ΟΡΓΑΝΙΣΜΟΣ
ΒΙΟΜΗΧΑΝΙΚΗΣ
ΙΔΙΟΚΤΗΣΙΑΣ

Αξιοποίηση Διπλωμάτων Ευρεσιτεχνίας

Δρ. Γεώργιος Ασημόπουλος

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ (ΟΒΙ)

ΠΕΡΙΦΕΡΕΙΑΚΟ ΓΡΑΦΕΙΟ ΘΕΣΣΑΛΟΝΙΚΗΣ

An official website of the European Union How do you know?

Publications Office of the European Union

Search All collections

Advanced search Browse by subject Expert Search

English (en) 0 Sign in

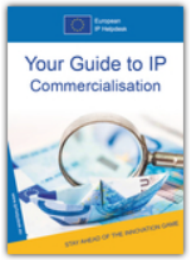
Law European data Public procurement EU Publications Research & Innovation EU Whoiswho

Publication detail

Share Help

Publication detail › Your guide to IP commercialisation

Add to my publications Create alert Permanent link Metadata RDF Embed in website



EU publications

Rate this publication

Your guide to IP commercialisation

Commercialisation is the process of turning products and services into a commercially viable value. Concerning Intellectual Property (IP), this term can be more specifically defined as the process of bringing IP to the market in view of future profits and business growth. It is certainly not an easy

View more

How to cite

YOU MAY ALSO LIKE

European IP Helpdesk
Your guide to IP management in international business

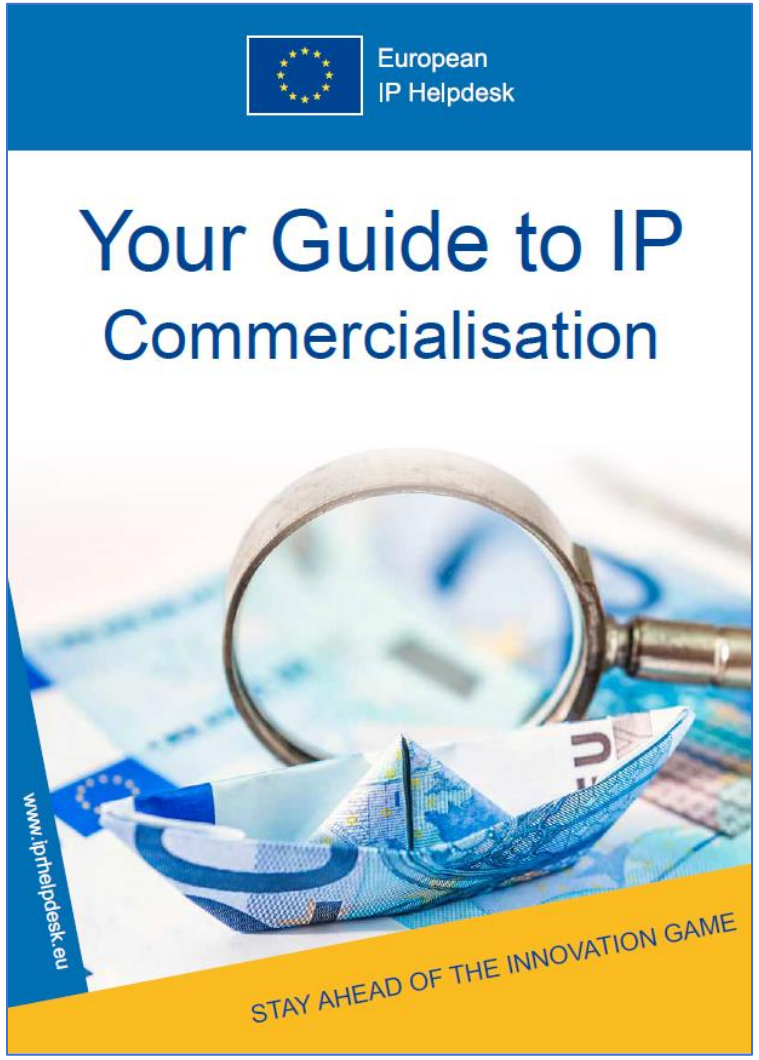
Before venturing into foreign markets it is vital that you protect the Intellectu as patents...

Published: 2020-10-19

Hi there! May I help you to search in our portal?

https://op.europa.eu/en/publication-detail/-/publication/a75b3213-ebf4-11e9-9c4e-01aa75ed71a1

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ



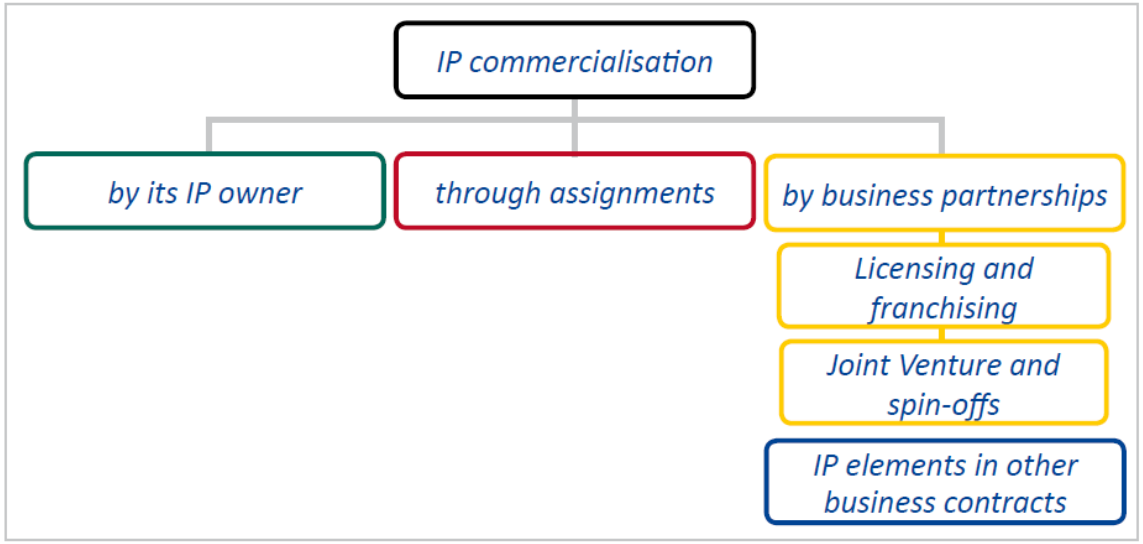
CONTENTS

ΟΡΓΑΝΙΣΜΟΣ
ΒΙΟΜΗΧΑΝΙΚΗΣ
ΙΔΙΟΚΤΗΣΙΑΣ

Introduction to IP Commercialisation

- Commercialisation is the process of turning products and services into a commercially viable value.

- Concerning Intellectual Property (IP), this term can be more specifically defined as the process of bringing IP to the market in view of future profits and business growth.



1. IP Commercialisation by its Owner

- already has enough capabilities for marketing, so that there is no need for partnership,
- does not have enough capacities for building up and/or carrying out such a partnership,
- hesitates to share information with third parties, or does not want to create possible competitors or spend money and make an effort to building partnerships.

ΟΡΓΑΝΙΣΜΟΣ
ΒΙΟΜΗΧΑΝΙΚΗΣ
ΙΔΙΟΚΤΗΣΙΑΣ

What to consider when commercialisation of IP is carried out by its owner?

- Keep your ideas secret
- Use IP databases and conduct FTO analysis
- Keep the records
- Protect IP
- Enforce intellectual property rights

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ

2. Assignments

- An IP assignment is a transfer of ownership of an IPR, such as a patent, trade mark or design, from one party (the assignor) to another party (the assignee).
- Assignments are useful tools for commercialisation, when the owner of the IP:
  - does not have enough capabilities (financial, HR, marketing, etc.) to market the developed intellectual asset
  - and/or when the owner would like to realise an immediate cash flow from an IP asset, which he does not plan to exploit with its own resources.

ΟΡΓΑΝΙΣΜΟΣ
ΒΙΟΜΗΧΑΝΙΚΗΣ
ΙΔΙΟΚΤΗΣΙΑΣ

What to consider in assignments?

- Remember to sign NDAs
- Analyse the risks by performing IP due diligence
    - the ownership status
    - the status of the IP protection
    - any restrictions on exploitation (freedom to operate)
    - the value of the IP, to be used as a basis during the negotiations
    - legal requirements for the assignment
- Consider the key terms in the assignment agreement
    - The form of the agreement
    - Identification of the IP
    - The payment
    - Warranties
    - Governing law and settlement of disputes

3. Licensing

- A licence is a contract under which the holder of an intellectual property (licensor) grants permission for the use of its intellectual property to another person (licensee), within the limits set by the provisions of the contract.
- Hence, in business language, a licence allows the licensor to make money from its intellectual asset by charging the licensee in return for its use.

Benefits and Risks of licensing for both parties

Benefits of licensing for both parties

For Licensor	*For Licensee*
Opportunity to reach new markets with existing products/ services.	Opportunity to create new businesses.
Opportunity to enter a market with existing clientele of the licensee, which reduces risks for market failure.	Opportunity to provide licensor's already available/well established products/services to the clients, which reduces risks for market failure.
No need to invest in marketing and distribution.	No need to invest on R&D.
The licensor retains ownership of the IP while receiving royalty income from it.	The licensee does not need to "purchase" the IP and use the opportunity to test market success of the licensed product/service without investing much.
Licensing is a means for turning a possible competitor into a partner.	

Risks of licensing for both parties

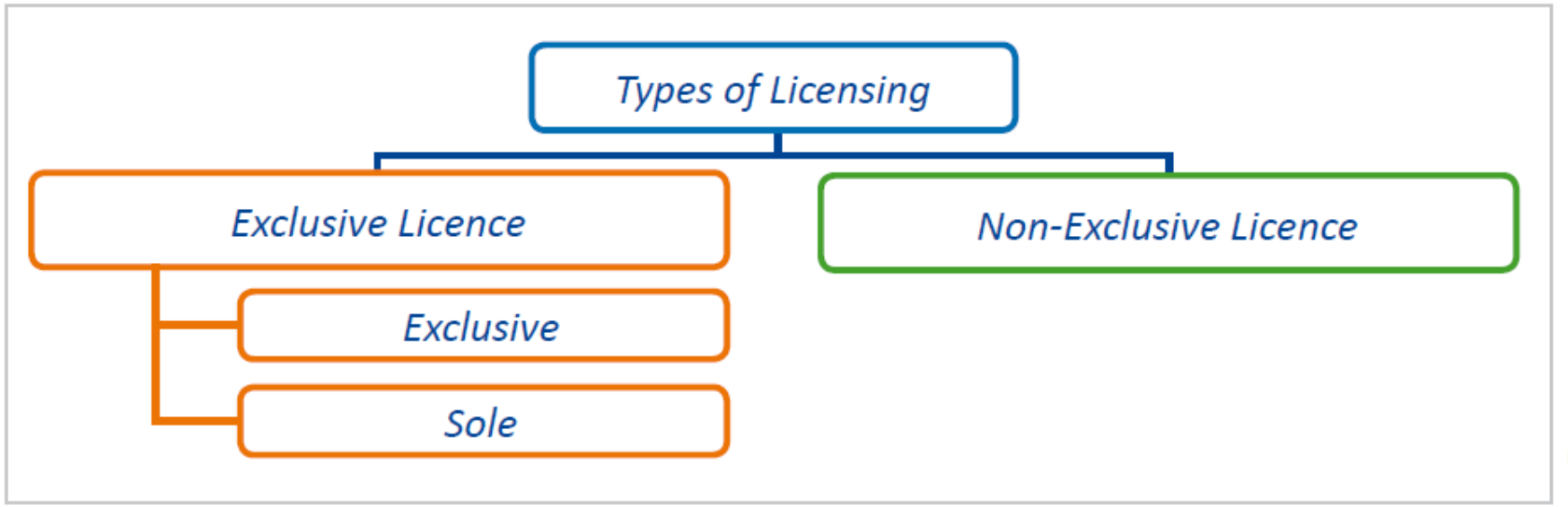
For Licensor	*For Licensee*
The licensee can become a competitor.	Licensing may create a techno-logical/business dependence.
The licensor can lose control of the licensed product/service.	The licensed IP may be chal-lenged and the technology become obsolete.
There are difficulties to find a fair, solid licensee willing to obtain a licence.	There are difficulties to find a fair, reliable licensor willing to grant a licence.
Licensors must trust licensees as a source of revenue. In the case of a market failure, licensees may generate no revenues although there may be a minimum royalty clause in the agreement.	Payments can be too burden-some to cover and a certain amount might still need to be paid even though there is a market failure because of a minimum royalty clause in the agreement.

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ

What to consider in licensing?

- Define the type of licence
- Be prepared for the negotiations
- Granted rights
- Geographical scope
- Field of use
- Right to sublicense
- Improvements
- The payment
- Warranties
- Infringement acts
- Governing law and settlement of disputes

> Signing an NDA before the licensing negotiations reduces the risks of possible leakage of valuable information for both parties.



- Exclusive Licence
  - Exclusive: only the licensee is able to use the licensed IP or technology (the licensor cannot use or license it);
  - Sole: the licensor agrees not to grant any additional licences but retains the right to make use of the licensed IP.
- Non-Exclusive Licence: the licensee and the licensor can both use the licensed intellectual property or technology. The licensor is also allowed to negotiate further non-exclusive licences with other companies.

Differences between assignment and licensing agreements

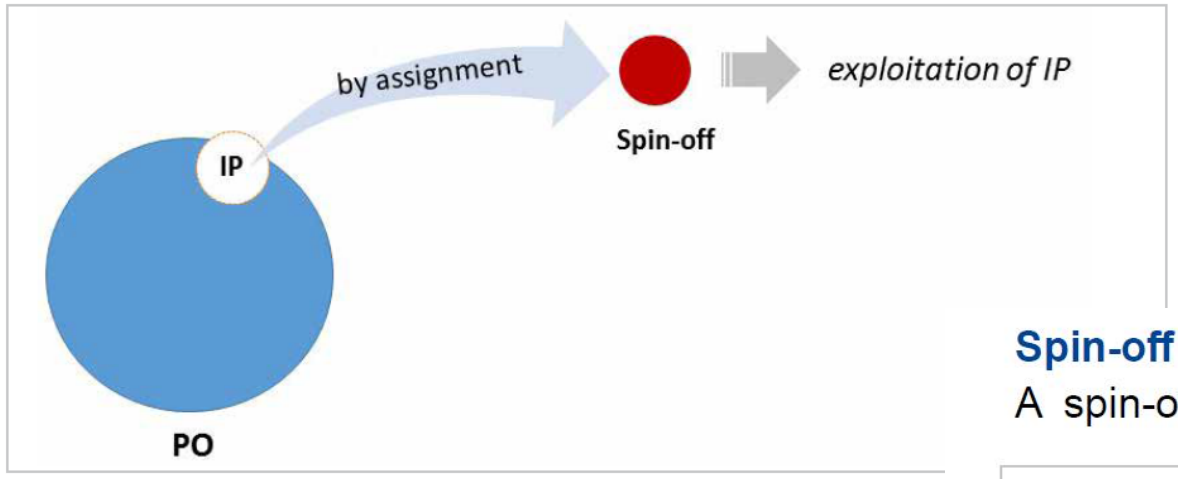
Assignment	*Licensing*
The party "selling" the IP: assignor The party "buying" the IP: assignee	The party "renting out" the IP: licensor The party "renting in" the IP: licensee
The owner of IP changes and becomes the assignee.	The owner of IP does not change and remains the licensor.
An assignment is a permanent transfer of rights.	A licence is a temporary transfer of certain rights.

4.2 Spin-offs

- Spin-offs (or spin-outs) are separate legal entities created by a parent organisation (PO) to bring its IP assets into the market.
- It is generally an efficient solution for the parent organisations, who may not be fully capable of commercialisation of their own IP assets, such as for universities and research institutions.
- Spin-offs are seen as an important means of technology transfer since they are acting as an intermediary between the research environment and industries while putting research results into the commercial market with a marketable product.
- Moreover, through spin-offs, research organisations can focus on their main task of “research” instead of “marketing”, which is the main task of commercial companies (spin-off).

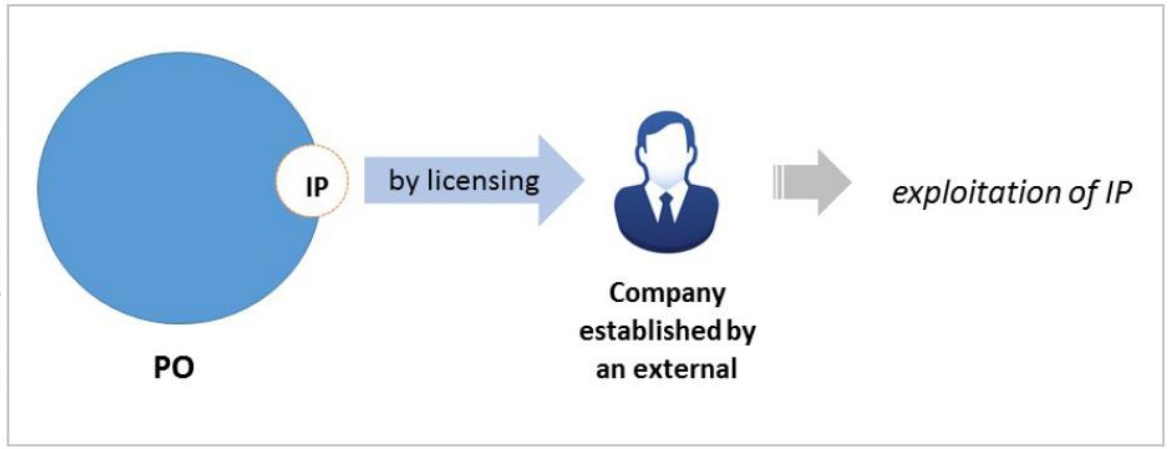
Types of spin-offs

Spin-off by separation



Spin-off formed by a person external to the PO

A spin-off company can be formed by a person external



What to consider in spin-offs?

- Transfer of IP from the parent organization
  - This transfer can take place either by (I) assignment, or by (II) licensing.
- Contracts and agreements
  - concluding NDAs prior to the negotiations held with the investors to protect confidential parts of the IP to be transferred,
  - establishing employment contracts covering the issues related to ownership of the IP created by the employees/researchers
  - drafting licensing or assignment agreements

Europäisches Patentamt
European Patent Office
Office européen des brevets

Valorisation of scientific results

Patent commercialisation scoreboard: European universities and public research organisations | November 2020

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ

Methodology

- 686 interviews
- 38 EPC contracting states
- 10.846 pending European Patent application
- 7.596 granted European Patents
- Between 2007 – 2017

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ

Table 2.6

Distribution of final sample of European patent applications by EPO technology sector

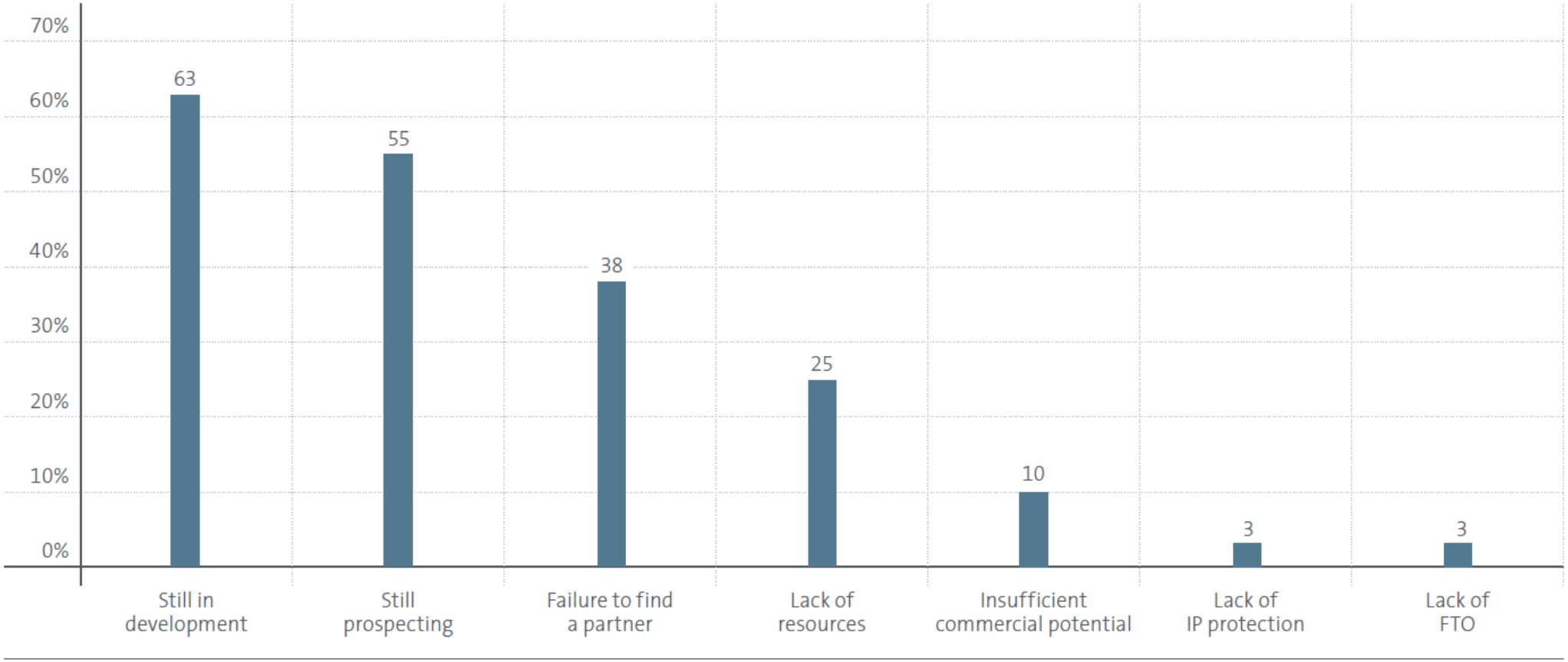
	Healthcare, biotechnology and chemistry	Mobility and Mechatronics + ICT	Total
Unweighted (N)	382	268	650
Share (%)	59%	41%	100%
Weighted (N)	331	305	636
Share (%)	52%	48%	100%

Table 2.7

Distribution of final sample of European patent applications by WIPO technology sector

	Electrical engineering	Instruments	Chemistry	Mechanical engineering and other fields	Missing	Total
Unweighted (N)	81	173	303	90	3	650
Share (%)	12%	27%	47%	14%	0%	100%
Weighted (N)	96	187	256	95	3	637
Share (%)	15%	29%	40%	15%	0%	100%

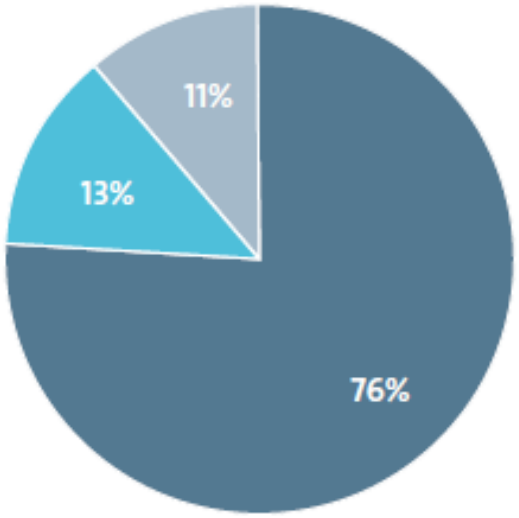
Challenges to successful exploitation



Source: European Patent Office

Figure 3.1

Co-development of patented inventions



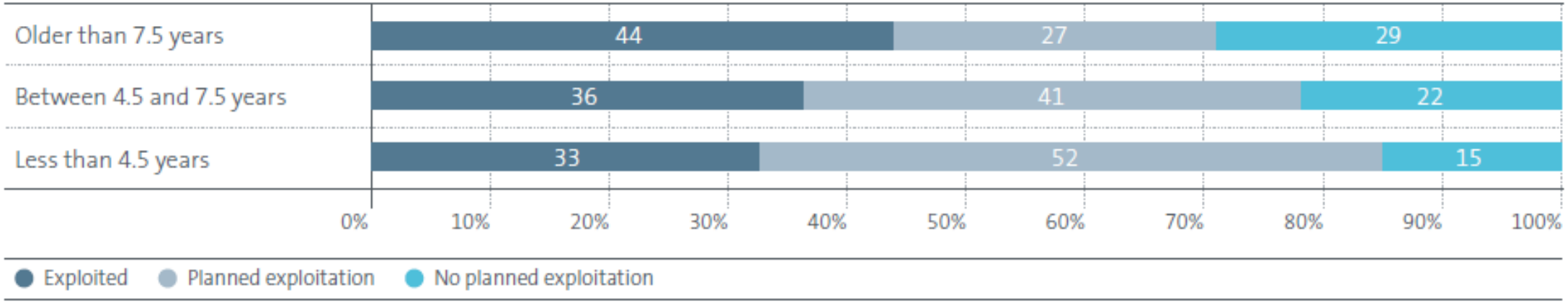
Developed alone Developed together with another UNI/PRO Developed together with a private company or individual inventor

Source: European Patent Office

Basis: Number of interviews unweighted N=650, of which <1% Don't know and <1% No statement.

Figure 4.6

Stage of exploitation by age of patented invention from its priority date

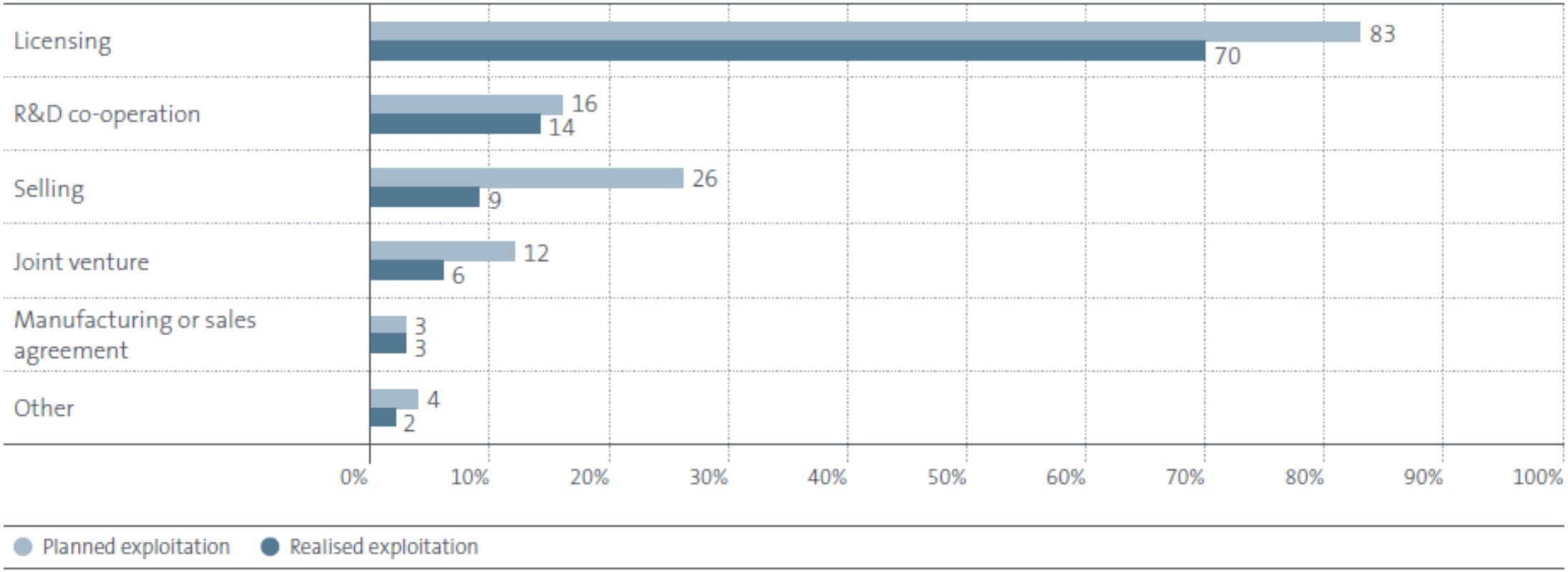


Source: European Patent Office

Basis: Number of interviews unweighted N=633, of which 1% Don't know and <1% No statement.

Figure 4.7

Types of exploitation

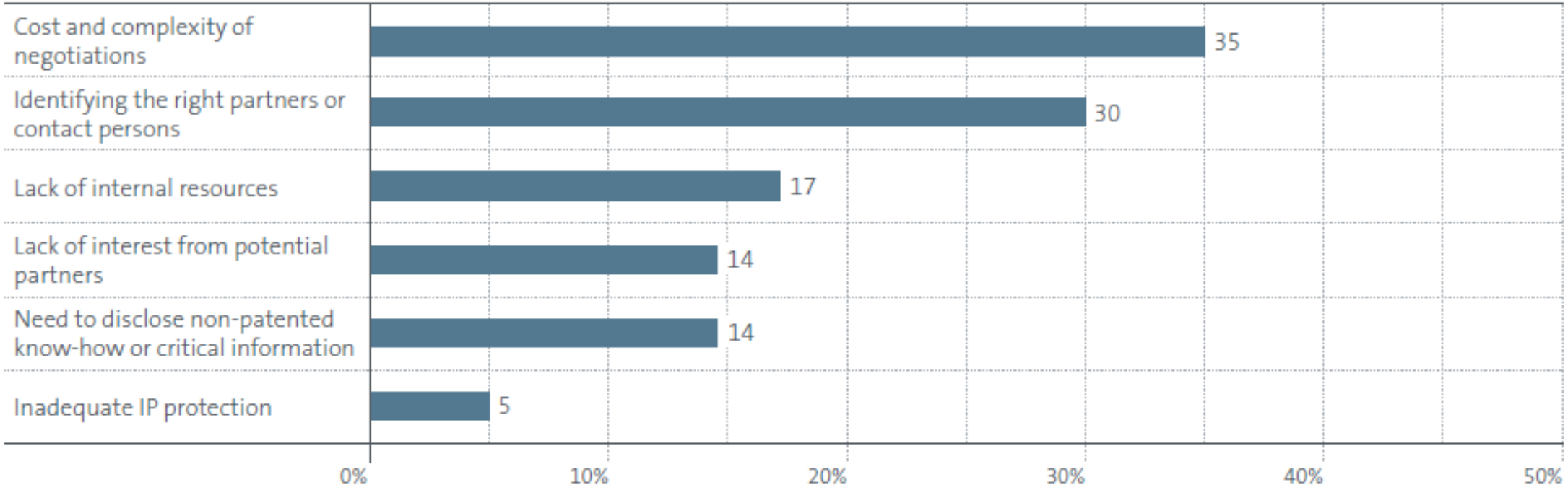


Source: European Patent Office

Basis: Number of interviews unweighted N=244, of which 2% Don't know and <1% No statement.

Figure 5.3

Challenges in realised exploitation (important + very important)



Source: European Patent Office

Basis: Number of interviews unweighted N=217, of which 3-4% Don't know and <1% No statement.

ΟΡΓΑΝΙΣΜΟΣ
ΒΙΟΜΗΧΑΝΙΚΗΣ
ΙΔΙΟΚΤΗΣΙΑΣ

Αξιοποίηση Διπλωμάτων Ευρεσιτεχνίας

Δρ. Γεώργιος Ασημόπουλος

ΟΡΓΑΝΙΣΜΟΣ ΒΙΟΜΗΧΑΝΙΚΗΣ ΙΔΙΟΚΤΗΣΙΑΣ (ΟΒΙ)

ΠΕΡΙΦΕΡΕΙΑΚΟ ΓΡΑΦΕΙΟ ΘΕΣΣΑΛΟΝΙΚΗΣ