



European IP Helpdesk

Stay ahead of the innovation game.

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

Feb. 10, 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



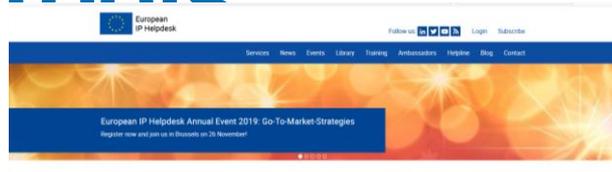


The EC IP Helpdesks

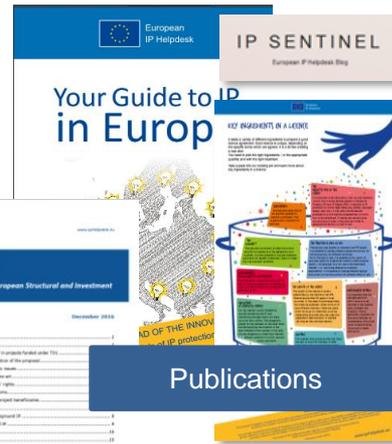




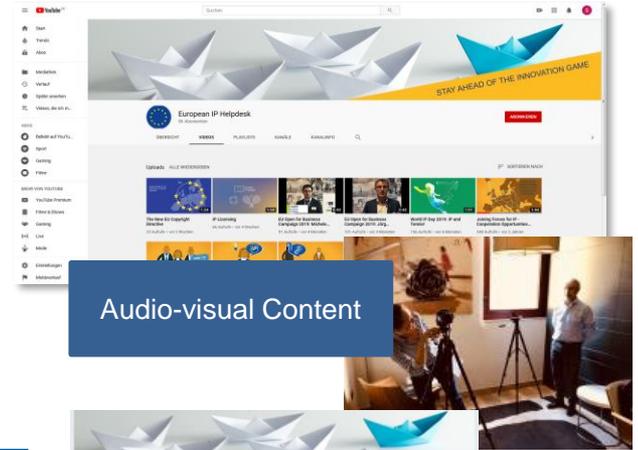
Communication Formats & Outreach Tools



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**





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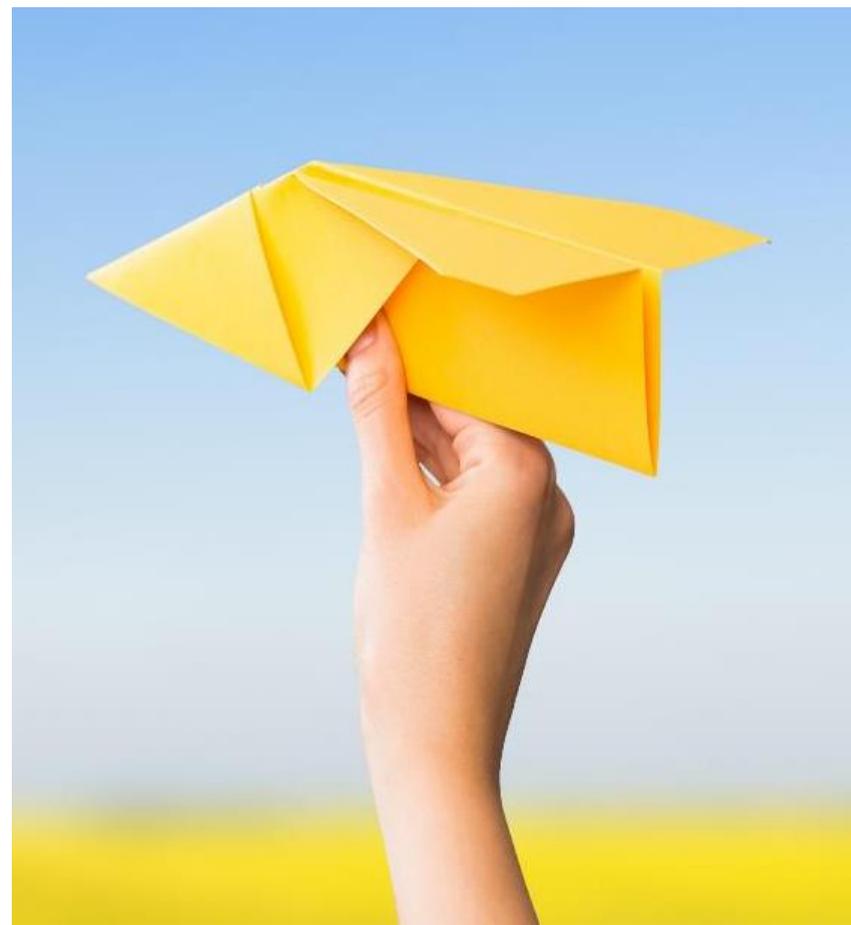
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Today's speaker

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)



Roadmap

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





Roadmap

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





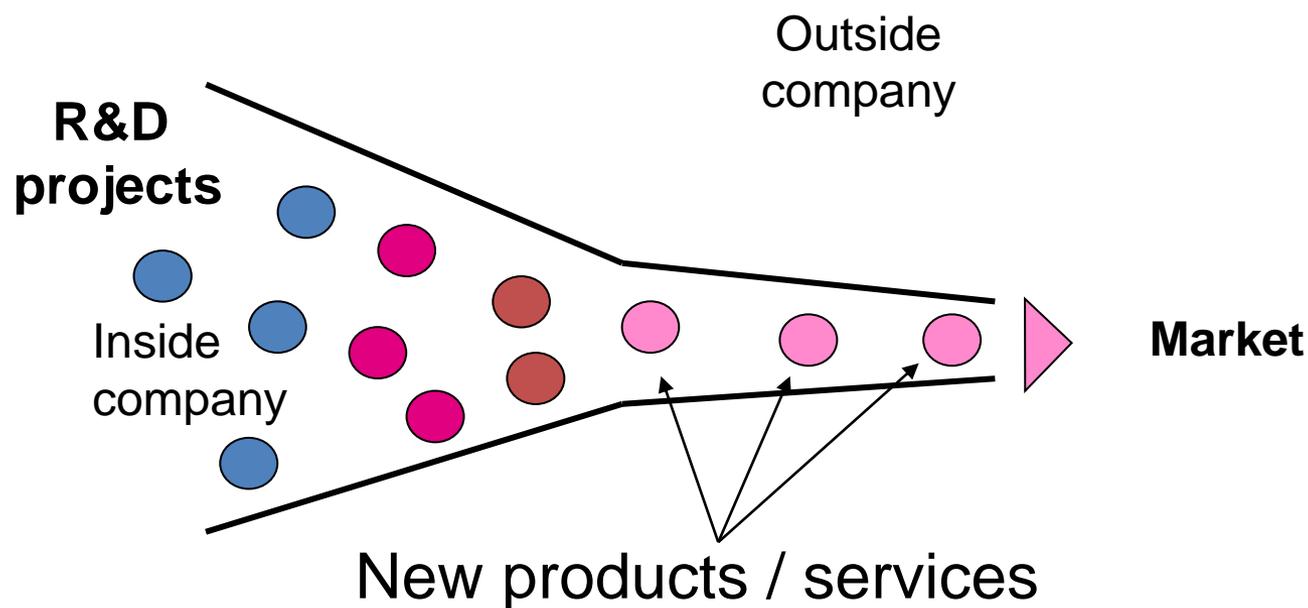
I. What is Technology Transfer?

“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)



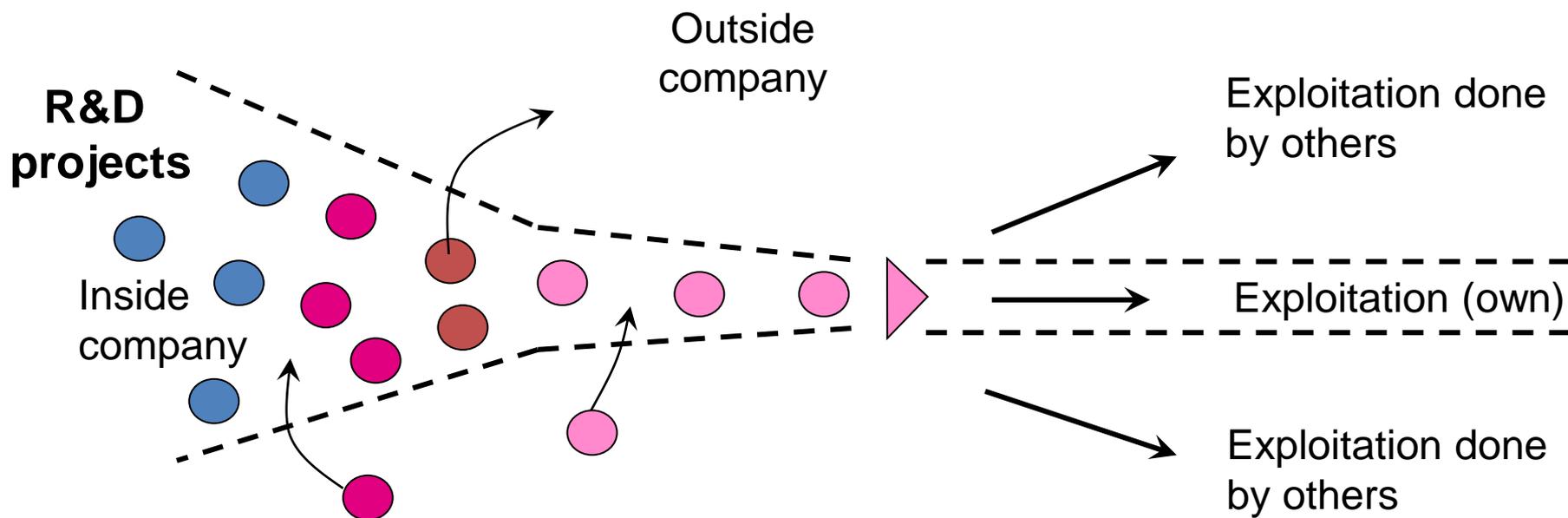
Closed Innovation



Ideas → Development → Testing → Launch



Open Innovation

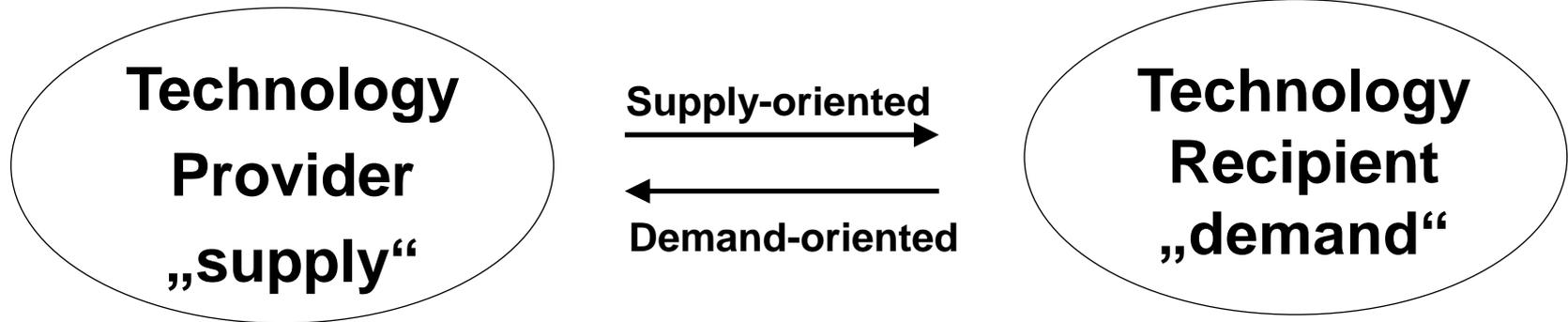


Ideas → Development → Testing → Launch

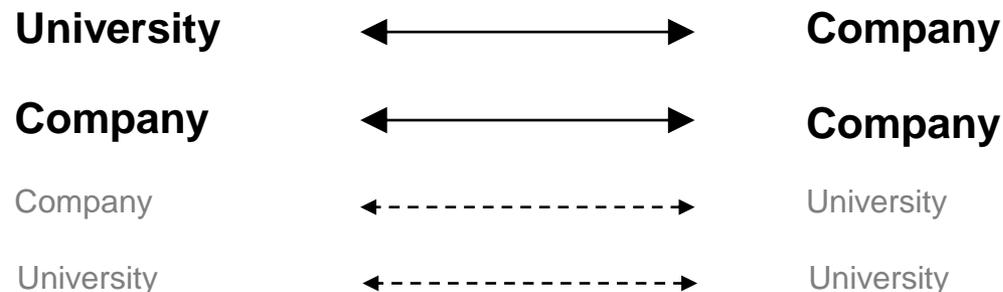
Commercialisation



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



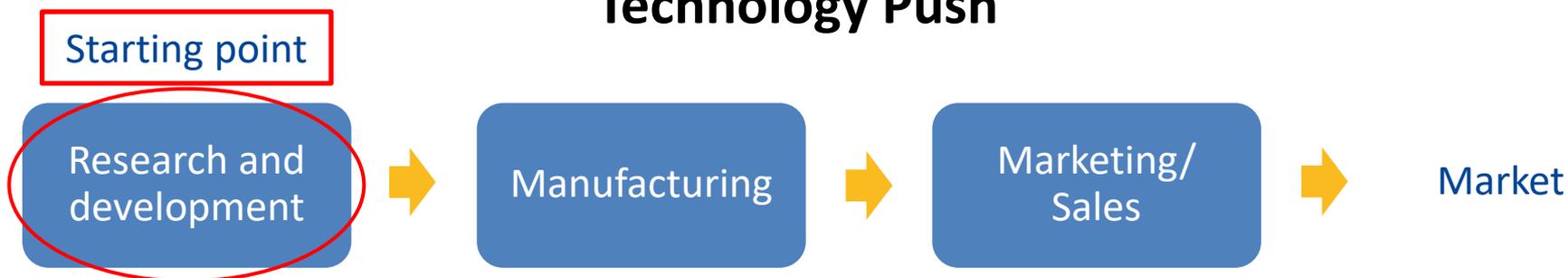
Why do universities engage in Technology Transfer?

- 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

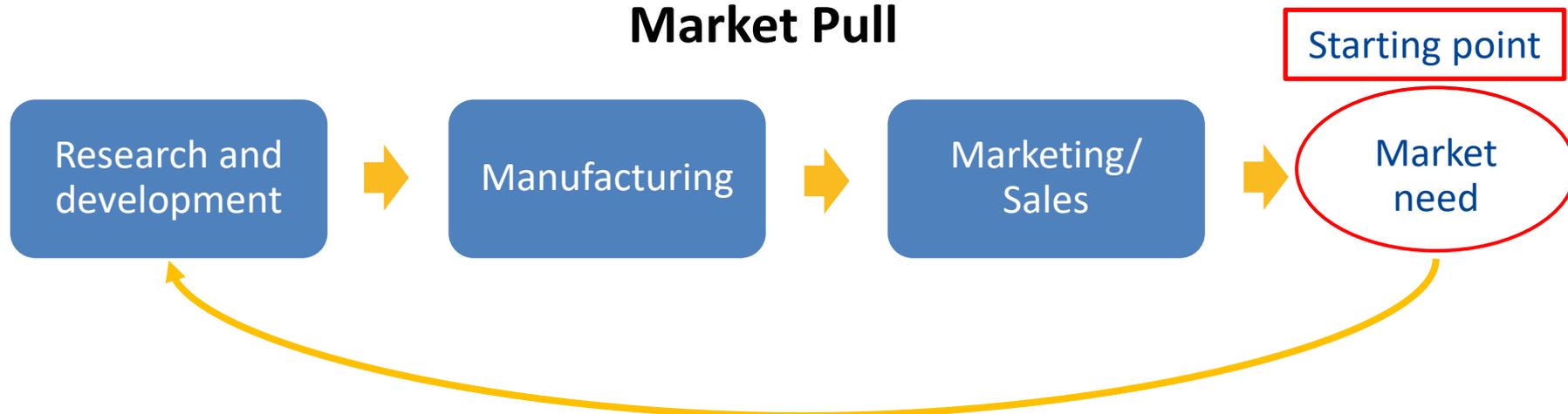


Technology Push vs Market Pull (I/II)

Technology Push



Market Pull





Roadmap

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 - I. Search for technology**
 - II. Screening of technology
 - III. Contractualisation
- III. Actors + Assistance





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/supplier)
- Support comes 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)



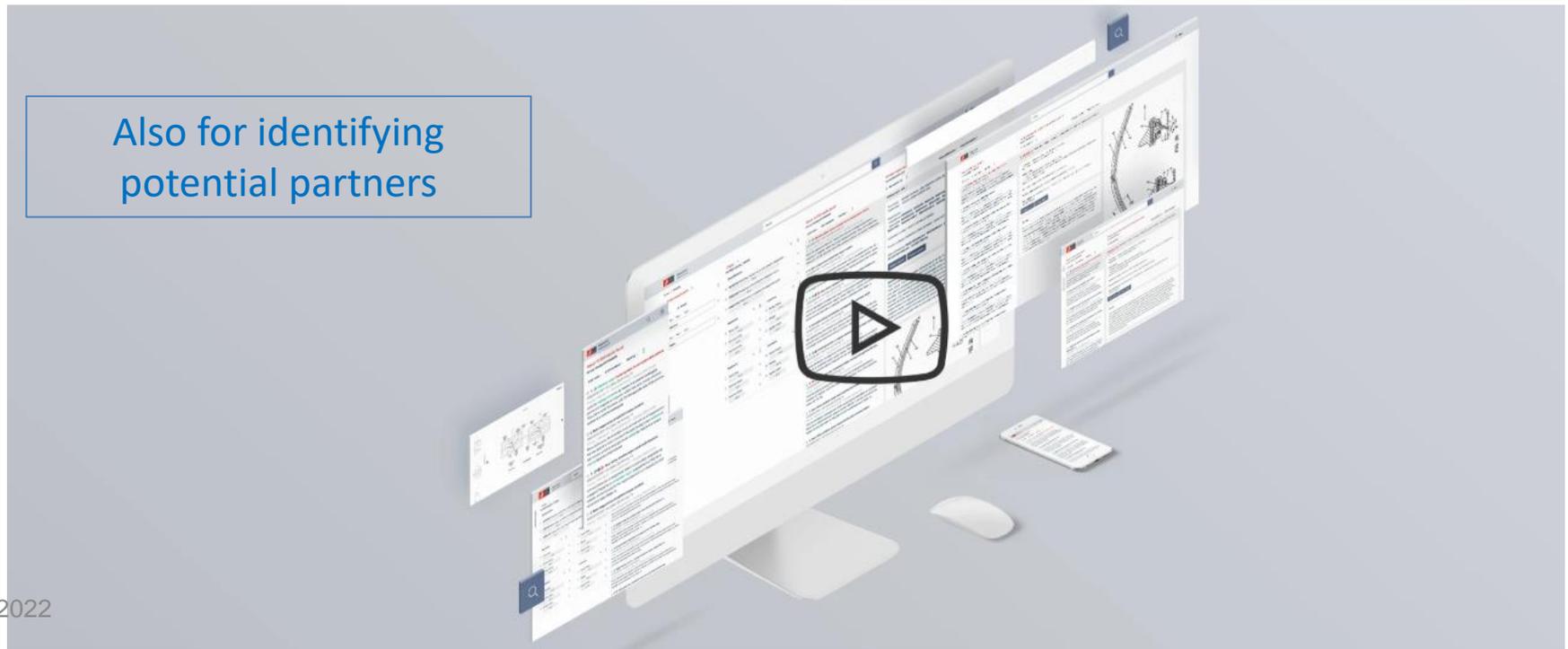
The Espacenet database (over 110 million docs)

<https://worldwide.espacenet.com>



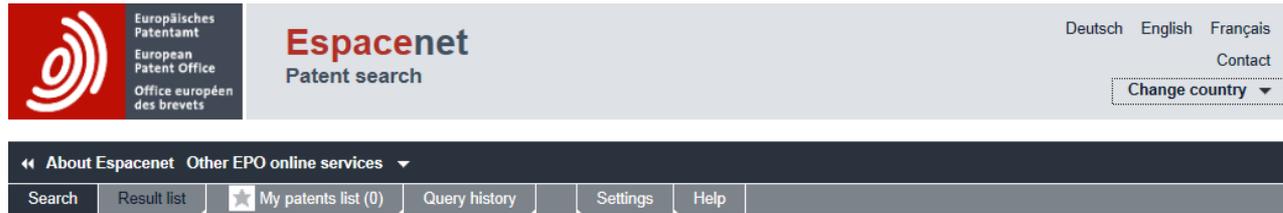
Espacenet: free access to over 110 million patent documents

Also for identifying
potential partners





The Espacenet database (over 110 million docs)




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

Quick access

Discussion forum

Classic Espacenet



The Espacenet (n docs)

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AND ▾ + Field ×

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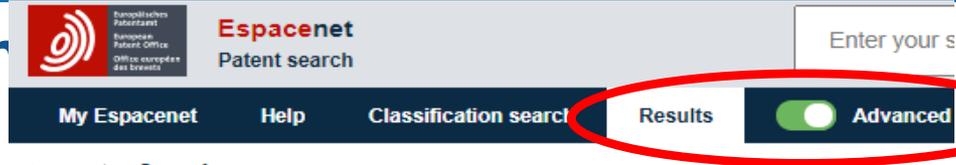
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The Espacenet (on docs)

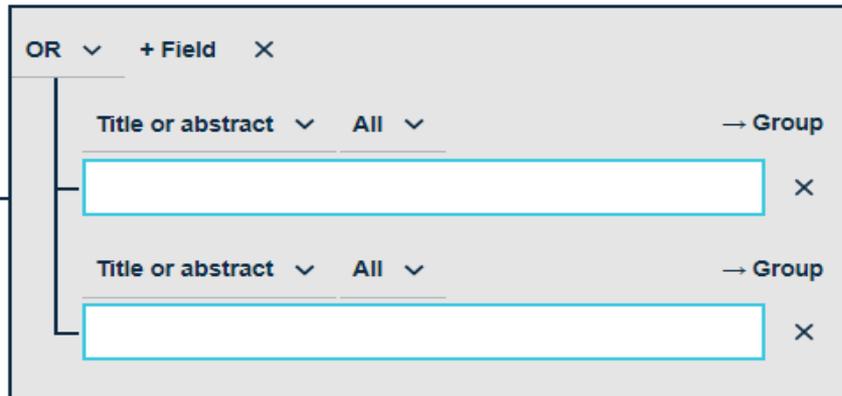


The Espacenet Patent search interface header. It includes the Espacenet logo, a search input field with the placeholder text "Enter your s", and a navigation bar with the following items: "My Espacenet", "Help", "Classification search", "Results", and "Advanced". The "Results" and "Advanced" items are circled in red.

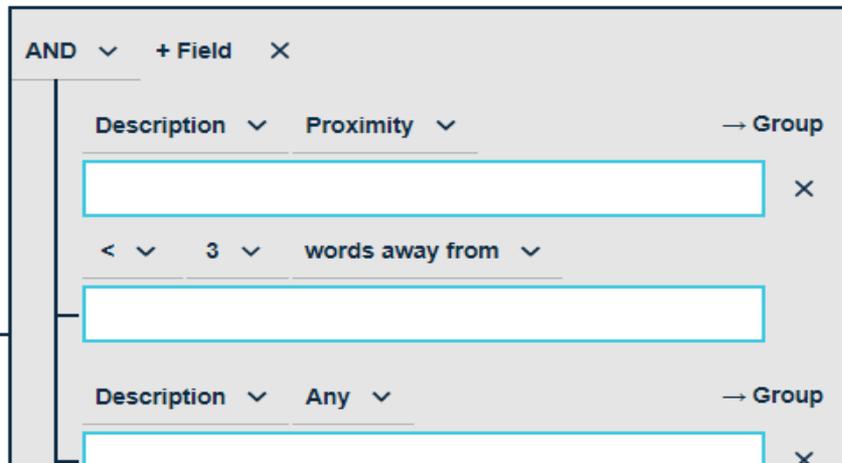
Home > Search

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A search criteria panel with a grey background. It features a header "OR ▾ + Field ×". Below the header, there are two identical search criteria entries. Each entry consists of a dropdown menu set to "Title or abstract", another dropdown menu set to "All", and a "→ Group" link. Below each dropdown menu is a text input field with a blue border and a small "×" icon to its right.



A search criteria panel with a grey background. It features a header "AND ▾ + Field ×". Below the header, there are two search criteria entries. The first entry consists of a dropdown menu set to "Description", another dropdown menu set to "Proximity", and a "→ Group" link. Below these dropdowns is a text input field with a blue border and a small "×" icon to its right. Below the text input field, there are three more dropdown menus: the first is set to "<", the second is set to "3", and the third is set to "words away from". The second entry consists of a dropdown menu set to "Description", another dropdown menu set to "Any", and a "→ Group" link. Below these dropdowns is a text input field with a blue border and a small "×" icon to its right.



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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“**

Legal

Is there valid IP-
protection?

Market

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



Screening of technology

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

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

***Webinar on
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***



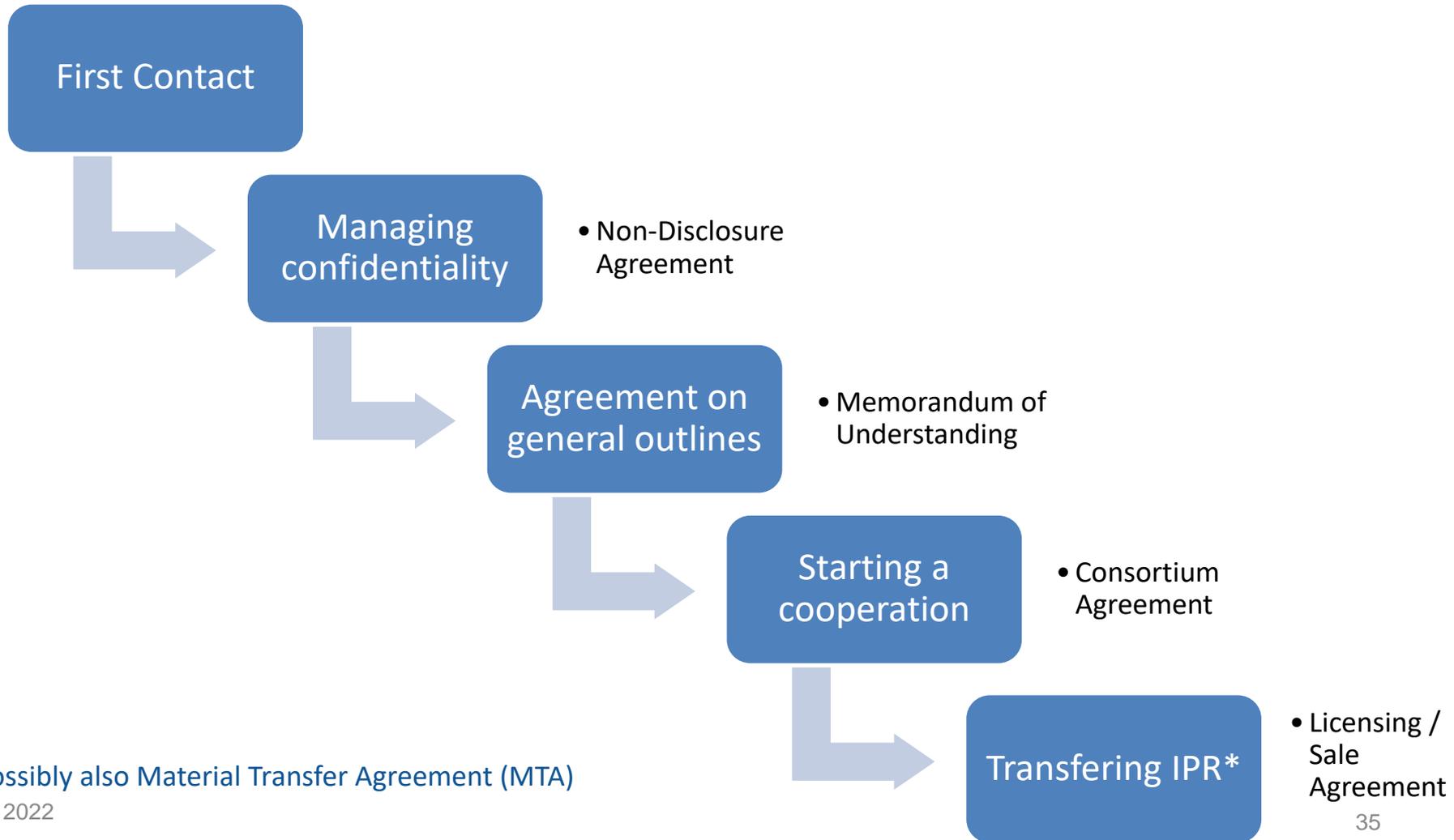
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Contractualisation of a transaction





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



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Webinar on Commercialisation and Licensing



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



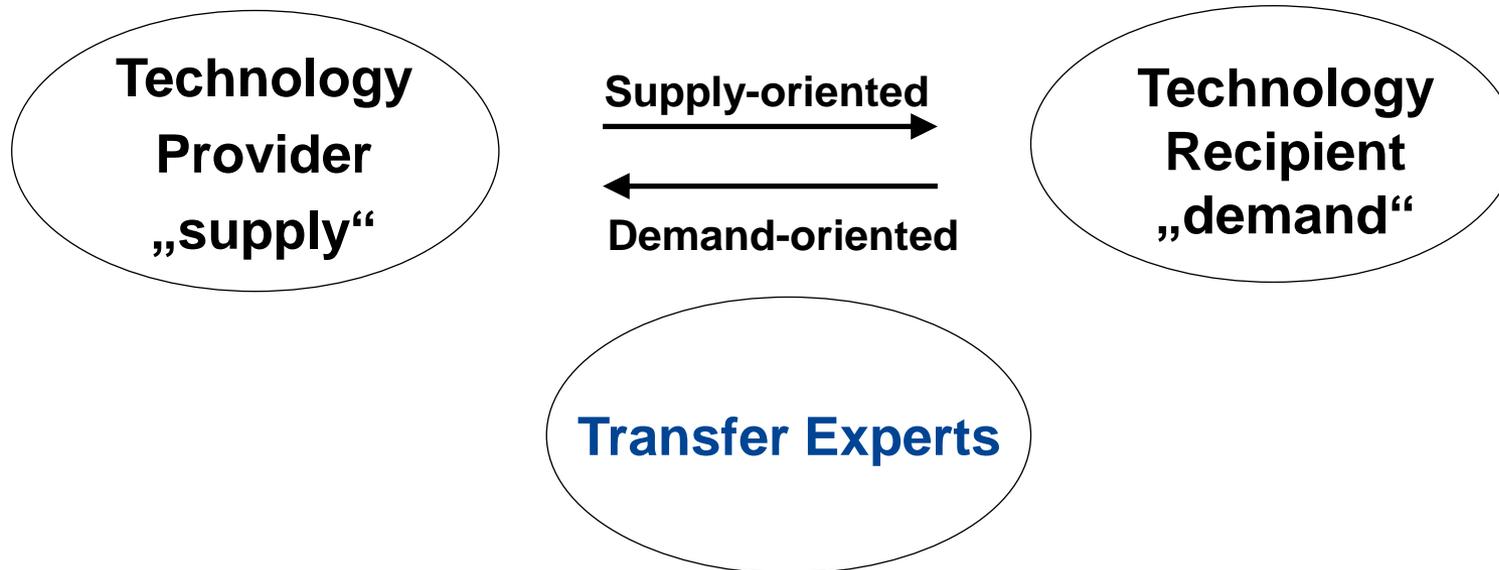
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- I. What is Technology Transfer?
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Professionals experienced in different aspects of Technology Transfer



- 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 EU 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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