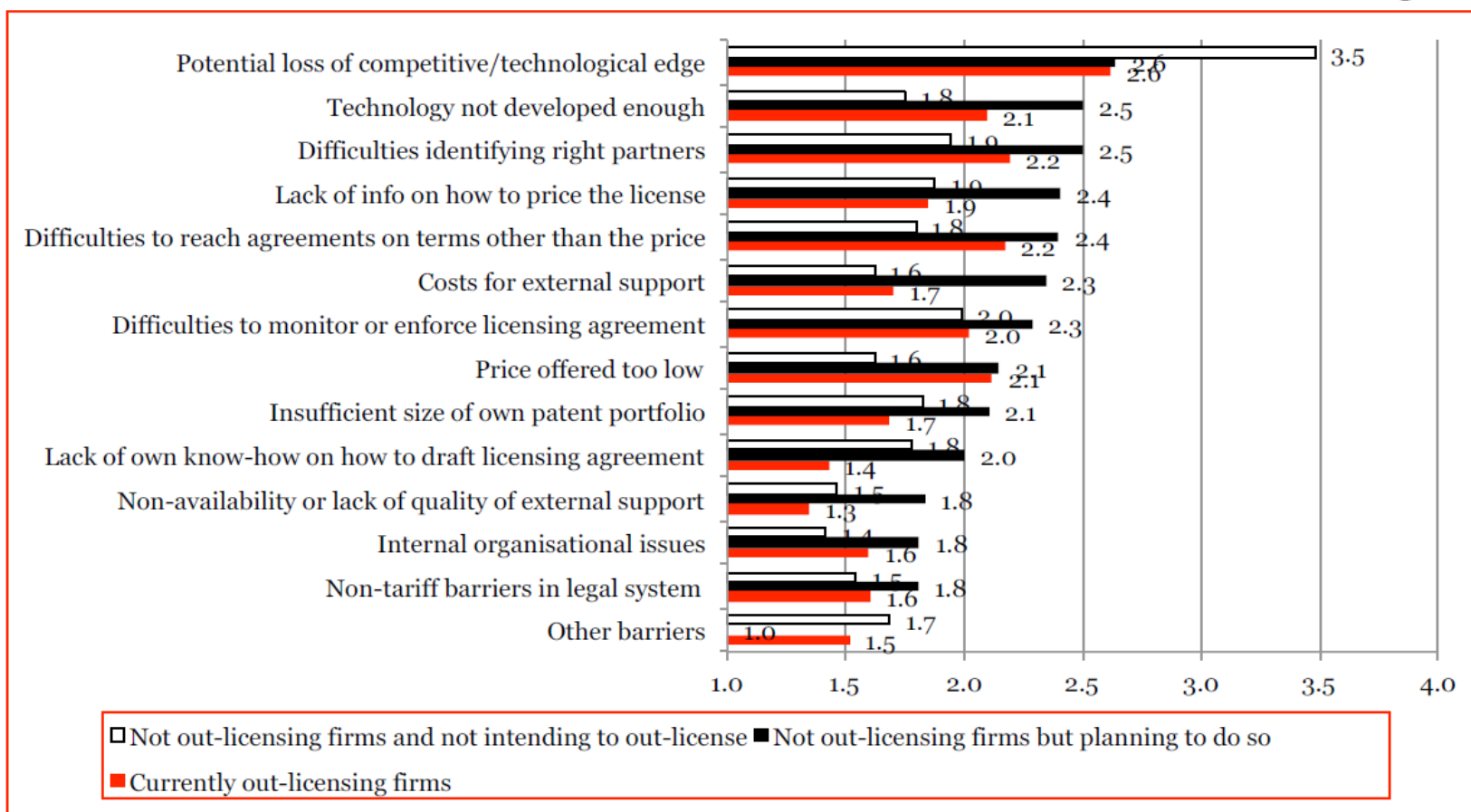


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# Barriers to outlicensing patents

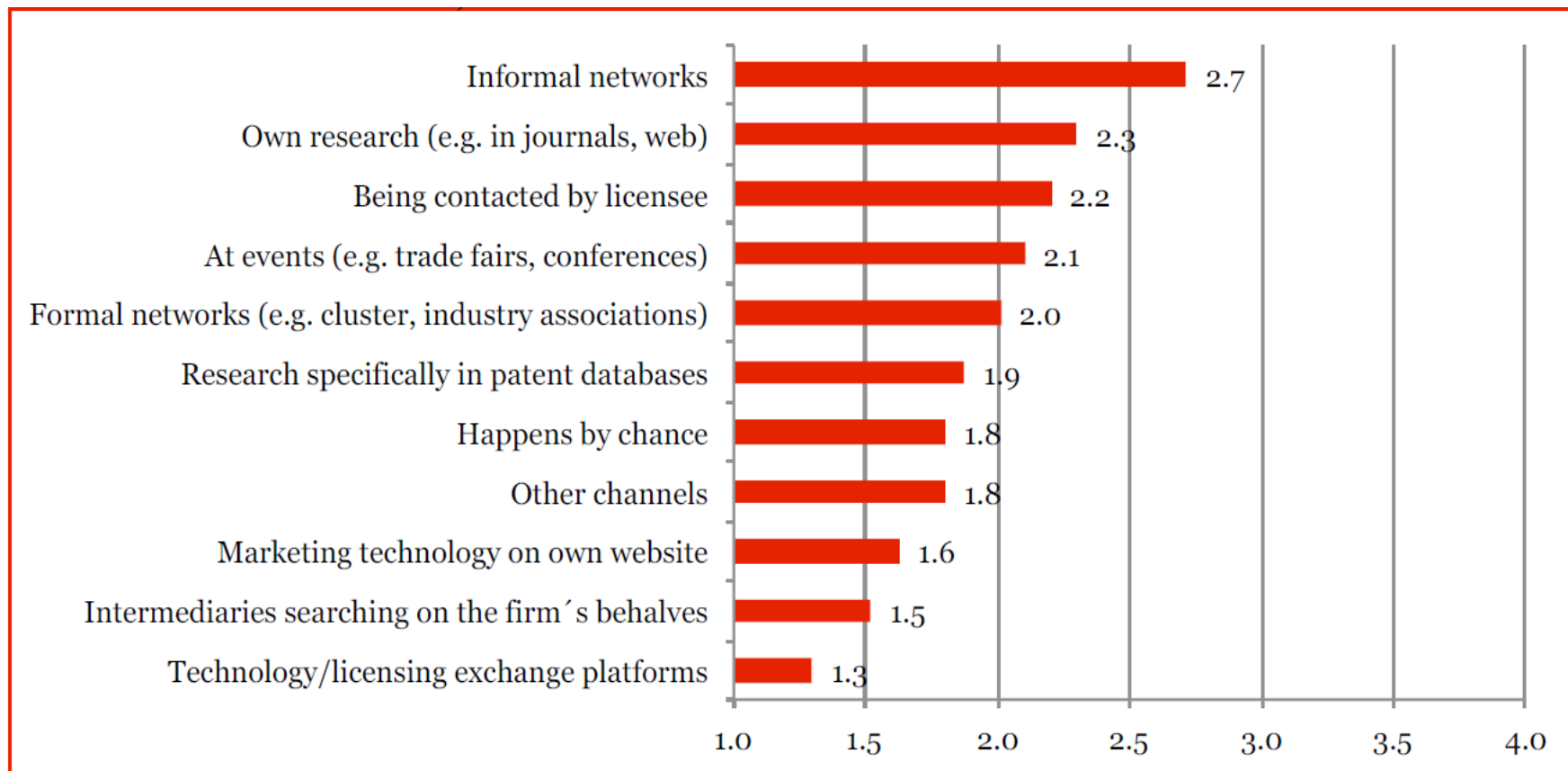


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Source: PATLICE Survey (Survey on patent licensing activities by patenting firms), European Commission



# Channels to find potential licensees

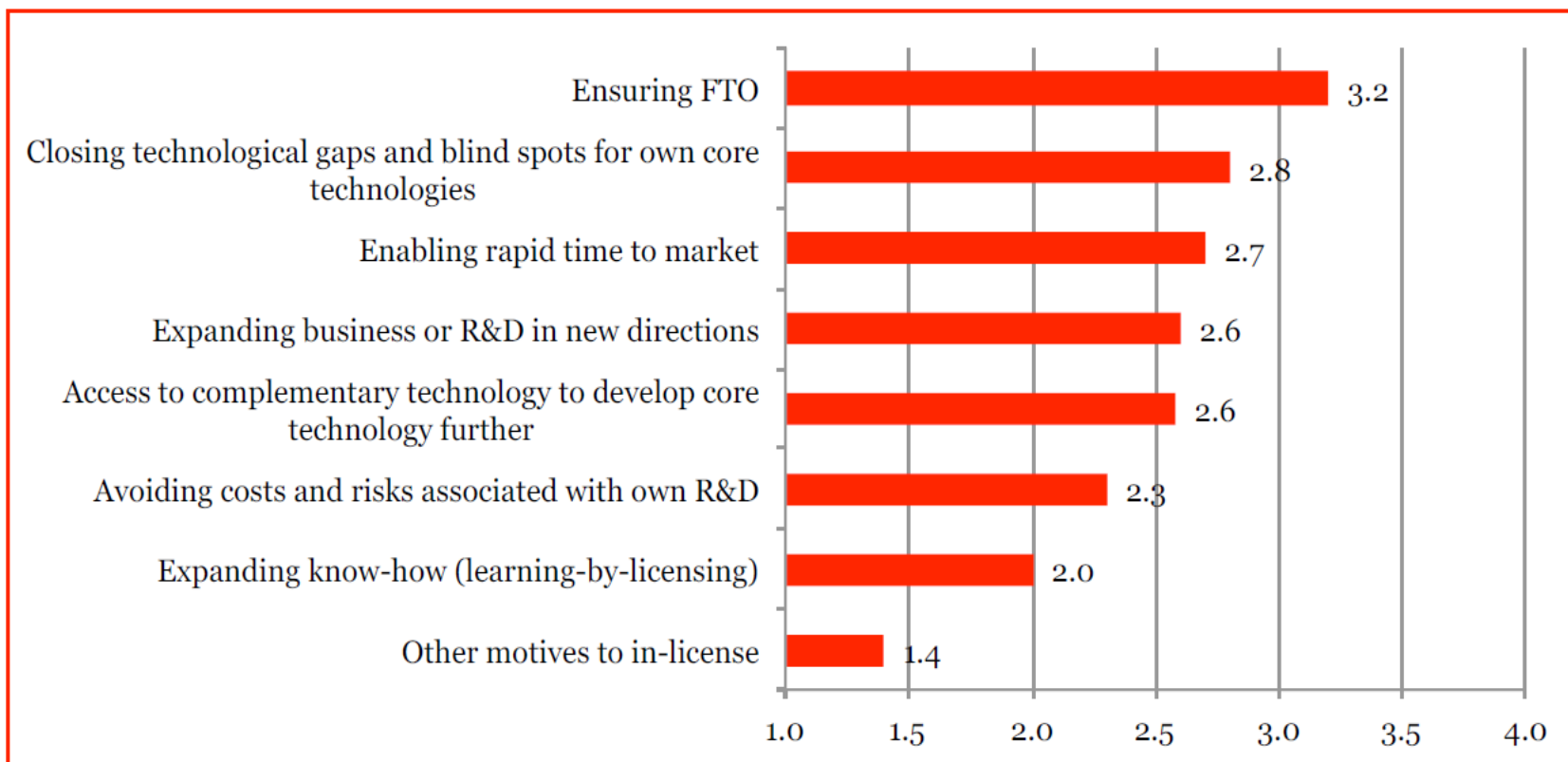


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# Motives for inlicensing patents



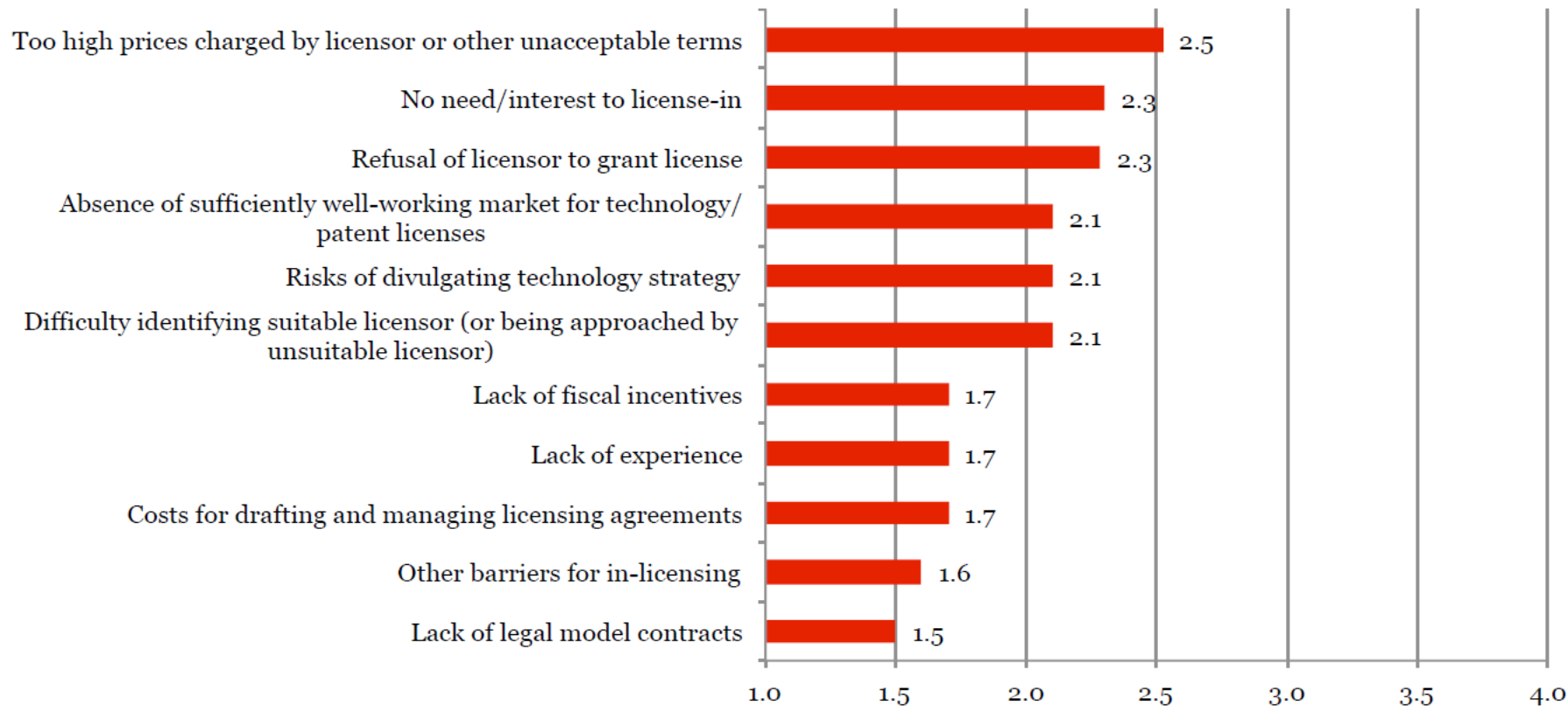
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# Barriers to inlicensing patents



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?**



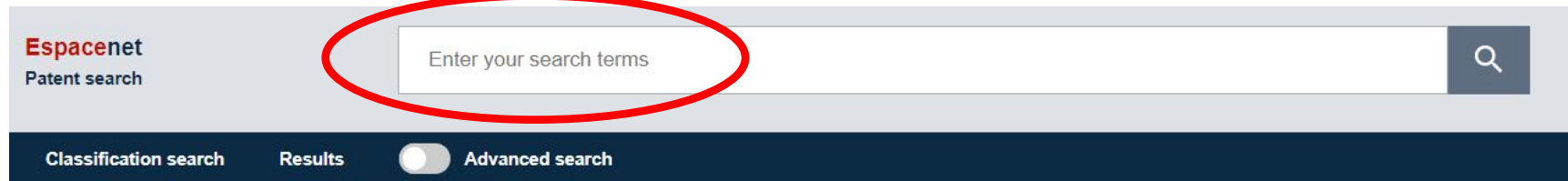
# Due diligence in patents

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



# The Espacenet database (over 110 million docs)

<https://worldwide.espacenet.com>



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


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## 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

**New training:  
„Licensing -  
Advanced“**



# Case study: Orcan Energy

<https://www.epo.org/learning/materials/sme/sme-case-studies.html>

Dr. Christian Hackl

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://iprhelpdesk.eu/news/case-study-orcan-energy>

[https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/european-ip-helpdesk/europe-case-studies\\_en](https://intellectual-property-helpdesk.ec.europa.eu/regional-helpdesks/european-ip-helpdesk/europe-case-studies_en)

Dr. Christian Hackl

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CASE  
STUDY

Licensing Out to China:  
The Case of Clean-Tech Company Orcan Energy

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# Licensing agreement negotiation

- A strategic choice
- A long standing relationship
- Legal, technical and financial aspects



# Negotiating licensing agreements

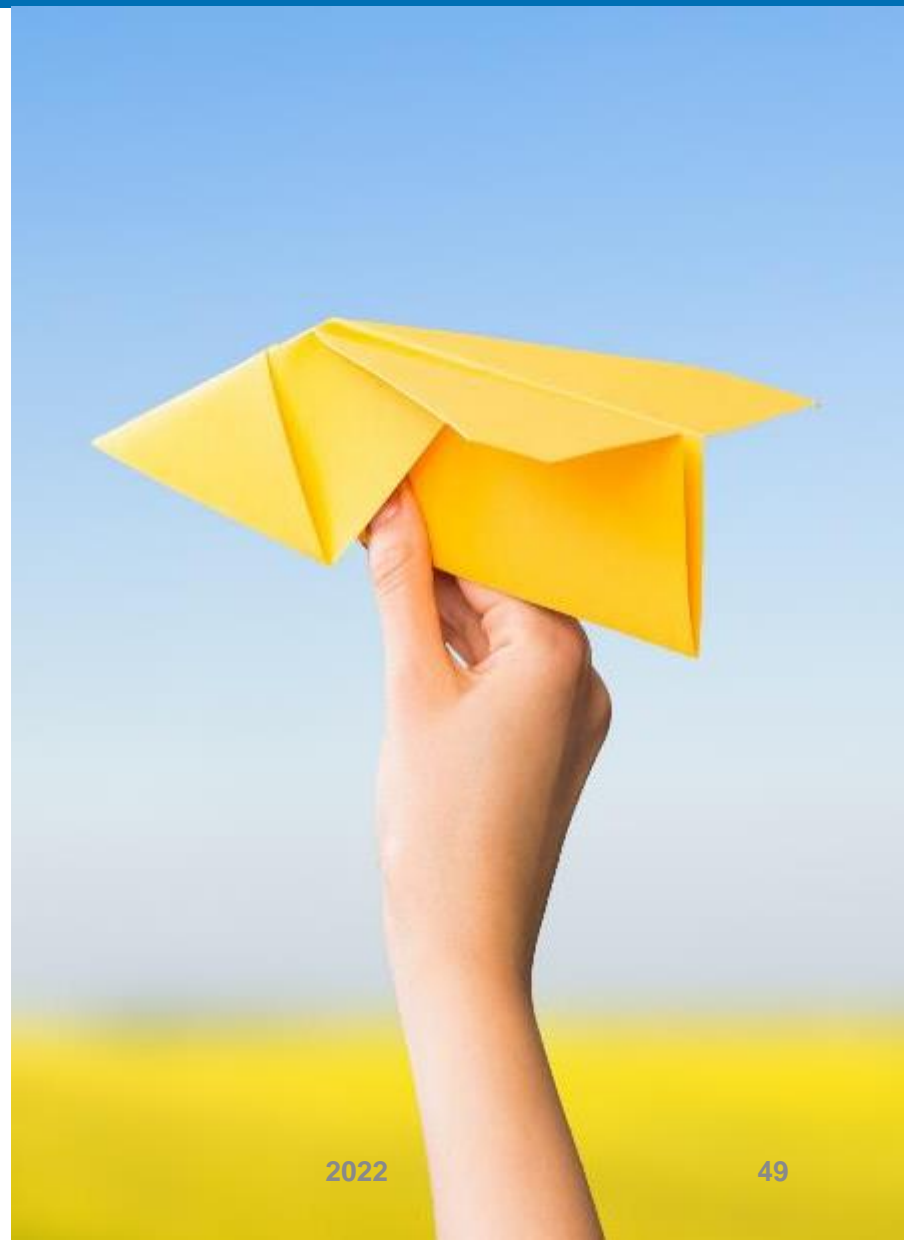
- Search for a win-win agreement
- Be sufficiently prepared to negotiate
- Seek “objective” criteria
- Discuss the agreement as a whole
- Time is always important





## Contact us!

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## DISCLAIMER

The European IP Helpdesk provides free-of-charge first-line support on IP-related issues aiming to help current and potential beneficiaries of EU-funded projects, as well as EU SMEs, manage their Intellectual Property assets.

The European IP Helpdesk is managed by the European Commission's 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).

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