European IP Helpdesk

Stay ahead of the innovation game.

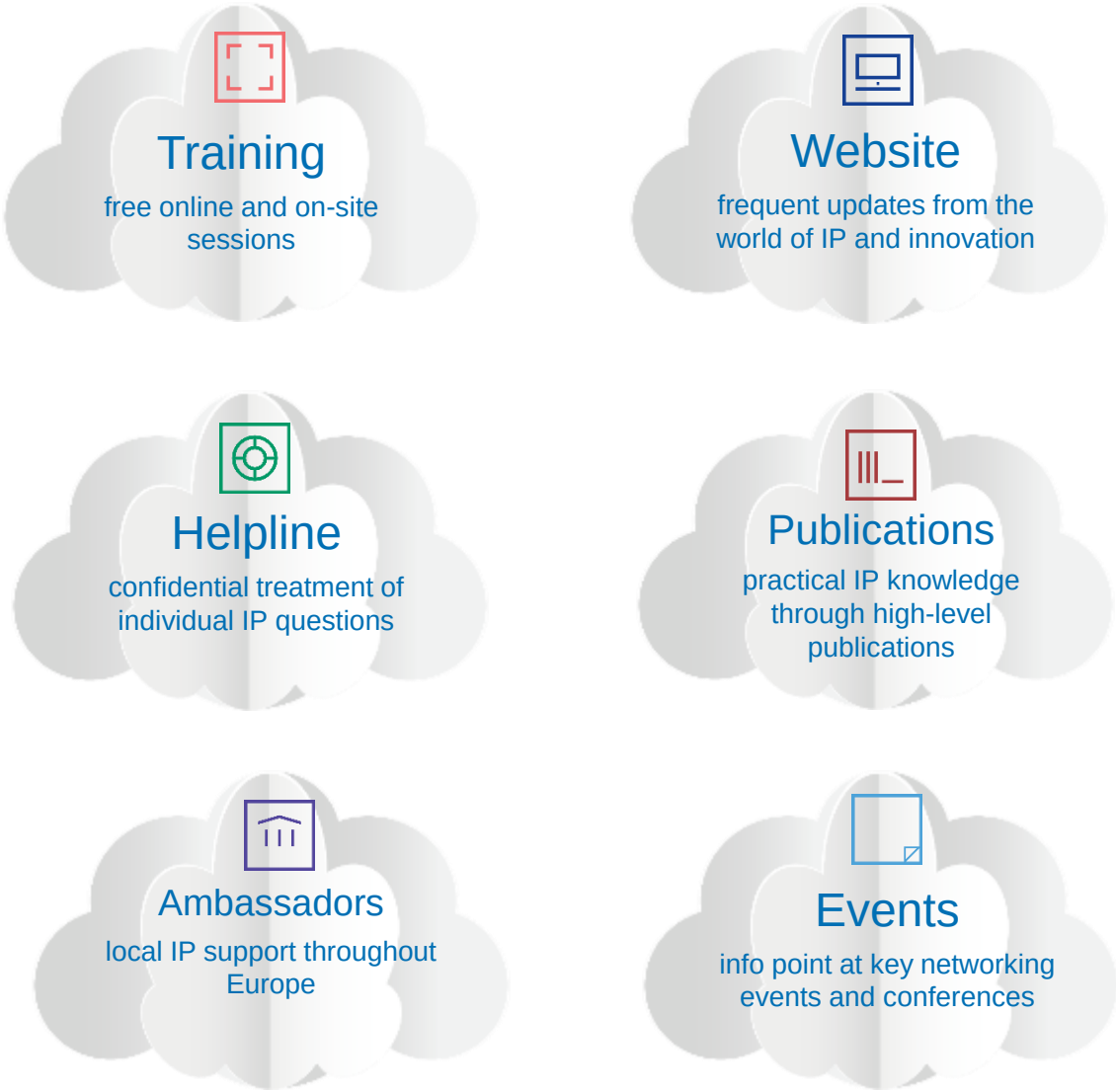
Facing challenges: Knowledge Valorisation of intellectual assets

Jakob Haardt, EUIPH

30 November 2023

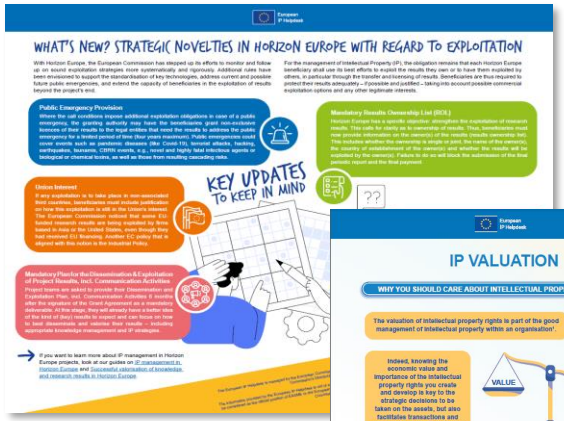
European IP Helpdesk

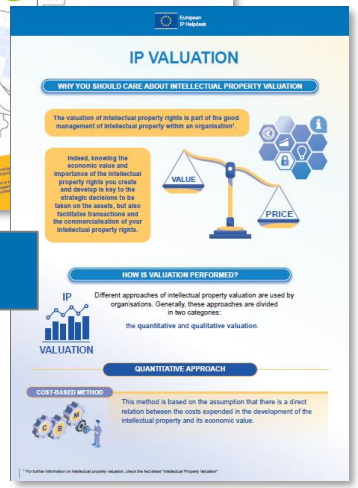
- Service initiative of the European Commission
- Addressing **current and potential beneficiaries of EU-funded projects, researchers and EU SMEs**
- Free-of-charge first-line support on intellectual property (IP)
- Hands-on IP and innovation management support
- International pool of IP experts from various thematic fields
- Unique cooperation scheme with the Enterprise Europe Network: 44 ambassadors from 27 EU countries



European
IP Helpdesk

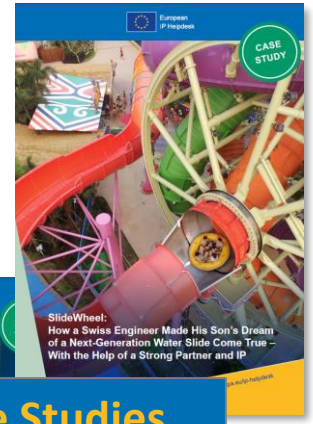
ec.europa.eu/ip-helpdesk

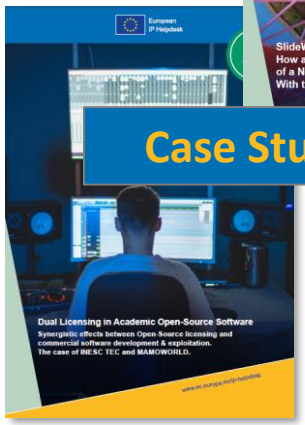




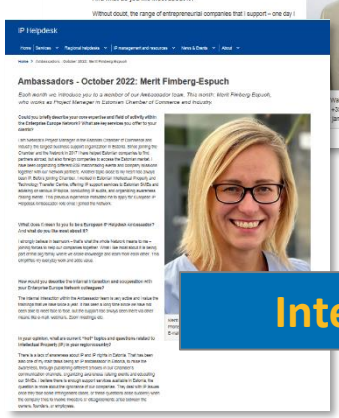
Infographics

Fact Sheets





Case Studies

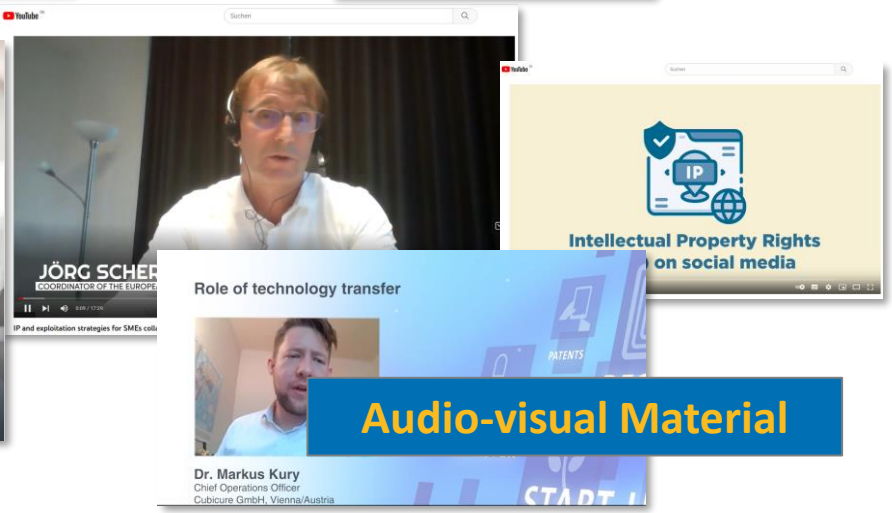


Interviews

IP Specials

Guides

Podcast

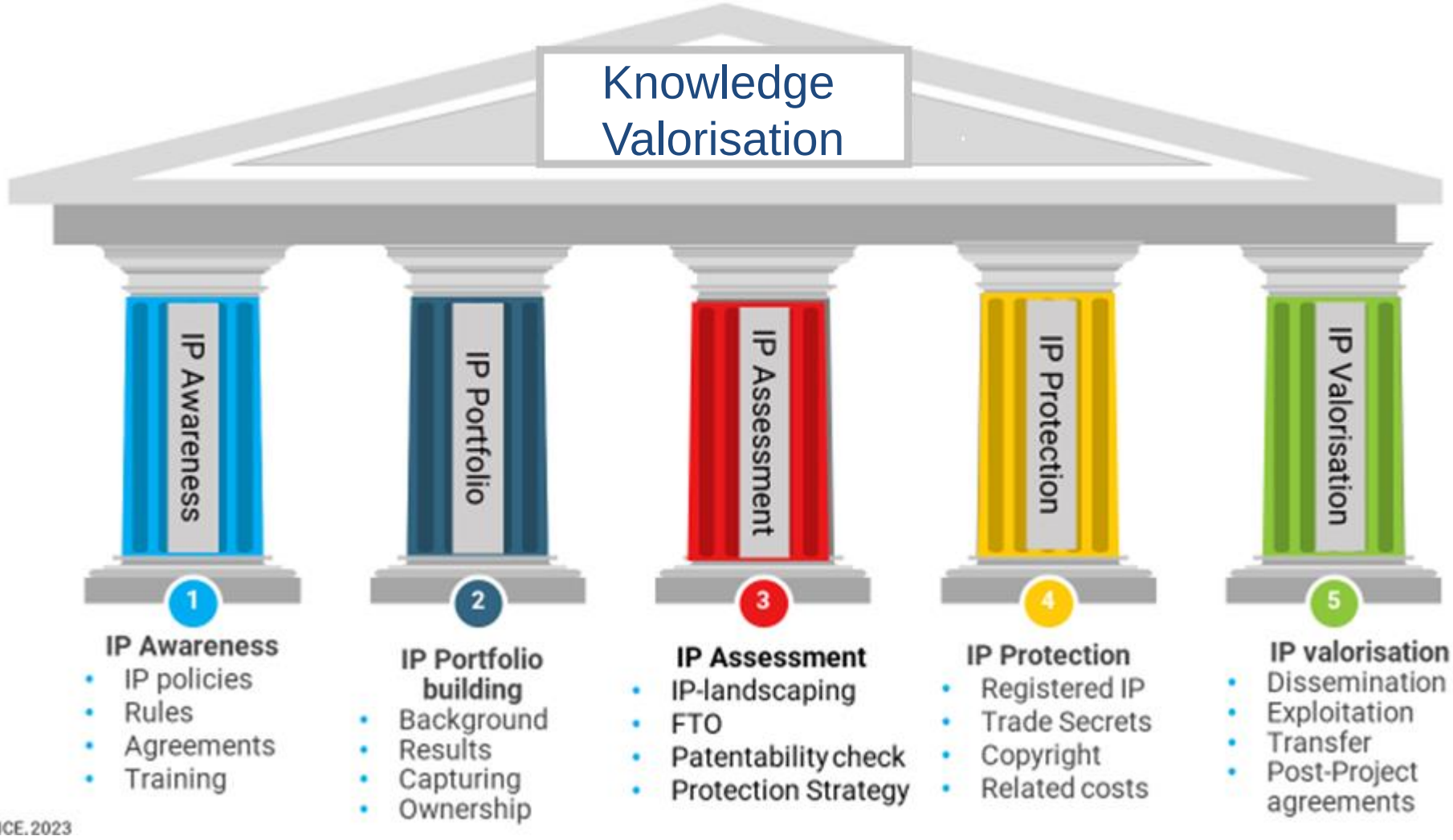


Audio-visual Material

Agenda for today

- **Knowledge Valorisation – Three key areas of the Code of practice:**

1. Establishing a *strategy* for the efficient management of intellectual assets
2. *Managing* intellectual assets
3. From Intellectual asset creation to the *market*


Knowledge
Valorisation
IP Awareness
IP Portfolio
IP Assessment
IP Protection
IP Valorisation
1
2
3
4
5
IP Awareness
IP policies
Rules
Agreements
Training
IP Portfolio building
Background
Results
Capturing
Ownership
IP Assessment
IP-landscaping
FTO
Patentability check
Protection Strategy
IP Protection
Registered IP
Trade Secrets
Copyright
Related costs
IP valorisation
Dissemination
Exploitation
Transfer
Post-Project agreements
EURICE.2023

1.

Establishing a strategy for the efficient management of intellectual assets

Knowledge Valorisation – Establishing a strategy for the efficient management of intellectual assets

- Establishing a ***strategy*** for all intellectual assets generated in research (collaborations) is crucial
  - particularly those results which are developed collaboratively and jointly owned

- A proper IP strategy is essential to support exploitation of key results
  - Establish a systematic approach to capture and manage intangible assets, e.g. for technology upscaling, licensing, transfer, access to finance, etc.

- Define appropriate measures to a) give access to existing IP, b) to define ownership, c) to protect, d) to share and e) to exploit newly created IP

Intellectual Property needs action!

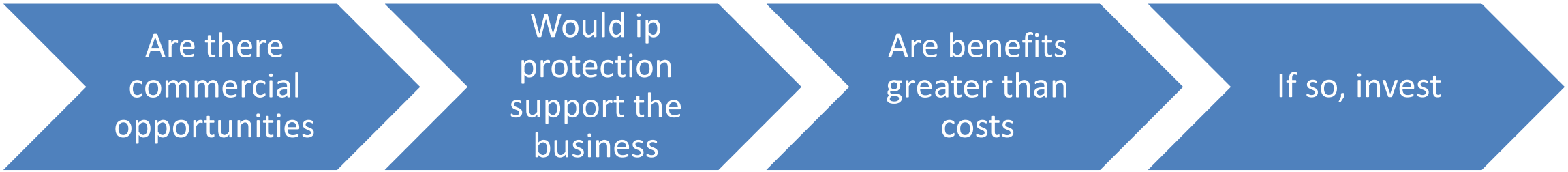
Intellectual Property Rights allow your organisation to prevent competitors from using your intellectual assets.

BUT Intellectual Property Rights require **action**: ownership ≠ protection!

Therefore it is vital that your **Intellectual Property asset** be:

- ✓ *Protected*
- ✓ *Managed*
- ✓ *Enforced*

IP protection is a strategic Commercial decision



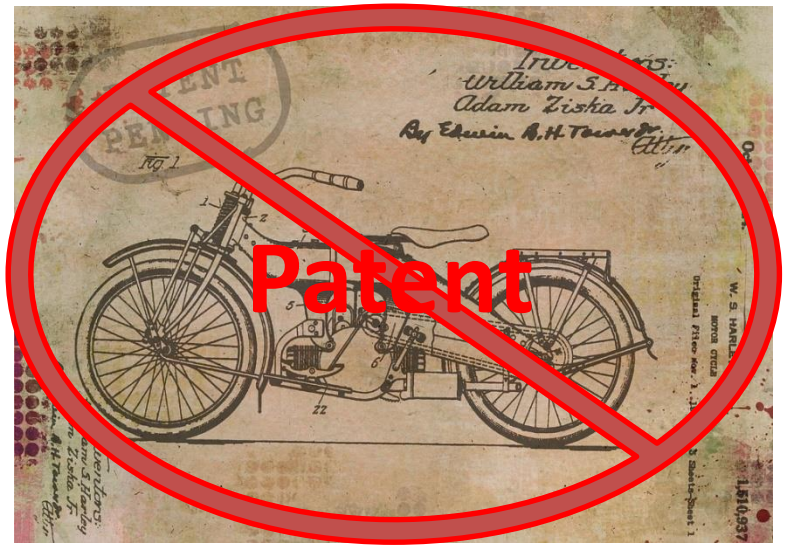
Assessment, protection and exploitation must be considered together

Beware of early disclosures:

- If protection is a strategic commercial decision, you should avoid early disclosures.
- No dissemination of results should take place before decision is made regarding their possible protection, and should follow a **dissemination check-list**:
  - Take a decision about the **protection** of results and all required steps
  - Beware not to infringe third parties' intellectual property rights
  - Open access as a general principle of scientific dissemination

Or use early discosure for your strategy:

- **DEFENSIVE PUBLICATIONS**
- By publishing all information regarding Intellectual Property Produced, the inventor ensures that neither he nor anybody else may be granted a patent on the subject or in connected fields to the information published



Objective: Ensure technology is part of the state of the art:

NO NOVELTY = NO PATENT(s)

Scientific publications and copyright protection

Copyright

- Does not protect the ideas themselves but only the concrete form of expression of ideas
- The creativity protected is the originality of the authored work!
- No formal registration process is required
- Copyright protection arises automatically upon creation of the work, provided that it is original

→ Generally, protection lasts for 70 years after the death of the creator.

Copyright

- **What are copyright and related rights?**
  - **Copyright protects literary and artistic works**, such as poems, novels, music and paintings, but also cinematographic works, architectural works and many others. Related rights are related to the protection of works of authorship under copyright. Their purpose is to **protect the legal interests of certain persons and legal entities who contribute to making works available to the public** such as performing artists, producers of phonograms, broadcasters, etc.
- **What are the rights granted?**
  - Copyright owners can prohibit or authorise that their works be:
    - copied or reproduced (e.g. printed publications or sound recordings)
    - distributed to the public
    - performed in public
    - translated into other languages
    - adapted, such as novel into screenplay…

Open Access Vs Copyright

Copyright and Open Access may co-exist.

However, by applying the Open Access scheme the copyright owner waives his **economic** rights, namely:

- copied or reproduced (e.g. printed publications or sound recordings)
- distributed to the public
- performed in public
- translated into other languages
- adapted, such as novel into screenplay…

Open Science

Open Access

Not an obligation to disseminate (publish) or ignore IP rights

- The dissemination of results **can be postponed** to allow the appropriate protection of results beforehand
- **If/when** a scientific article, research data, is published, it **will have to be in open access**

At the latest upon publication:

deposit in a **trusted repository**, and **ensure open access** via the repository **under CC BY licence**, or equivalent

Owners of the copyright must:

retain sufficient intellectual property rights (copyright) to comply with the OA requirements

AAM: Accepted Author Manuscript. VoR: Final version

Open Data:

Regarding the digital research data generated, openness is often encouraged by the funder. To comply, you have to:

(a) deposit data in a research data repository and take measures to make it possible for third parties to access, mine, exploit, reproduce and disseminate — free of charge for any user — the following:
- (i) the data, including associated metadata, needed to validate the results presented in scientific publications as soon as possible;
- (ii) other data, including associated metadata

(b) provide information — via the repository — about tools and instruments at the disposal of the beneficiaries and necessary for validating the results (and — where possible — provide the tools and instruments themselves)

Open ≠ unprotected or no IPR

Copyright protects the scientific publication

Copyright protects (creative) data

Database right protects the collection if there has been a "substantial investment" in obtaining, verifying or presenting the contents of the database

Other protection for other aspects of the creation/invention (IP Rights, secrecy, NDA, contracts, etc)

As open as possible

As closed as necessary

Its NOT about making results free for commercial use

Source: Nigel Clarke, 2023

Works in open access are usually protected by copyright, other IP rights may protect the underlying content

e.g. a publication **made available as open access**, may also have the method described protected by a **patent** and/or **design rights**, and software code protected by **copyright**

2.

Managing intellectual assets

Knowledge Valorisation – Managing intellectual assets

- Efficient intellectual assets ***management*** is key to **accelerate the uptake of innovative solutions** and to develop new technologies, products, and services to address the most pressing societal challenges such as ensuring fair green and digital transitions

- The objective of an intellectual assets management strategy is to **build a portfolio of valuable intellectual assets** that can be strategically managed for use across multiple value creation paths

Identification of Key Exploitable Results

- A Key Exploitable Result (KER) is an identified main interesting result, which has been selected and prioritized due to its **high potential to be "exploited" –** meaning to make use and derive benefits- downstream the value chain of a product, process or solution, or act as an important input to policy, further research or education.

Ownership

Clarify **ownership of intellectual assets** as early as possible including access and use rights (for example, for research, education, or commercial exploitation purposes), background, results and relevant third-party intellectual assets (for example, to facilitate investments and other financial arrangements).

Before the start of the project, prepare a list identifying all **background results**, including IP, and relevant sideground information belonging to each of the partners and expected to be used during the project and update the list if necessary.

During the project's lifetime, keeping track of the results generated and their envisaged owner. At the end of the project, preparing a **'Results Ownership List'** identifying all results generated and define their exploitation path.

Ensure that a **Joint Ownership and Management Agreement** is established where IP is jointly owned.

Ownership of Results

- Given the collaborative nature of most projects, some results can be jointly developed by several participants. Hence, situations of joint ownership might arise.

→ **Joint Ownership Agreements** (i.e. defining specific conditions for granting licenses or issues related to costs of protection and sharing of potential revenues); Default rule in Consortium Agreement

3.

From Intellectual asset creation to the market

Knowledge Valorisation – From Intellectual asset creation to the market

- Establish a clear **collaboration agreement** defining in particular the scope of collaboration, the valorisation strategy, the dissemination and exploitation of results (such as licensing or transfer of results, spin-off creation), and the intellectual assets management strategy covering the project's lifecycle and beyond.

- Prepare a thorough **intellectual assets risk analysis**, including freedom-to-operate analysis to identify the critical components in cases where a technology is to be developed, validated, and brought to the market.

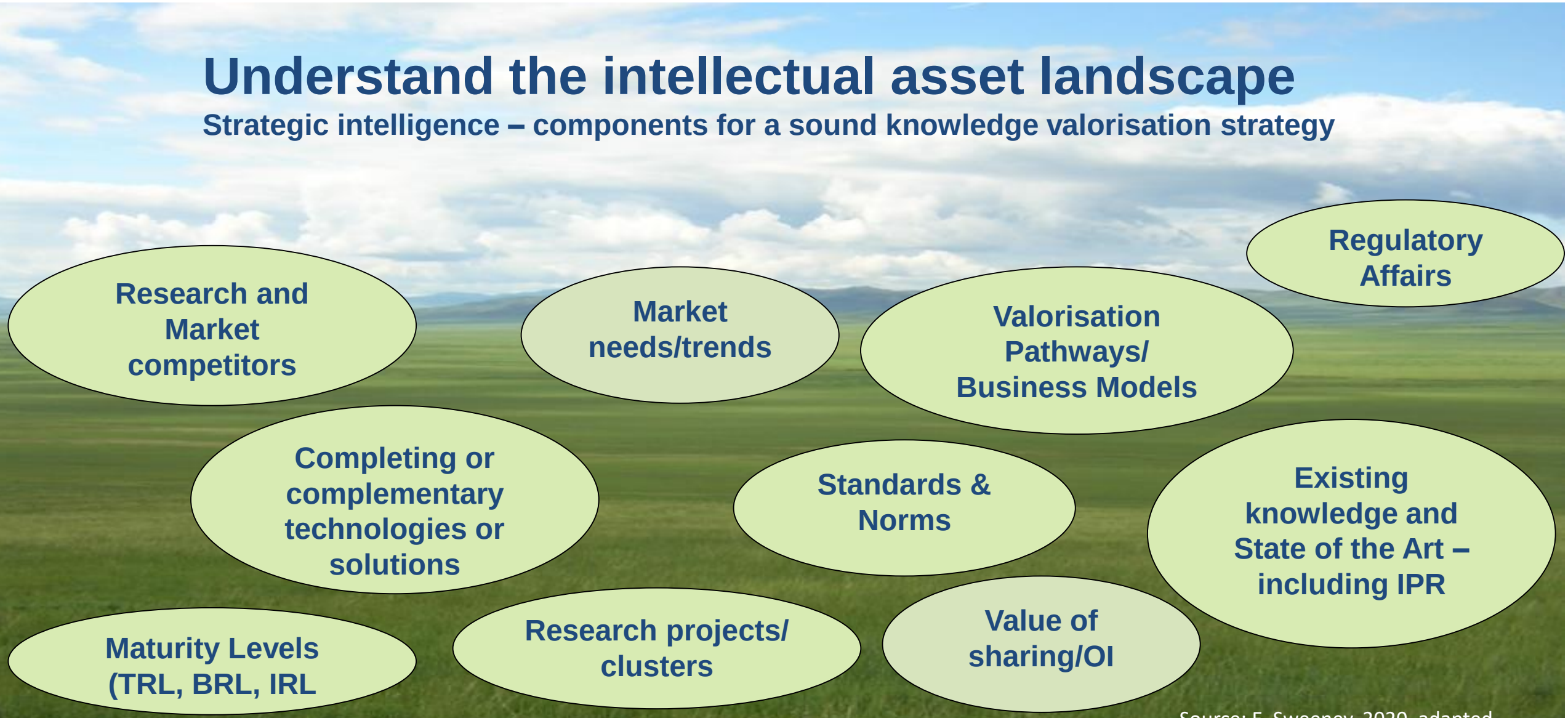
Knowledge Valorisation – From Intellectual asset creation to the market

- Identify potential **complementary patents** and negotiating **cross-licensing agreements** to increase the value of the developed technology for potential investors and third-party licensees.

- Considering engaging in collaborative license mechanisms such as patent pools and clearing houses; e.g. for impact licensing.

Understand the intellectual asset landscape

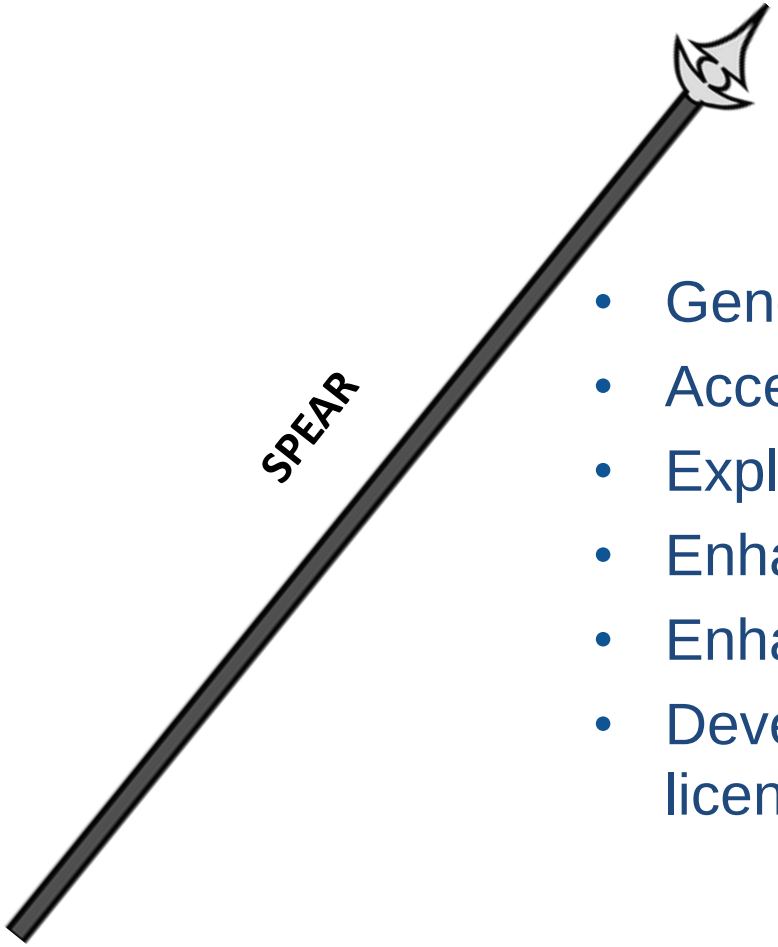
Strategic intelligence – components for a sound knowledge valorisation strategy



Source: E. Sweeney, 2020, adapted

Protection (Shield) and Management (Spear)

- Defend position
- Secure Market Share
- Protect Productsor services
- Create barriers to entry
- Enhance competitiveness
- Avoid litigation

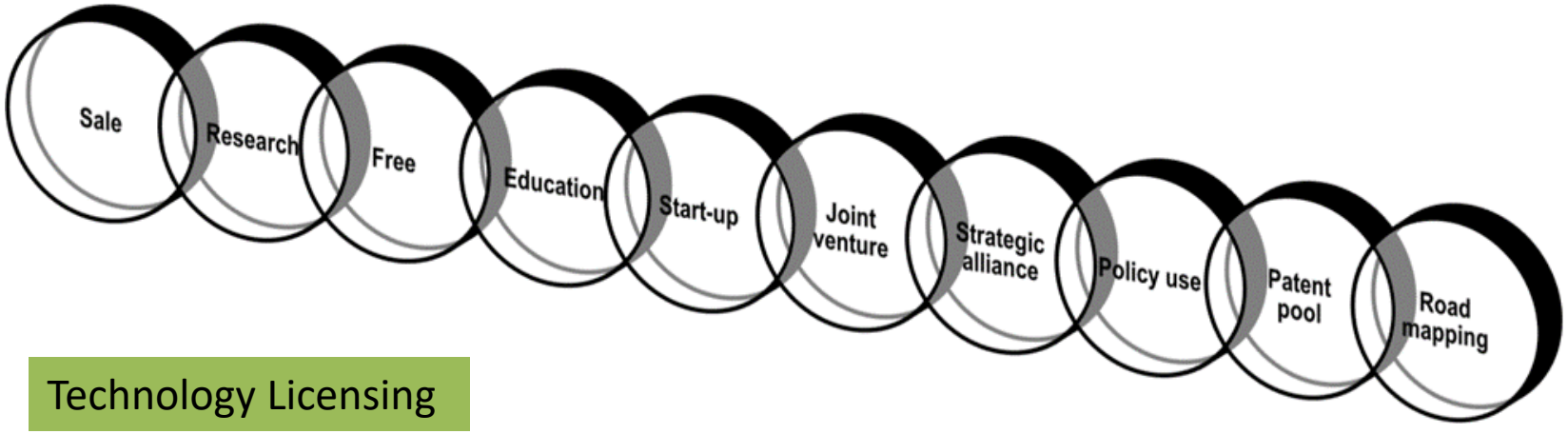


- Generate New Revenues
- Access new technology
- Exploit new Markets
- Enhance Corporate Value
- Enhance competitiveness
- Develop Partnerships and licensing relationships

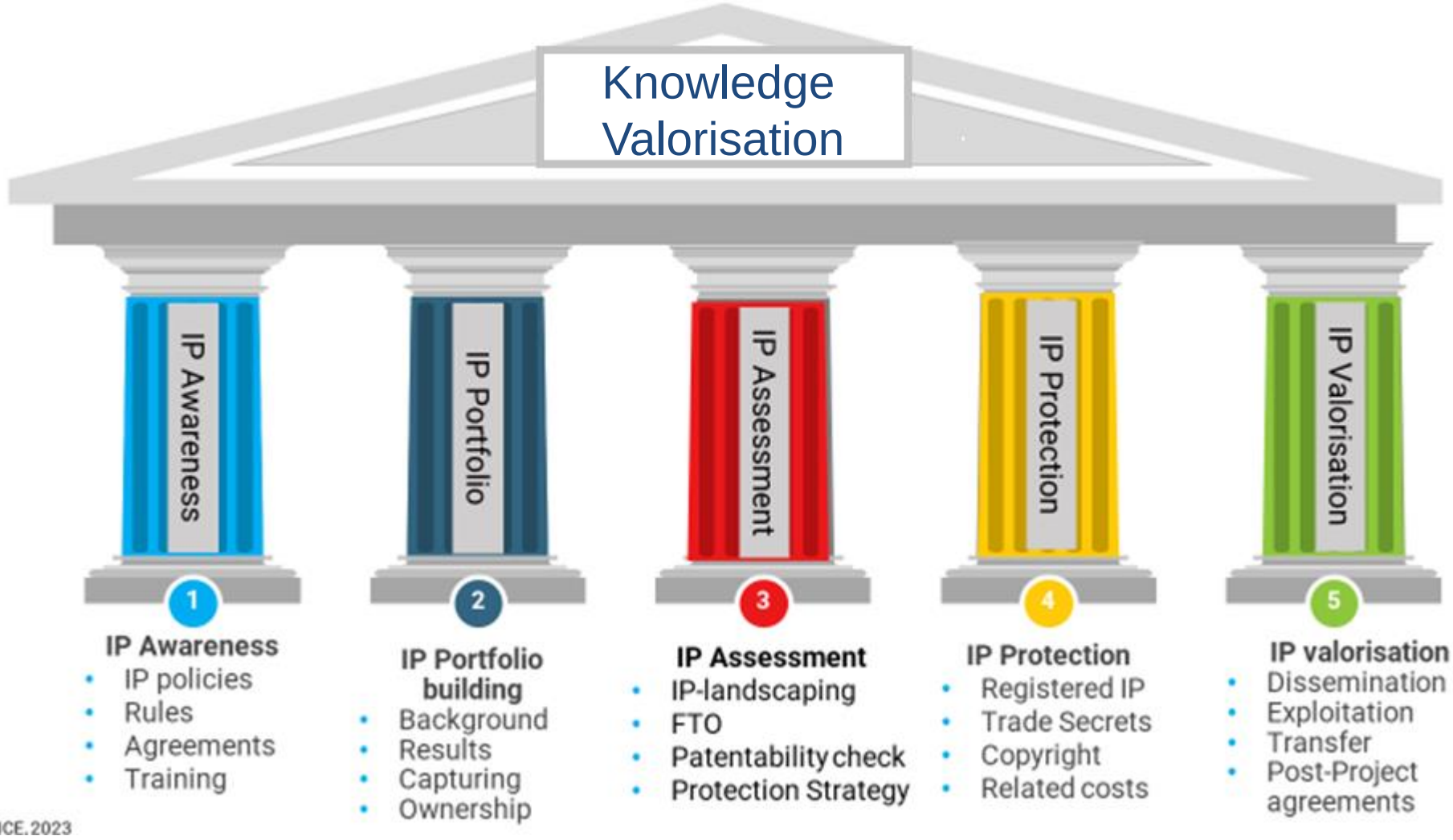
Exploitation Strategies

Like physical property, intellectual property is a valuable asset which can be traded – bought, sold or leased, given away free, used in JV's, as collateral, etc…

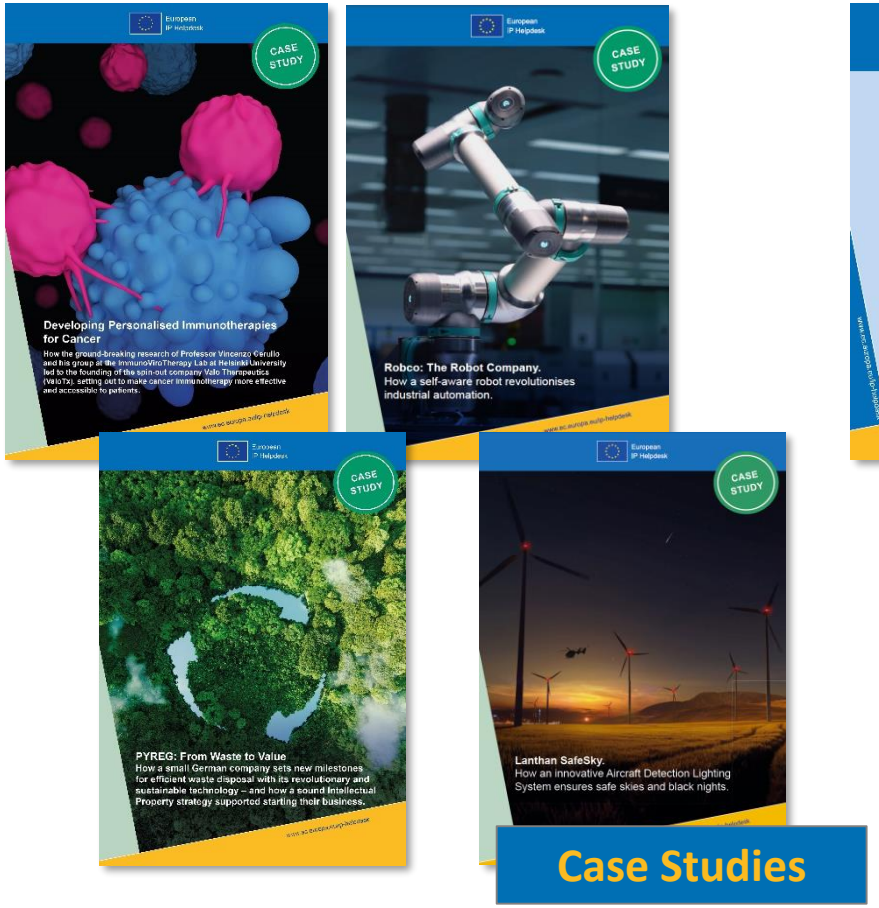
But, many more ways of extracting value…

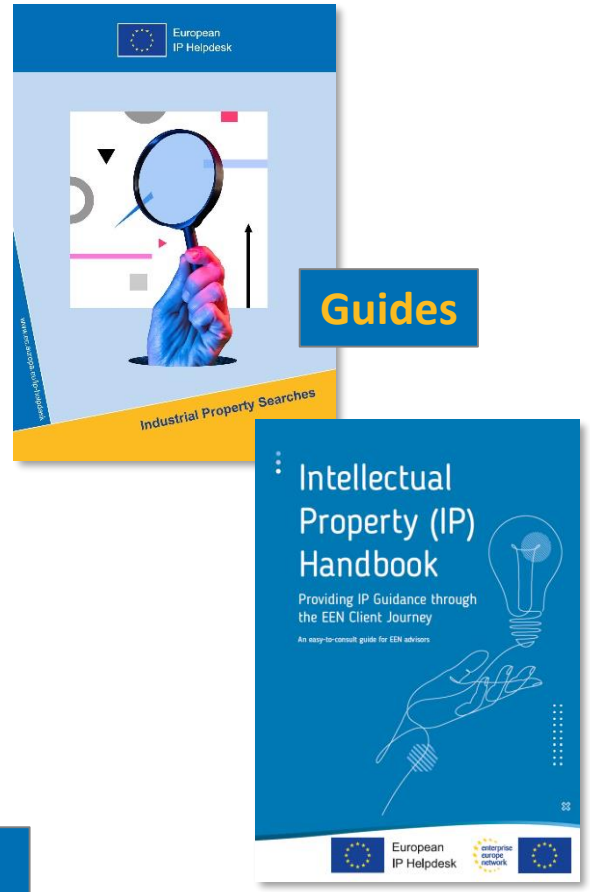


Technology Licensing


Knowledge
Valorisation
IP Awareness
IP Portfolio
IP Assessment
IP Protection
IP Valorisation
1
2
3
4
5
IP Awareness
IP policies
Rules
Agreements
Training
IP Portfolio building
Background
Results
Capturing
Ownership
IP Assessment
IP-landscaping
FTO
Patentability check
Protection Strategy
IP Protection
Registered IP
Trade Secrets
Copyright
Related costs
IP valorisation
Dissemination
Exploitation
Transfer
Post-Project agreements
EURICE.2023

Upcoming Publications





Contact:

- Website: ec.europa.eu/ip-helpdesk
- training@iprhelpdesk.eu
- X (Twitter) @iprhelpdesk
- LinkedIn /european-ipr-helpdesk

Thank You !

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 Research and Innovation (DG RTD).

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 EISMEA or the European Commission. Neither EISMEA nor the European Commission nor any person acting on behalf of EISMEA or of the European Commission is responsible for the use which might be made of this information.