Network per la Valorizzazione della Ricerca Universitaria

Italian Network of Technology Transfer Offices of Universities and Public Research Organizations

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DISCLAIMER

- The present document has freely been assembled from the author who is the only owner. It is partially based on the teaching materials made available from the EPO (European Patent Office), from the materials made available on NETVAL website and authored by Shiva Loccisano, materials realized in the framework of collaboration AICIPI-NETVAL by Roberto Tiezzi, materials prepared by Elisa Grassi; these have subsequently been adapted and edited from the author under its own responsibility.

- The lecture will deal with the functioning of the Italian, International and European IPR protection systems, plus some practical tools for the IP Management and Licensing.

- LA TUTELA DELLA PROPRIETA' INTELLETTUALE
- PROCEDURE BREVETTUALI
- LA GESTIONE DELLA PROPRIETA' INTELLETTUALE
- LA VALORIZZAZIONE DELLA PROPRIETA' INTELLETTUALE MEDIANTE IL LICENSING

Monia Gentile, Knowledge Transfer Manager, Scuola Superiore Sant'Anna www.santannapisa.it
JoTTO-Joint Technology Transfer Office www.jointto.it Co-ordinator
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Introducing myself

- Ms Electronic Engineering with specialization in Bioengineering
- Master in Innovation Management
- Training and staff exchange in Germany, Italy, Spain, UK, both on engineering, innovation and TT subjects
- Born in center of Italy (Molise), studied in Pisa, where I live and work
- 15 years experience in TT, univ. collaborations with companies-institutions-investors, patent analysis, business planning, management of the TTO
- Board of Directors of PNICube since 2017
- Publications (book chapter on TTOs in Italy, book review on strategic collaborations between academia and university, some speechs at workshops)
- A doughter (18) a son (6), one husband
- 44 years old

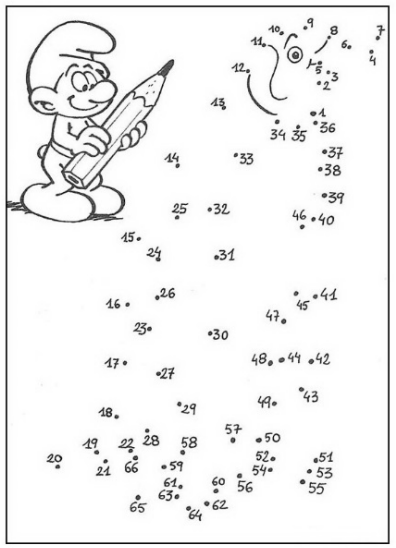
- After finishing my Engineering studies I had no idea about patents and had never heard about technology transfer

Introducing myself

TT Office, Pisa, June, 2017

✓To know about technology
✓To know about regulations and procedures
✓Good public relations

✓Able to join the dots



www.giochigratisenigmisticaperbambini.com

Me, Presidente NETVAL Andrea Piccaluga, 5 start-up, Tokyo, Apr. 2007

LA TUTELA DELLA PROPRIETA' INTELLETTUALE

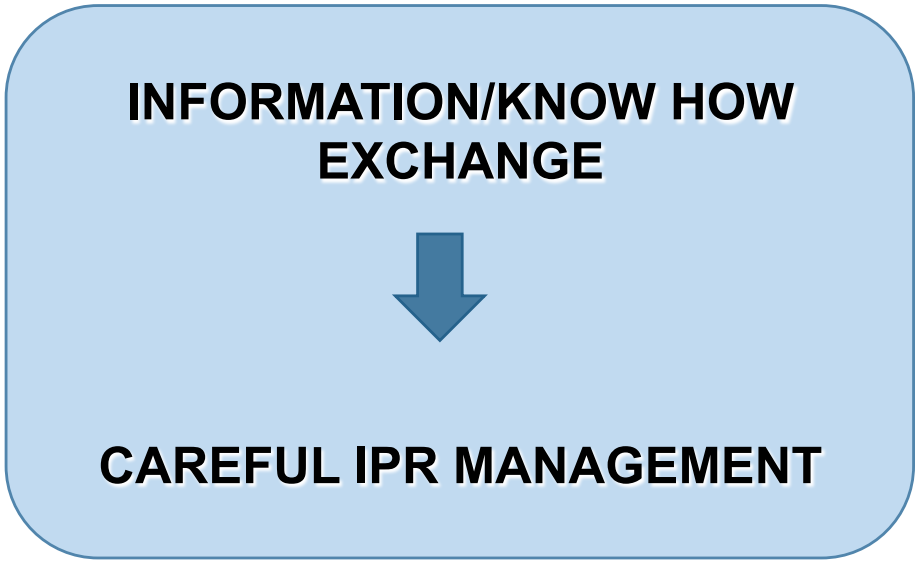
Align and preserve interests is crucial

- In the contemporary extremely complex & highly interconnected world, «**Research networks**» are the place where "**fast paced innovation**" is made possible.

- Properly **managing and protecting know-how** and results of the collaborations becomes a **fundamental tool** to "make intangible resources tangible" and enable their circulation while **preserving each different stakeholder interests.**

In their broader meaning Knowledge and Technology Transfer might be interpreted as a set of activities **intended to disseminate scientific research results** and, in accordance with various innovation stakeholders (univ, funders and the broader business community), main KTT mechanisms involve:

- Promotion
- Networking
- Continuing and professional education
- Consultancy
- Collaborative research
- Contract research
- Licensing
- Spin-off
- Teaching



Why an IP system?

Innovators
make significant investments in developing new products

Competitors
benefit from their efforts

Heavy pressure
may drive the innovator out of business

Can offer similar or identical products at a cheaper price

Get a free ride
on the back of the innovator's creativity and inventiveness

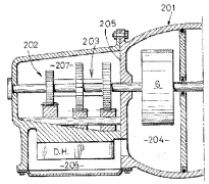
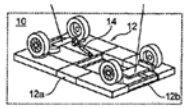
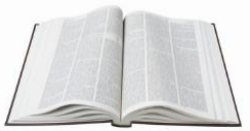
IP system
Rights over the use of inventions, designs, brands, literary and artistic works

In general terms: IPRs confer an **exclusive right**

In particular: IPRs confer the owner the right to prevent others to “use something” without his/her permission

Some IPRs needs to be registered/filed (like patents) but others (like copyright), might not need so, also depending on the specific concerned law system

The different types of IP (I)

Legal right	What for?	How?	
Patents	New inventions	Application and examination	
Utility models	New inventions	Application and registration	
Copyright	Original creative or artistic forms	Exists automatically	

The different types of IP (II)

Legal right	What for?	How?	
Trade marks	Distinctive identification of products or services	Use and/or registration	
Registered designs	External appearance	Registration	
Trade secrets	Valuable information not known to the public	Reasonable efforts to keep secret	

TRADE MARKS

What is a trade mark?

- A trade mark is any sign, capable of being represented graphically, which distinguishes the goods and services of one undertaking (company or organisation) from those of another

- Many different types: word, figurative, colour, shape

- Distinctiveness

Routes for registration

- National
- International
- EU
  - European Union Trade Mark

Scope of protection

- Exclusive right, but
  - principle of speciality
  - principle of territoriality
- Potentially perpetual (renewal every ten years)
- Risk of loss of protection if:
  - not used after five years
  - found to be invalid

DESIGNS

What is a design?

- A design is the outward appearance of the whole or parts of a product resulting from its features.
- A product is any industrial or handicraft item.
- Requirements for protection
  - Novelty
  - Individual character

Registered and unregistered design rights

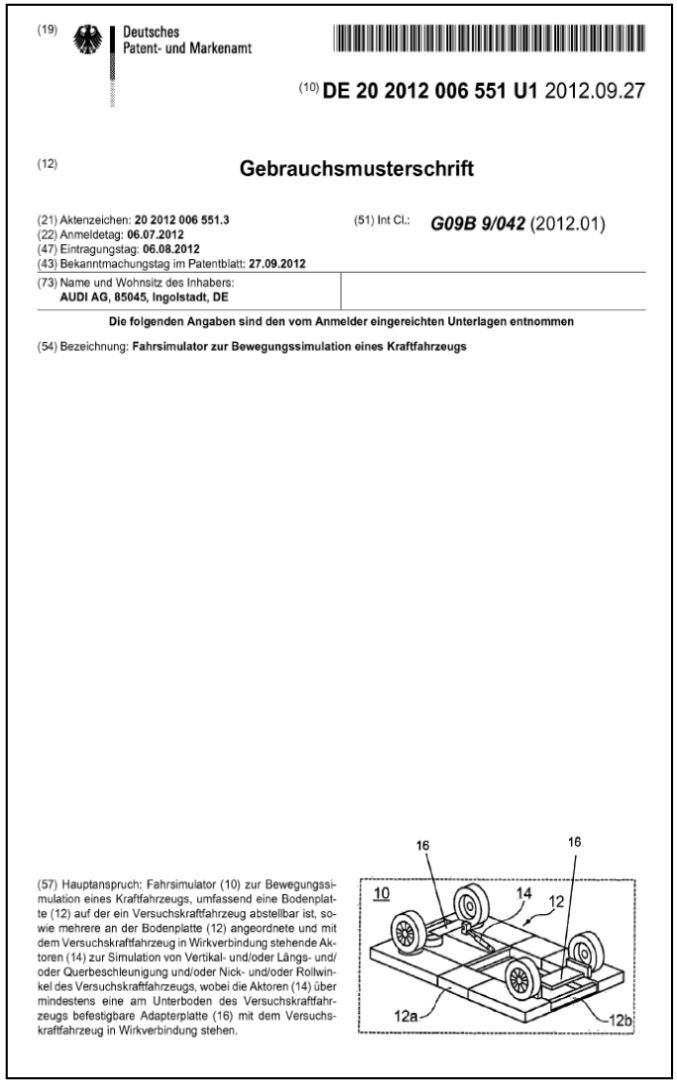
- National
- International
- EU
  - registered Community design
  - unregistered Community design

Scope of protection

- Exclusive right
- Principle of territoriality
- Duration
  - registered design rights: maximum 25 years
  - unregistered design rights: 3 years

UTILITY MODELS

What is a utility model?



(19) Deutsches Patent- und Markenamt

(10) **DE 20 2012 006 551 U1** 2012.09.27

(12) **Gebrauchsmusterschrift**

(21) Aktenzeichen: **20 2012 006 551.3**
(22) Anmeldetag: **06.07.2012**
(47) Eintragungstag: **06.08.2012**
(43) Bekanntmachungstag im Patentblatt: **27.09.2012**

(51) Int Cl.: ***G09B 9/042*** (2012.01)

(73) Name und Wohnsitz des Inhabers:
AUDI AG, 85045, Ingolstadt, DE

Die folgenden Angaben sind den vom Anmelder eingereichten Unterlagen entnommen

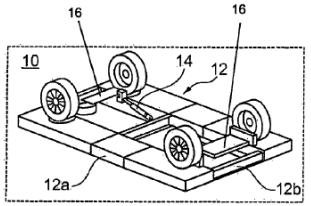
(54) Bezeichnung: **Fahrsimulator zur Bewegungssimulation eines Kraftfahrzeugs**

(57) Hauptanspruch: Fahrsimulator (10) zur Bewegungssimulation eines Kraftfahrzeugs, umfassend eine Bodenplatte (12) auf der ein Versuchskraftfahrzeug abstellbar ist, sowie mehrere an der Bodenplatte (12) angeordnete und mit dem Versuchskraftfahrzeug in Wirkverbindung stehende Aktoren (14) zur Simulation von Vertikal- und/oder Längs- und/oder Querbeschleunigung und/oder Nick- und/oder Rollwinkel des Versuchskraftfahrzeugs, wobei die Aktoren (14) über mindestens eine am Unterboden des Versuchskraftfahrzeugs befestigbare Adapterplatte (16) mit dem Versuchskraftfahrzeug in Wirkverbindung stehen.

- A utility model grants the holder the exclusive right to prevent third parties from:
  - exploiting an invention (e.g. making, using, offering for sale)
  - without authorisation in the country where the utility model was registered

  for a short period (3 to 10 years).
- The holder has to disclose the invention to the public.

Reveal invention (disclosure)



Get protection (utility model)

Scope of protection compared with patents

Utility models

- Registered territorial IP right
- Available in limited number of countries
- No central filing in Europe
- Protection for 3 -10 years
- Search reports in some countries only
- Registered and published after a few months
- Generally no substantive examination (novelty, inventiveness)
- Reviewed only in revocation or infringement proceedings

Patents

- Registered territorial IP right
- Available in most countries
- Central filing possible (e.g. EPO for Europe)
- Protection for up to 20 years
- Search reports standard
- Application published after 18 months
- Substantive examination (novelty, inventive step)
- Grant or refusal after substantive examination procedure

What are plant variety rights?

- Exclusive exploitation rights for new plant varieties

- Four requirements for protection:

  - novelty
  - distinctness
  - uniformity
  - stability

- Right holder = breeder

- Obtained through registration

COPYRIGHT

What is copyright?

- Copyright protects any production of the human mind, such as literary and artistic works.
  - This production must be an expression and not a mere idea.
  - The expression must be original.
- Copyright creates a special legal relationship between authors and their work.
- It confers legal protection for a limited period of time.

Scope of protection

- Economic rights

  - relate to the economic exploitation of the work

  - are freely transferable or licensable

- Moral rights

  - relate to a moral interest of the author

  - are always retained by the author

- Exceptions and limitations

TRADE SECRETS

What are trade secrets?

- Information that
  - is not generally known or easily discovered
  - has a business, commercial or economic value (actual or potential) because the information is not generally known
  - is subject to reasonable efforts to maintain secrecy
- Unlimited life, provided the information does not become public knowledge.

Means of protection

Practical

- Limited access to information
- "Need to know"
- Encryption of data
- Monitored entry to installations

Contractual

- Restrictive covenants in employment contracts
- Non-disclosure agreements

How many IPRs in an iPhone?

Trade marks:

- Made by “Apple"
- Product “6S"
- Software: “iOs", “Applestore“

Patents:

- Data-processing methods
- Semiconductor circuits
- Chemical compounds
- Touchscreen

Copyrights:

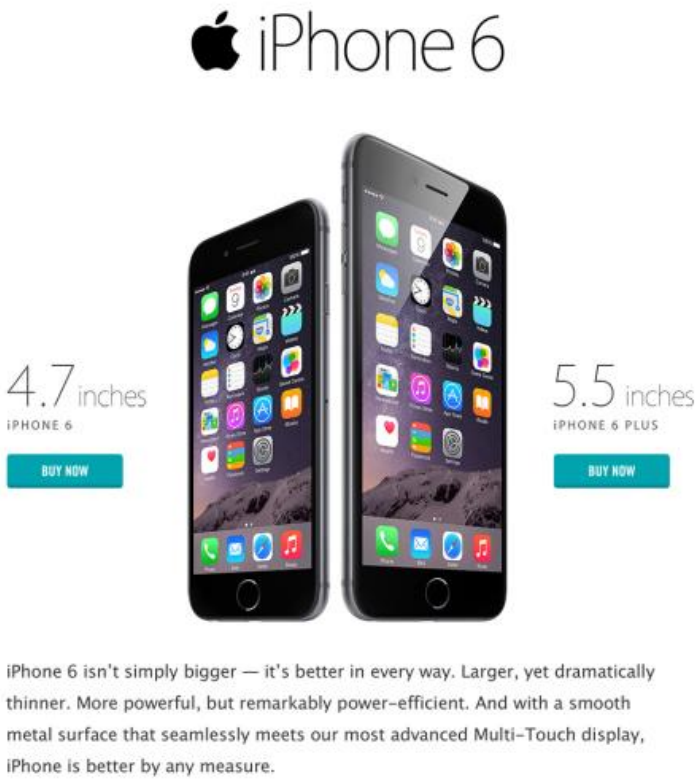
- Software code
- Instruction manual
- Ringtone

Trade Secrets:

- ????

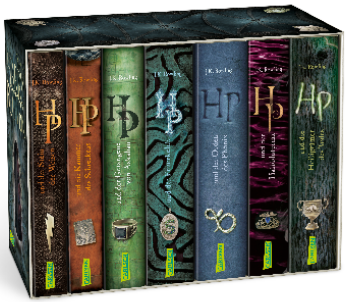
Design:

- Overall phone shape
- Retina screen shape
- Arrangement of icons
- Capacitive Touchscreen



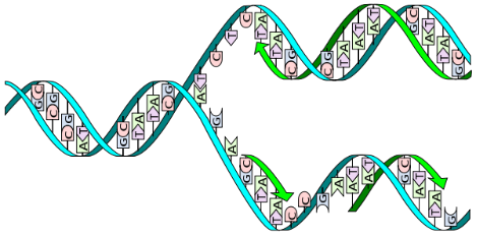
Coca-Cola®

Apple® iPod touch®



Harry Potter

Polaroid® instant camera



DNA copying process

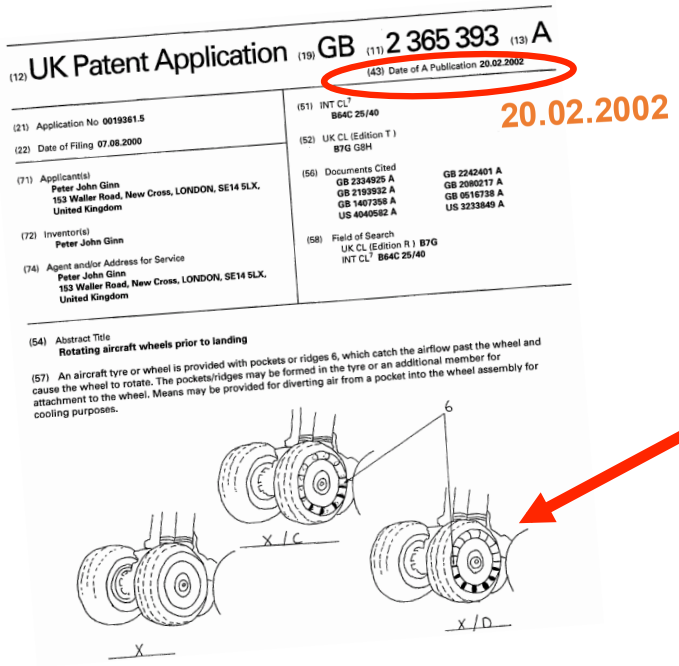
Reveal invention (disclosure)

Get exclusivity (patent)

…in this way other people will take advantage from the innovation and continue to build upon existed knowledge to foster societal growth!

Re-inventing the wheel - literally

- 15-25% of all R&D efforts are wasted each year on inventions that have already been invented.
- Don't start your R&D until you have done a search!



(12) UK Patent Application (19) GB (11) 2 365 393 (13) A

(43) Date of A Publication 20.02.2002

20.02.2002

(21) Application No 0019361.5

(22) Date of Filing 07.08.2000

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United Kingdom

(51) INT CL[7]
B64C 25/40

(52) UK CL (Edition T)
B7G G8H

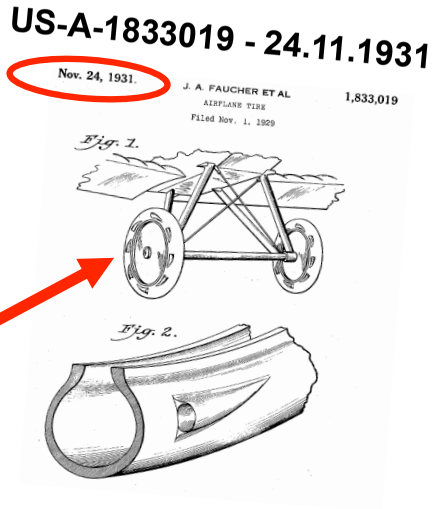
(56) Documents Cited
GB 2334925 A
GB 2193932 A
GB 1407358 A
US 4040582 A
GB 2242401 A
GB 2080217 A
GB 0516738 A
US 3233849 A

(58) Field of Search
UK CL (Edition R) B7G
INT CL[7] B64C 25/40

(54) Abstract Title
Rotating aircraft wheels prior to landing

(57) An aircraft tyre or wheel is provided with pockets or ridges 6, which catch the airflow past the wheel and cause the wheel to rotate. The pockets/ridges may be formed in the tyre or an additional member for attachment to the wheel. Means may be provided for diverting air from a pocket into the wheel assembly for cooling purposes.

US-A-1833019 - 24.11.1931



Nov. 24, 1931. J. A. FAUCHER ET AL 1,833,019

AIRPLANE TIRE

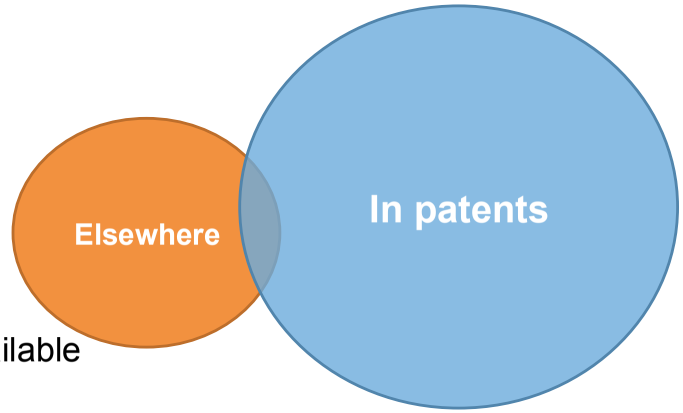
Filed Nov. 1, 1929

Fig. 1.

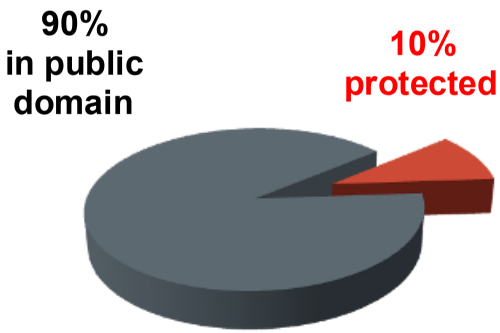
Fig. 2.

Solutions found in patent documents

Where do competitors publish their R&D?



Approximately 80% of the information which can be found in patents is not available anywhere else in comparable detail.



You can find many great solutions for free!

Reasons

- Applications rejected/withdrawn or patent invalidated
- Payment of renewal fees discontinued
- Patents have lapsed

...inventions and patents

What is an invention?

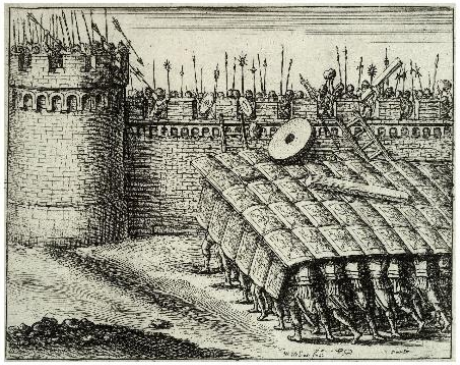
"An original solution to a technical problem"

For an invention to be patented, it must usually be

- ✓ **new** to the world (i.e. not available to the public anywhere in the world)
- ✓ **inventive** (i.e. not an "obvious" solution), and
- ✓ susceptible of industrial application

Rights conferred by patents

- Right to **prevent others from making, using, offering for sale, selling or importing** infringing products in the country where the patent was granted
  - **Exception:** non-commercial purposes (private use, academic research)
- **Right to assign, sell or license these rights**
- For a limited time (up to 20 years).



Rights coming from a patent

- Does a patent give you the right to exploit an invention?
- A patent is a negative right.

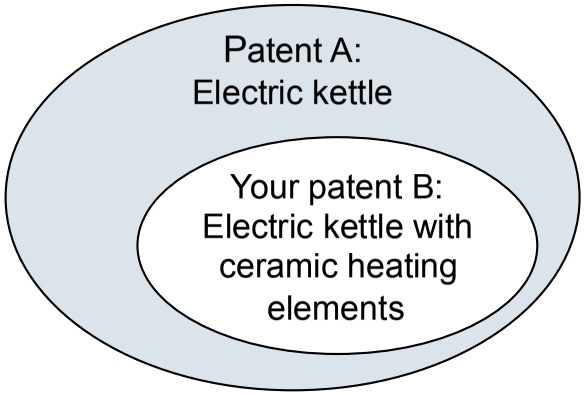
  It gives you the right to prevent others from exploiting the invention.

  It is not an enabling right.
- Patents owned by others may

  overlap or encompass your own patent.

  -> Seek a licence before commercialising

For example:



Patentability requirements

- **Novelty** → Is it new?
- **Inventive step** → Is it original/inventive?
- **Industrial application** → Is it apt to be produced at the industrial level?

Patentability requirements: Novelty

- – An invention shall be new where it is not included in the prior art.
- Prior art shall consist of everything that has been made available to the public by means of written or oral description, use or any other means prior to the filing date of the patent application or, where appropriate, the recognized priority date.
- Solely for the purpose of determining novelty, the content of a patent application pending before the National Directorate of Industrial Property and having a filing date or priority date earlier than the priority date of the patent application under examination shall likewise be considered part of the prior art.

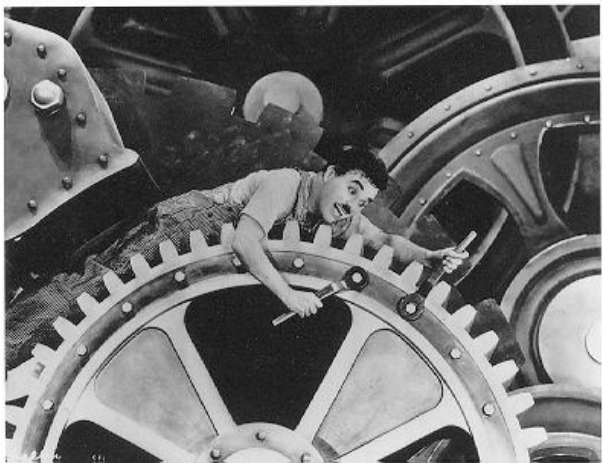
Patentability requirements: Inventive step

- An invention shall be regarded as involving an inventive step if it **would not have been obvious**, or obviously derived from prior art, to a **person skilled in the technical field** concerned.

The skilled person is a legal fiction. The concept of the skilled person means a practitioner with general technical knowledge in the in the relevant technical field. He or she is assumed to have access to the entire state of the art and to be capable of performing routine work and experimentation, but to be devoid of inventive skills.

Patentability requirements: Industrial application

- An invention shall be regarded as industrially applicable where its subject matter **may be produced or used in any productive activity**, including services.



- **The following shall not be considered inventions:**

  (a) **discoveries, principles and scientific theories, and mathematical methods;**

  (b) **materials already existing** in nature;

  (c) **literary and artistic works or any other aesthetic creation**;

  (d) **plans, rules and methods for the pursuit of intellectual activities**, the **playing of games**, or **economic and business activities**, and also **computer programs or software, where they do not form part of an industrially applicable invention**; and

  (e) **methods of presenting information**.

- **The following shall be expressly excluded from patentability:**

  (a) inventions, the prevention of the commercial exploitation of which is necessary to **protect ordre public or morality**, including to **protect human**, **animal or plant life** or **health** or to **avoid serious prejudice to the environment or ecosystem**;

  (b) diagn**ostic, therapeutic and surgical methods** for the treatment of humans or animals; and

  (c) **plants and animal breeds**, and also essentially biological processes for the production of plants or animals.

  For the purposes of subparagraph a), the following shall be considered contrary to morality and shall therefore not be patentable:

  (a) processes for cloning human beings;

  (b) the human body and its genetic identity;

  (c) the use of human embryos for industrial or commercial purposes; and

  (d) processes for modifying the genetic identity of animals that cause them suffering without any substantial medical benefit being obtained for human beings or animals.

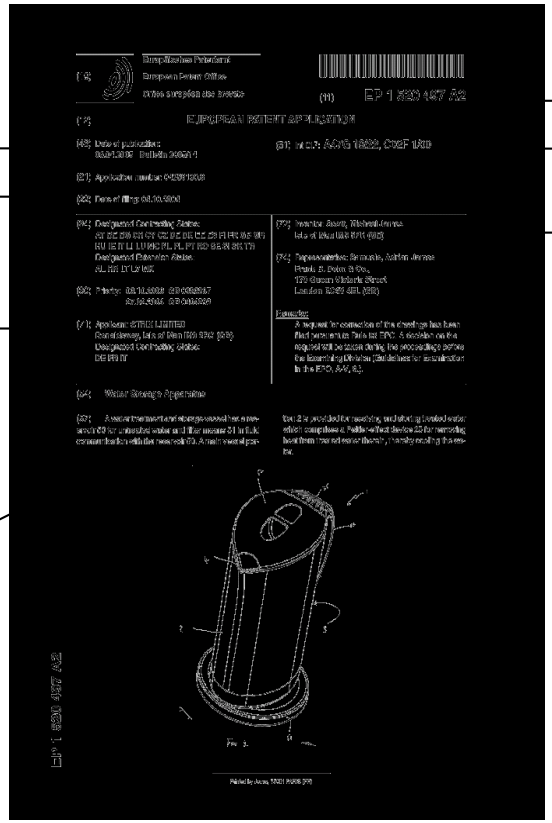
What do patent documents look like?

Date of publication

Date of filing

Applicant

Abstract



Application number

Technical class

Inventor

Claims

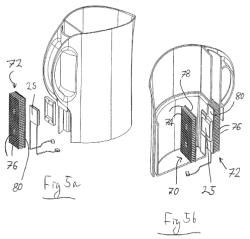
1. A portable water treatment and storage vessel comprising:

   a reservoir for untreated water;
   filter means in fluid communication with said reservoir; and
   a main vessel portion for receiving and storing treated water;

   wherein said main vessel portion comprises electro-thermal cooling means for removing heat from the treated water therein, thereby cooling the water.

Claim(s)

Description



Drawing(s)

What does the description contain?

- Prior art
  - *teapot with one spout*
- Drawback of prior art
  - *time-consuming*
- Problem to be solved
  - *reduce filling time for multiple cups*
- Solution
  - *provide a second spout*
- Advantage of the invention
  - *filling time is reduced*

Fig.1.

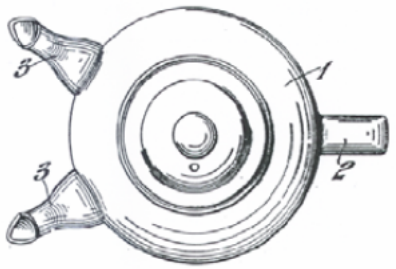
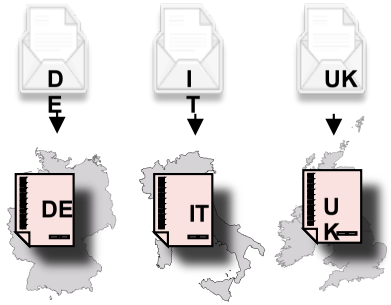


Fig.2.

PROCEDURE BREVETTUALI

Validità territoriale del brevetto e armonizzazione

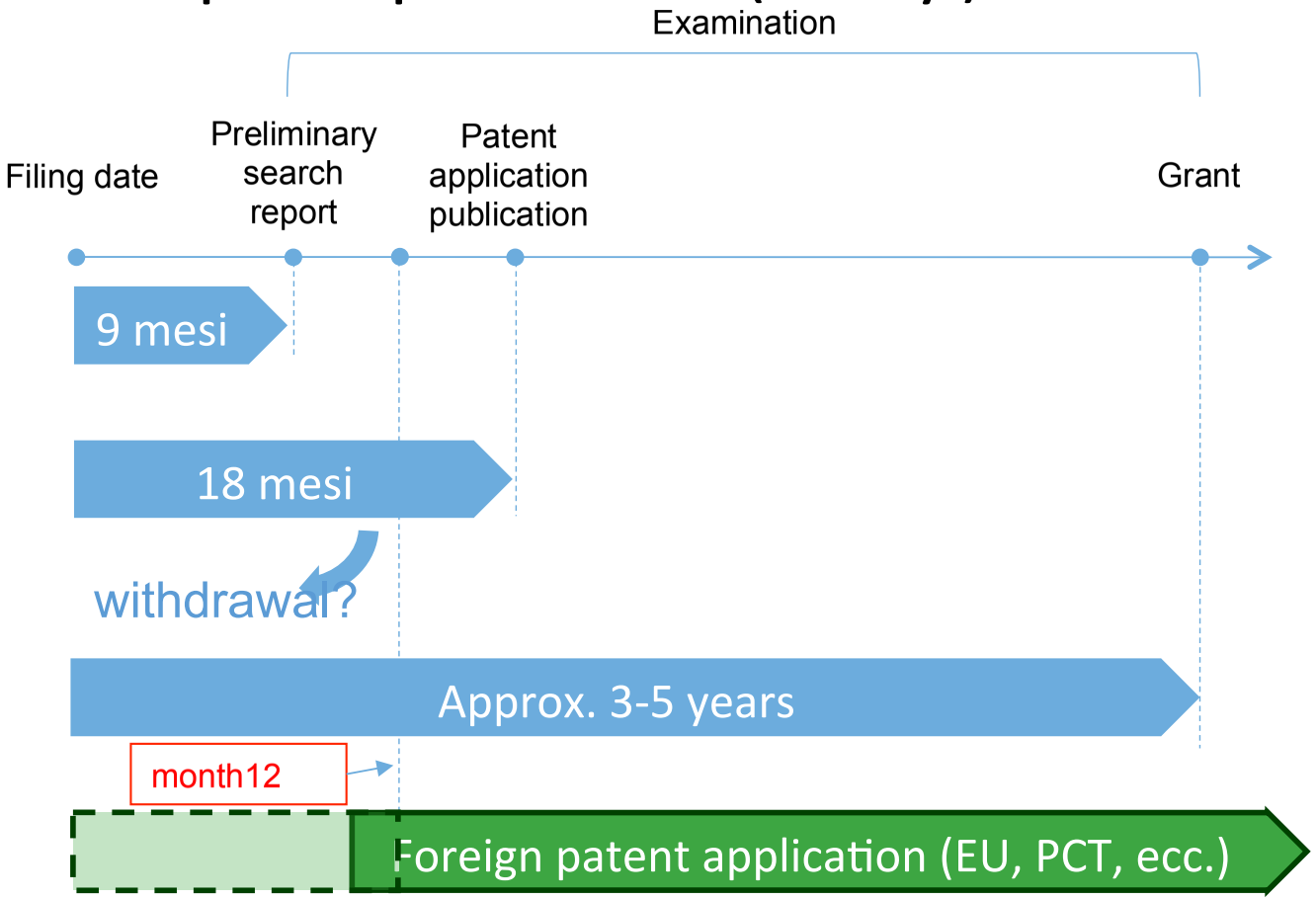
- **Patents are valid on a territorial basis** (Ecuadorian patents protect the inventions only in Ecuador)
- **To seek wide protection one need to file multiple patent applications covering the same invention in each country of interest**



- **Paris convention and other international agreements solve this issue, offering various advantages**
  - Less filing expenses
  - More time to take decisions and define proper strategies

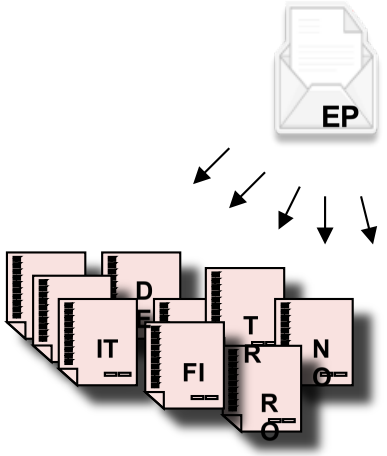
Proper deadlines and procedures must be respected

The grant procedure from a national perspective (Italy)



The European Patent

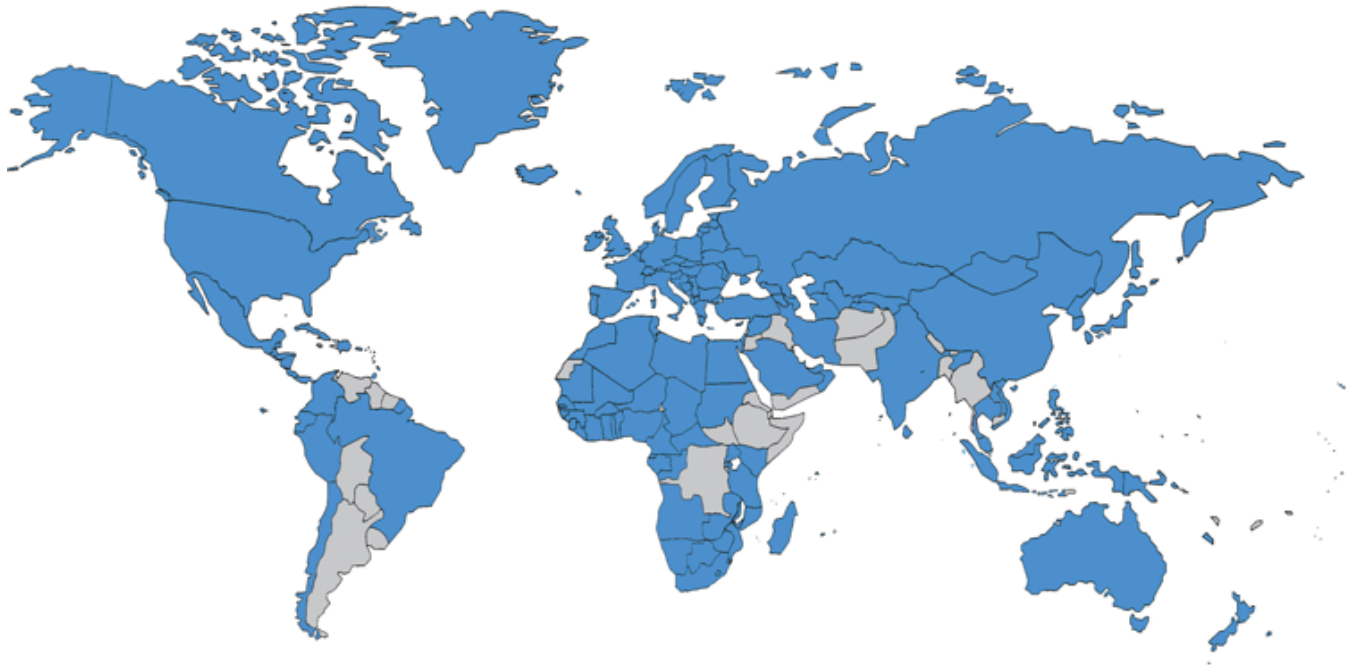
- **Authority – EPO** (European Patent Office)
- **One application filed at one office for up to 42 states** (Oct. 2016)
- **Patent is issued centrally subject to examination**
- **Results in a bundle of national patents** (the issued patent needs to be registered in each of the country of interest)



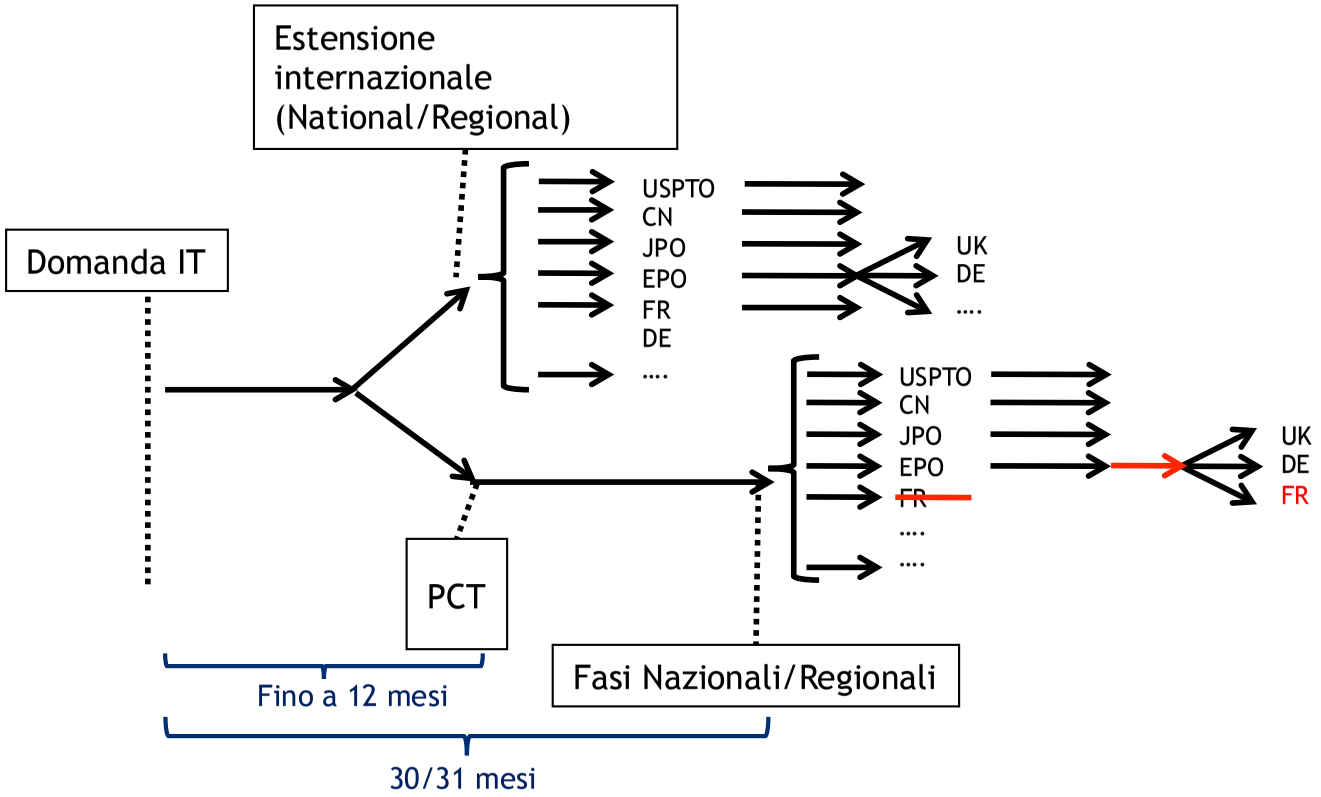
La domanda PCT (Patent Cooperation Treatment)

- **Authority – WIPO** (World Intellectual Property Organization)
- **Centralized procedure valid in 148 countries** (19 May 2016)
- **Preliminary search report is provided and, upon applicant request, a complete examination provides opinion on patentability** (optional)
- **Does not lead to any grant, but allow to postpone decision by applicant on which countries to proceed after 30-31 months** (instead of 12)
- **After entering into the National phase the application will be subject to standard national tracks**

148 Countries belonging to PCT



Come estendere un brevetto: i percorsi possibili



Riferimenti normativi

Codice proprietà industriale D. L. n.30 del 10 Febbraio 2005
e successive modifiche con D.L. n.131 del 13 Agosto 2010

Art. 64. Invenzioni dei dipendenti di imprese

1. Caso di dipendenti che inventano per contratto: titolarità alla ditta

2. Caso di dipendenti che non sono retribuiti per inventare: titolarità alla ditta ed equo premio per inventore

3. Invenzione casuale, ma che rientra nel campo di attività del datore di lavoro: il datore di lavoro ha opzione di esclusiva

L'inventore è sempre riconosciuto tale per diritto morale

Riferimenti normativi

Codice proprietà industriale D. L. n.30 del 10 Febbraio 2005

Art. 65. Invenzioni dei ricercatori

Quando il rapporto di lavoro intercorre con Università o Ente di ricerca la titolarità spetta all'inventore, a meno che l'invenzione non derivi da attività finanziata in tutto o in parte da terzi.

In tal caso la titolarità può spettare all'Università o ente di ricerca e all'inventore spetta un equo premio

Riferimenti normativi

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Riferimenti normativi

Codice diritto d'autore: regio decreto 1369 del 1942, per l'esecuzione della legge n°633 del 1941

La titolarità spetta all'autore

Se il datore di lavoro è un'amministrazione dello stato, il diritto spetta al datore di lavoro (art.11)

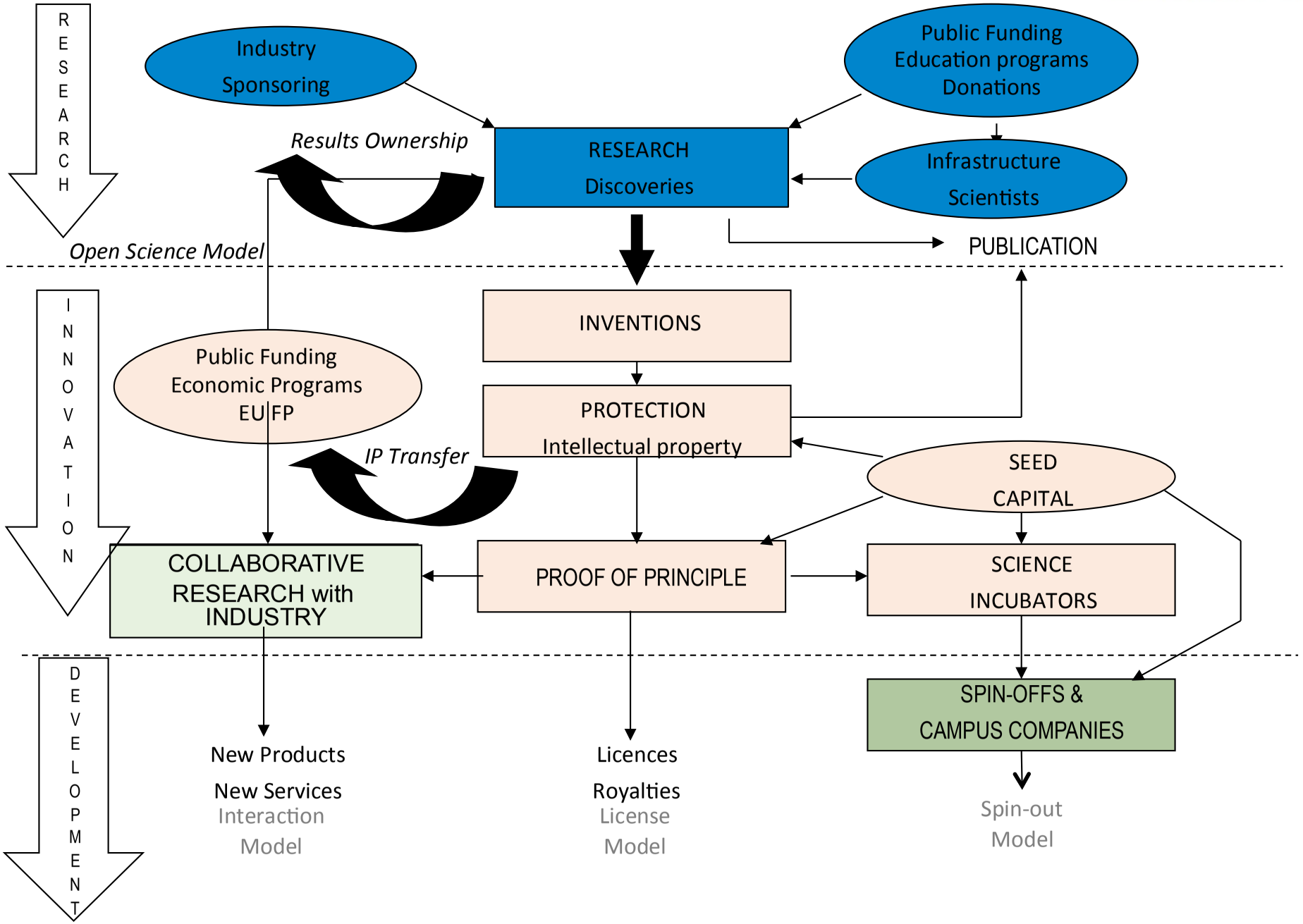
LA GESTIONE DELLA PROPRIETA’ INTELLETTUALE

Where the IP is managed
in the collaboration with industries and other partners

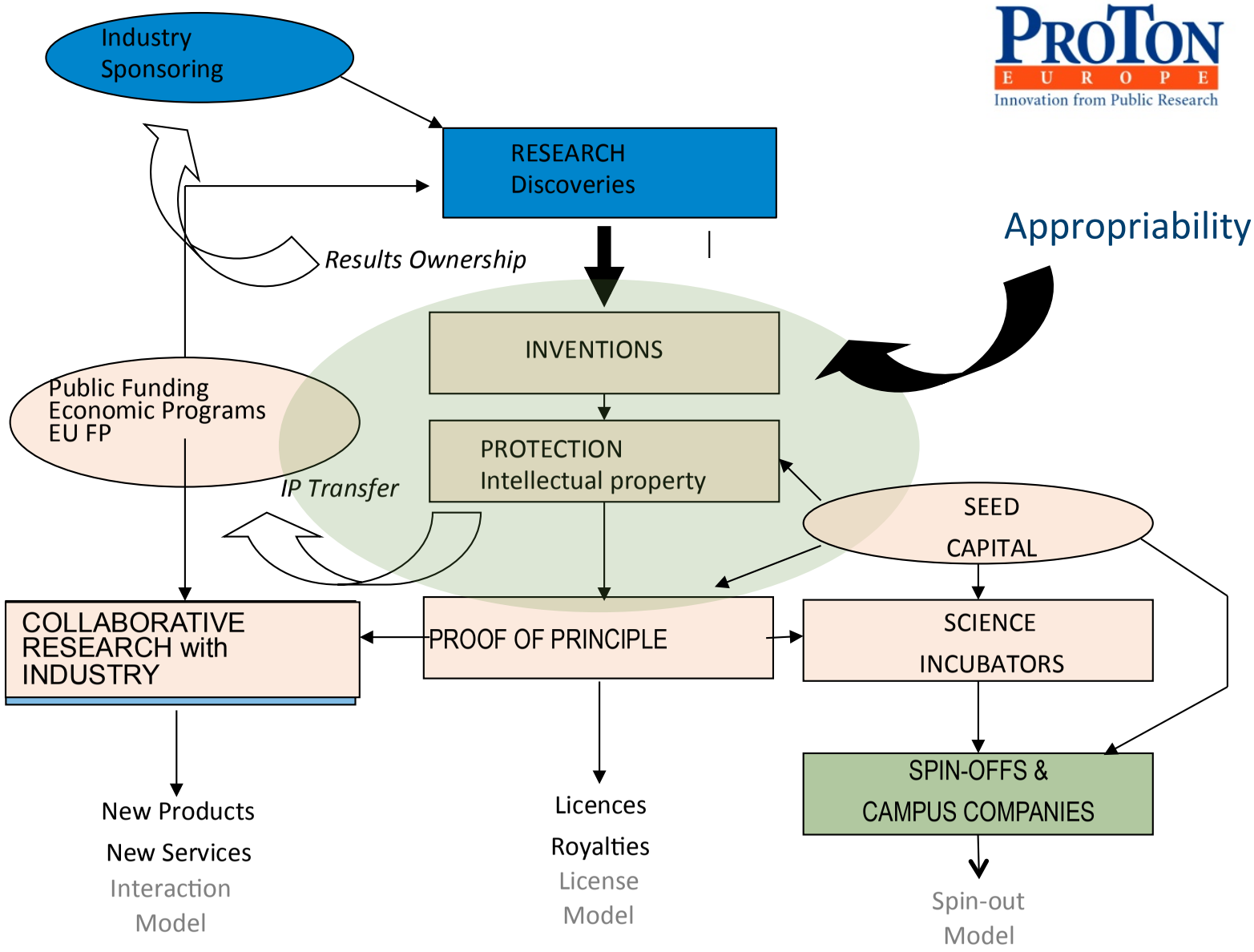
- ✓ Contract Research → Specific provisions in the Agreement
- ✓ Funding for scholarships → Specific clauses in the Agreement
- ✓ Joint Laboratories → Specific clauses in the Agreement
- ✓ Licensing → Licence agreement
- ✓ European Projects → Specific provisions in CA
- ✓ National and Regional Projects → Specific Agreement

The Technology Transfer function

PROTON EUROPE
Innovation from Public Research



IPRs generation process



The Parties and their perspectives: Industry vs Academia

- **Industry's interest in collaboration with Universities:**

1.Solve problems

2.Develop a competitive advantage

3.Catch profit opportunities

•More relevant ?

•**Impact**

•New ideas or solution to problems, new methods of analysis, new intellectual property of potential benefit for the company

•**The University's interest in collaboration with companies:**

- not in competition with Industry = no direct use of IPRs
- complementary = support to the industrial development towards exploitation
- recognition and reputation

Source: AICIPI-NETVAL Model, R. Tiezzi

Industrial approach to collaborations

In a collaboration whit the University, Industry usually tends to:

- claim the ownership of the research results (IPRs)
- retain full control of IP procedures and confidentiality measures
- keep title and interest in exploiting of the results according to a specific strategy (direct expoitation, licensing out…even publication!)

Source: AICIPI-NETVAL Model, R. Tiezzi

Collaboration structure

- Definition of the objectives: research program
- Budgeting and definition of each role/contribution: financing of the company and co-financing of the university
- Identification of “pre-existing know how”: MTA, patents and know how
- Definition of research management: Laboratory Record Books, disclosure forms, monitoring researchers exchange

Source: AICIPI-NETVAL Model, R. Tiezzi

Collaboration structure

- Confidentiality agreement – NDA and publication rules
- Rules of ownership and exploitation (managing the co-ownership issue)
- Economic structure of IP transfer (options, license, assignment): from the fees for the inventors to royalties

Source: AICIPI-NETVAL Model, R. Tiezzi

Models: Non Disclosure Agreement

AIM: to keep confidential the exchanged information

SCENARIO: meeting for project proposal, company collaboration proposal, request for a company service/prototyping, hiring of new collaborators, diploma work preparation etc.

Parties: only the one that is receiving the information

or in case of Mutual NDA both Disclosing and Receiving Party have to keep confidentiality on information.

Duration: 2-5 years

Warnings: Define the scope of the exchange of information very precisely; avoid clauses that are not specifically related to confidentiality and expecially clauses related to IP rights.

Fac- simile

Model: Joint Invention Agreement (basic version)

BETWEEN

Company

AND

University…..

FOR the filing and exploitation of the invention „Name“.

The parties agree upon the following:

XXXXXXXXXXXXX and University are **seeking to file an international patent** based on a joint invention titled “_____”;

XXXXXXXXXXXX and University will **share the ownership** of the patent and **the cost of** filing according to the following percentages: XXXXXXXXX: 50%, UNIVERSITY:50%;

XXXXXXX has **the exclusive right of commercialisation** of the above mentioned invention, further related to “Name”;

XXXXXXX will be in charge of **choosing the nations** where the patent will be further submitted within 30 months from the filing, according to the **market** needs of the above patent; the costs of national phases and the maintenance costs will be sustained by XXXXXXX that will **inform University** about the nations where the patent has been filed.

XXXXXXX will **pay to University a royalty** of 5% on the sale of the “Name”;

After the agreement is in force, the patent application shall be placed and an official letter of reception shall be presented before any information of the invention could be published by each party.

This agreement shall be in force after the legal representatives of both XXXXXXX and University has signed it.

Any changes to this agreement shall be made in written form.

The agreement shall be valid until no other stipulations have been agreed upon.

Model: IP Management Agreement

AIM: to manage the IP generated in the framework of project activities or for joint labs with other universities or companies

SCENARIO: partnership to apply for project proposal, company collaboration/research contract proposal, joint lab establishment

Parties: all the parties involved

Duration: the same as project/collaboration duration, but some clauses may last longer (confidentiality, IP titles mainteinance)

Shares and Costs: define who is in charge of administrative management of IP, what are the % of ownership, who's paying the fees

Exploitation: who is in charge for looking potential customers, if there's a company in the partenrship is the exploitation assigned to that company? How many royalties are paid to the others?

Decisions: Filing, mainteinance, exclusive- non exclusive licences are decided by qualified majority, simple majority?

IP Clauses in Third Parties Research Contracts

Confidentiality

(similar to clauses of NDA)

IP shares, management, exploitation

(simplified but similar clauses to IP MGMT Agreement; try to have 50% of IP ownership and % of royalties)

Publications

(university keeps the right to publish but usually has to verify the content of the paper with the company to understand if there's IP that can be protected, in that case the company may ask the university to wait 30-60 days before publishing in order to file the patent first)

LA VALORIZZAZIONE DELLA PROPRIETA' INTELLETTUALE MEDIANTE IL LICENSING

Technology transfer agreement

Art. 1.1 b) Rule 772/2004/CE defines the TT agreement as « ***a*** *patent license agreement, a know-how license agreement, a software copyright license agreement or a mixture of the above, including any such agreement containing clauses for the selling and buying of products or licensing of other Intellectual property intangible rights or assignment of intangible property rights (.....) assignement of patents, know-how, software copyrights, or a combination of such rights, whre a part of the risk of the technology exploitation is in charge of the assignor/licensor (patent rejection) (.....)*».

Technology Transfer Agreement

Agreements bringing dissemination of innovation to the market/Intellectual property rights agreement for the research results .

Indirect use of intellectual properties and technology market.

Technology Transfer agreements

- Confidentiality agreements (NDA, CA)
- Term sheet
- Memorandum of Understanding; Head of agreement
- IP License Agreements
- IP Assignment
- Research and development agreements
- Collaboration Agreements
- Material Transfer Agreements (MTA)

Negotiation phase

- **Freedom to operate** (counterfeit/third parties rights that could stop activities of the Licensee : contract evaluation– contractual warranties)

- **Due Diligence** (technology evaluation, protection, market, development time and cost) needed in order to decide what a comapny has to acquire and if acquire or not- Checklist with all the points to check during the diligence phase (ownership, third parties rights, status of the protection, administrative issues, patent portfolio, geographical coverage, quality of the protection, titles of the protections, litigation)

Contract negotiation

Preliminary Agreements:

- Confidential Agreements (Confidentiality Agreement; Non Disclosure Agreement)

- Further preliminary agreements (Term –sheets, Head of Agreement; Memorandum od Understanding), first refusal right, options;

Negotiation phase

Confidential Non – Binding Term Sheet: Licence of Technology

Background to the technology	
Parties	**X (Licensor); Y (Licensee)**
Scope of Licence	**Exclusive/Non –exclusive – In the fileds…/ all fields** **Subject ti the license back to the University for non commercial use of the licensed Technology and the licensees improvements** **The license will be non exclusive with respect to the licensed background** **Sublicence**
Licensed Products	**Any product, servuce or composition which is entirely or partially produced by means of the licensed Technology**
Licensed Technology	**(n. Patents; …..); know how; Licensor's improvements for a paeriod of 2 years**
Territory	**worldwide or…….**
Field of Use	**All fields or……..**
Liability	**No warranties prodided by the University**
Signing Fee	
Patent Cost	
Royalty Rate	
Milestone payments	
Minimum sums	
Fee income royalty rate	**x% of any sublicensing fees that the licensee receives for sublicensing the licensed technology with a third party**
Dilgence obligations	**Licensee must use its best endeavours to develop, exploit and market the licensed technology to maximise the financial return for both parties and in accordance with the development plan**
Term	
Governing Law	
Additional Terms	

License agreement

Agreement between the owner of the intellectual or industrial property right or the licensing authorized party -- (“the licensor") and the party to whom the right of use is licensed (“the licensee").

The owner transfers its right giving the authorization to the other party to what would be prohibited on the contrary. (art. 66 Italian code of Industrial property CPI)

Il contratto di licenza

Contratto atipico, di durata, in cui il titolare della tecnologia intende concederne a terzi il diritto d'uso temporaneo, esclusivo o non esclusivo, mantenendone la proprietà. Il licenziante limita la pienezza del suo diritto di esclusiva nella misura contrattualmente pattuita.

Scarso intervento del legislatore ⟹ autonomia negoziale.

Raccomandata forma scritta ⟹ trascrizione del contratto presso il registro competente per i diritti concessi (pubblicità dichiarativa).

Vincoli normativi:

-Relativi al trattamento fiscale dell'operazione;

-Relativi ai vincoli di trasferimento di alcune tecnologie (tecnologia militare e biotecnologie);

-Relativi alla normativa antitrust e sugli aiuti di stato

L'opportunità della licenza

Vantaggi per il licenziante:

•Conseguimento di mercati altrimenti preclusi (es. Università) o espansione in nuovi mercati.

•Entrate mediante sfruttamento indiretto della propria IP.

Svantaggi per il licenziante:

•Dipendenza dalla capacità e affidabilità del Licenziatario

•Concorrenza da parte del Licenziatario

•Minori vantaggi dello sfruttamento indiretto della propria IP

L'opportunità della licenza

Vantaggi per il Licenziatario:

•Accesso a tecnologie avanzate, innovative e già sperimentate per quei soggetti che non hanno risorse sufficienti per portare avanti ricerca e sviluppo in proprio

•Accesso a nuove tecnologie che possono portare a nuovi prodotti, servizi e nuove opportunità di mercato

Svantaggi per il Licenziatario:

•Dipendenza dalla tecnologia del Licenziante

•Immaturità della tecnologia

Parti, premesse e definizioni

- Indicazione delle parti (riferimenti)
- Premesse finalizzate alla descrizione dei presupposti fattuali e dei titoli di proprietà industriale che originano il negozio giuridico (intenzioni delle parti contraenti, elencazione dei diritti e titoli IP coinvolti, lo stato attuale e le finalità della negoziazione) Il contenuto delle premesse è usato dagli interpreti per individuare la volontà effettiva delle parti, quando è poco chiara.
- Definizioni funzione di circoscrivere le aree di significato dei singoli termini chiave (spesso molto tecnici) a valere nell'ambito del testo contrattuale, ed hanno la finalità di limitare gli spazi di incertezza e le libertà ermeneutiche delle parti in fase di esecuzione dell'accordo.

Oggetto della licenza

Le licenze possono avere ad oggetto qualsiasi diritto di proprietà intellettuale o industriale:

-brevetti;
-modelli d'utilità;
-Design;
-Marchi;
-Diritti d'autore;
-Know-how, Informazioni segrete e segreti commerciali.

È importante che i diritti siano individuati in modo puntuale: riferimenti precisi e dettagliati alle privative. Nel caso in cui si tratti di numerosi brevetti o di un brevetto tutelato in diversi paesi è opportuno predisporre un allegato.

Se si tratta di know-how è raccomandabile descriverlo in un allegato soggetto a vincolo confidenziale.

Oggetto della licenza

- Specificare quali diritti sono Concessi. La natura dei diritti conferiti dipende dall' oggetto della Licenza (produrre, usare e vendere nelle licenze di brevetto e modello; riprodurre, rappresentare, modificare o distribuire nelle licenze di copyright...)

- Possibili limitazioni a certi «ambiti d'uso»

- Riserva espressa di *research exemption* per le Università e i centri di ricerca nelle ipotesi di licenze esclusive (art. 68 CPI)

Tipologie di licenza

Esclusiva: assoluta o relativa a determinati campi d'uso o territori. Co-esclusiva

Non esclusiva: Il licenziante non dipende dal successo di un solo licenziatario.

Esclusiva: il licenziante deve proteggersi nel caso di scarso rendimento del licenziatario (minimo garantito, penalità…)

Territorio

Dove, per quali territori, è concessa la Licenza (mondiale, in determinati Stati, in determinate zone degli Stati)

Durata

Dipende dall'oggetto della licenza e dalle necessità economiche e commerciali dei contraenti; può terminare alla scadenza del titolo di IP; può essere pattuita per periodi determinati con facoltà di rinnovo; salvo recesso anticipato.

Obbligazioni delle parti

OBBLIGAZIONI DEL LICENZIANTE

Trasferimento dello sfruttamento della IP licenziata, spesso unitamente a servizi accessori (assistenza)

Garanzie: sulla titolarità dell'IP e sulla validità dell'IP; sulla contraffazione (FTO); sul funzionamento e idoneità all'uso della tecnologia.

Intraprendere le azioni necessarie per realizzare e commercializzare la tecnologia nel territorio

Obbligo di corrispondere corrispettivo pattuito

Obbligo di rendicontazione e comunicazione dei perfezionamenti della tecnologia

OBBLIGAZIONI DEL LICENZIATARIO

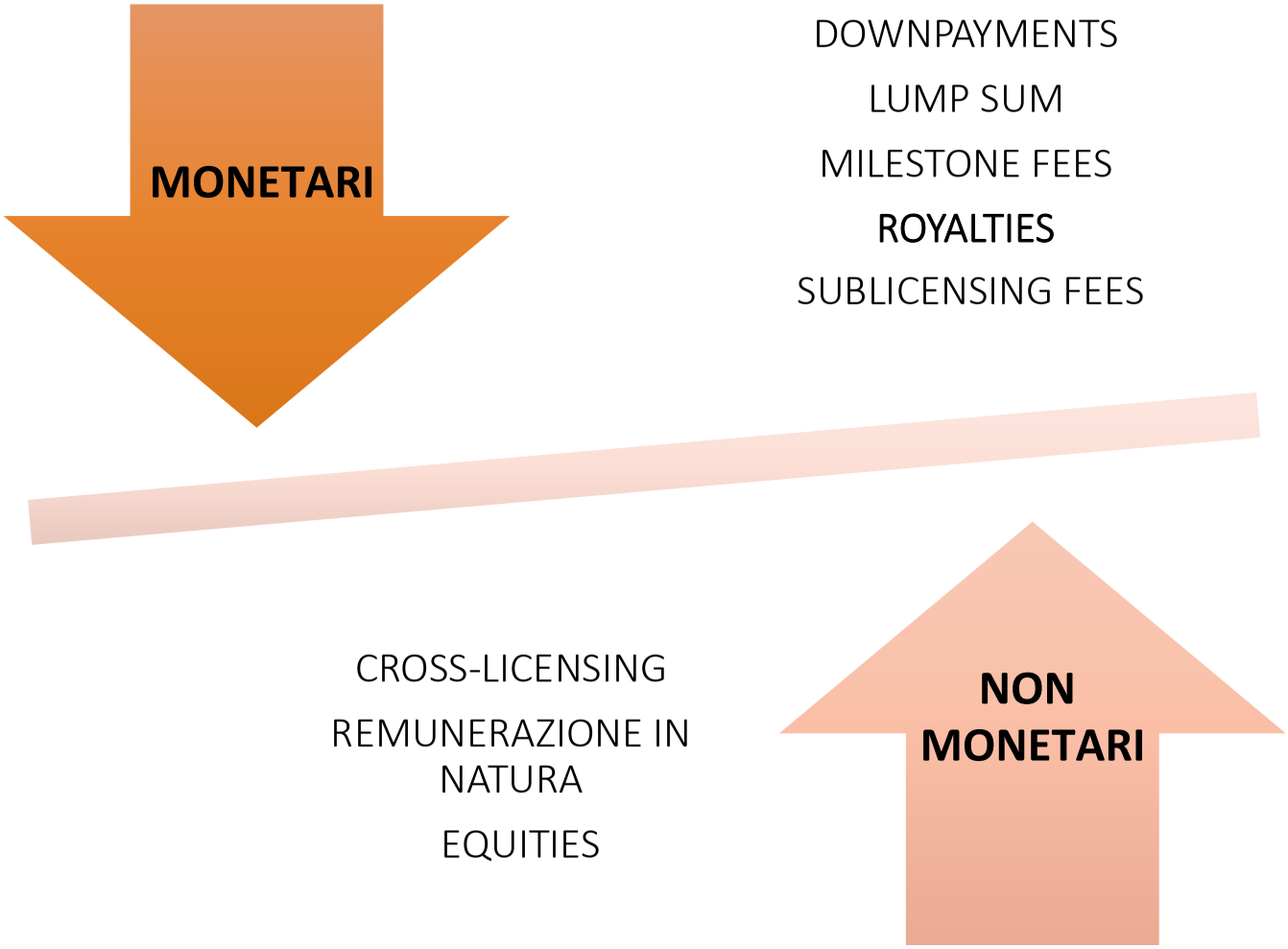
Corrispettivi

- È possibile che la licenza sia concessa a titolo gratuito, ipotesi frequente nel caso di contratti di licenza infra gruppo.

- Fattori di determinazione del corrispettivo:

✓importanza e ampiezza della privativa concessa (territorio, esclusiva);
✓eventuale fornitura di supporti e servizi tecnici aggiuntivi
✓dati di mercato relativi a transazioni analoghe ovvero al mercato della tecnologia cui l'oggetto del bene licenziato si riferisce.

Corrispettivi



Perfezionamenti

Definire, previa negoziazione, la disciplina dei perfezionamenti

La sublicenza

- ✓ Interesse del Licenziatario per consentire una **maggiore diffusione della tecnologia** e una penetrazione del mercato più capillare

- ✓ Può essere richiesta, e prevista espressamente nel contratto, l'approvazione scritta del Licenziatario per la concessione di qualsivoglia sub-licenza nonché per la scelta del sub-licenziatario e delle condizioni alle quali la sub-licenza può venire concessa.

- ✓ Le condizioni di sublicenza non devono essere peggiorative di quelle della licenza: spesso viene suddiviso in parti uguali il ricavo del licenziatario.

Monitoraggio del licenziatario

Inadempimenti del licenziatario:
1. Inerzia nell'exploitation della tecnologia licenziata
2. Underreporting
3. Inventing and patenting around
4. Eventi di dissesto del licenziatario
5. Eventi straordinari e imprevedibili

Rimedi contrattuali:
- ✓Clausole sul livello di diligenza richiesta al licenziatario (best efforts; due diligence)
- ✓Minimi garantiti
- ✓Dovere di contabilità accurata e accesso alla contabilità del licenziatario
- ✓Dovere di rendicontazione periodica
- ✓Ruolo delle running royalties
- ✓Conversione della licenza
- ✓Diritto di recesso
- ✓Condizioni sospensive o risolutive
- ✓Clausole risolutive espresse

Altre clausole

- ✓ **Contraffazioni**: Cosa succede in caso di contraffazione; Obblighi di collaborazione e assistenza e supporto reciproci.
- ✓ **Garanzie**: sulla titolarità dell'IP; sulla validità dei titoli; sulla brevettabilità dei trovati; sulla presenza di contraffazioni attive passive; idoneità all'uso della tecnologia (merchantability)
- ✓ **Clausola di non contestazione** (perdita del beneficio dell'esenzione dall'analisi antitrust - Reg. CE n. 772/2004)
- ✓ **Forza Maggiore**
- ✓ **Legge applicabile e Foro Competente**

Altre clausole

- ✓ Divieti specifici sull'uso della tecnologia sotto licenza in combinazione con altre tecnologie (cd. tainting)
- ✓ Uso dei nomi e dei marchi connessi con la tecnologia
- ✓ Obblighi di manleva e assicurativi
- ✓ Disciplina del rapporto in caso di scioglimento anticipato (smaltimento scorte e altro)

Le licenze delle Università italiane

Tabella 4.7 - Numero di licenze e/o opzioni concluse in ciascun anno considerato

Numero di licenze e/o opzioni	Numero di università					
	04	2006	2008	2	2012	2013
0		21	17			26
1-2		13	20			18
		6	6			5
6-10	6	6	2	3		1
	1	0	2	0	0	2
Numero di univers.	*44*	*46*	*47*	*51*	*51*	*52*
Totale contratti	*36*	*89*	*91*	*64*	*64*	*73*
Media contratti	*0,8*	*1,9*			*1,3*	*1,4*
Totale contratti top 5	*22*	*41*			*31*	*41*
Media contratti top 5	*4,4*	*8*			*6,2*	*8,2*

licenze attive nell'anno, passate da 27,1 a 23,3 mila Euro

8,2 licenze annue

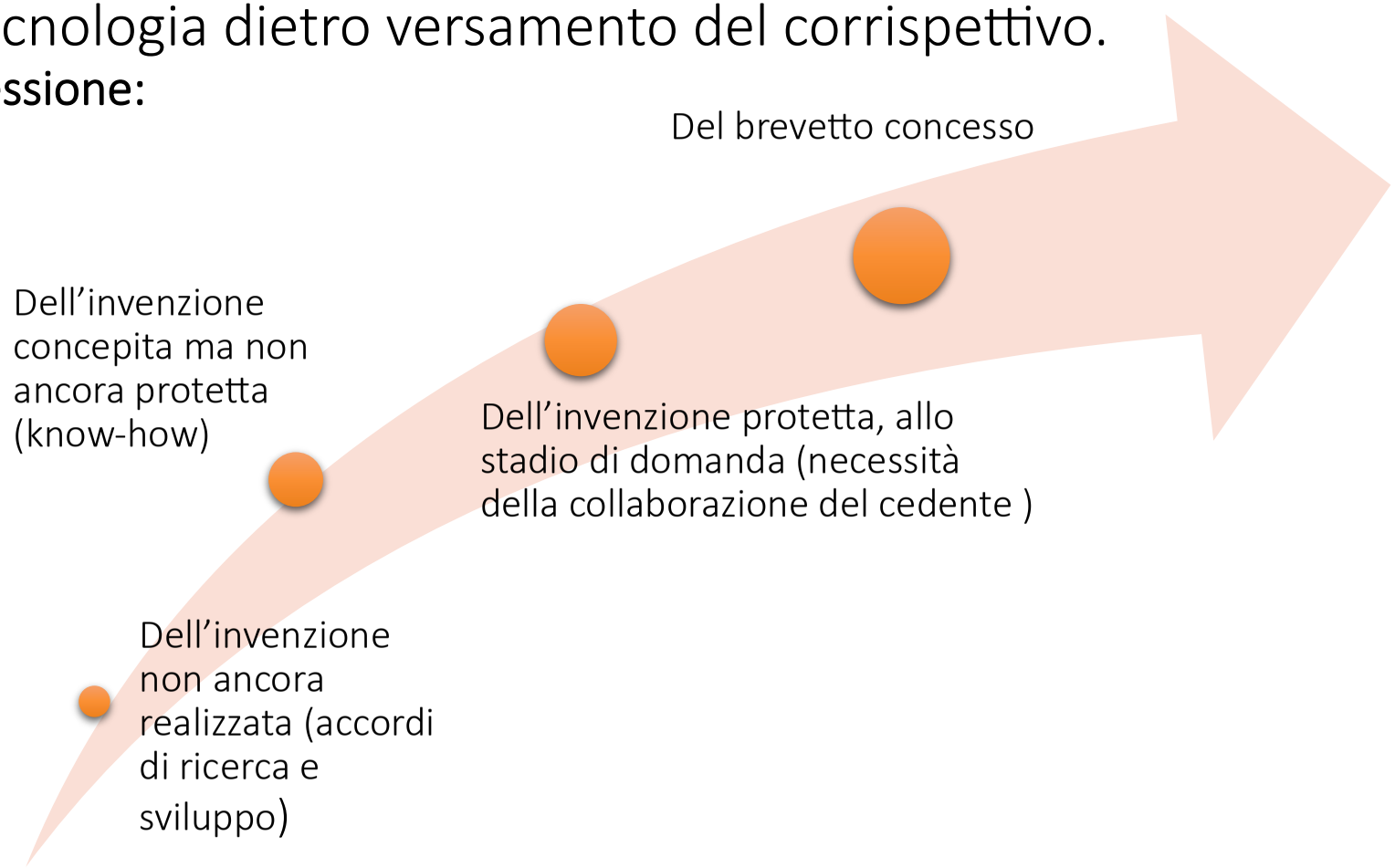
73 contratti di licenza e/o opzione

Fonte: Survey NETVAL 2015

Il contratto di cessione

Trasferimento a titolo definitivo dei diritti su una determinata tecnologia dietro versamento del corrispettivo.

4 ipotesi di cessione:



Il contratto di cessione

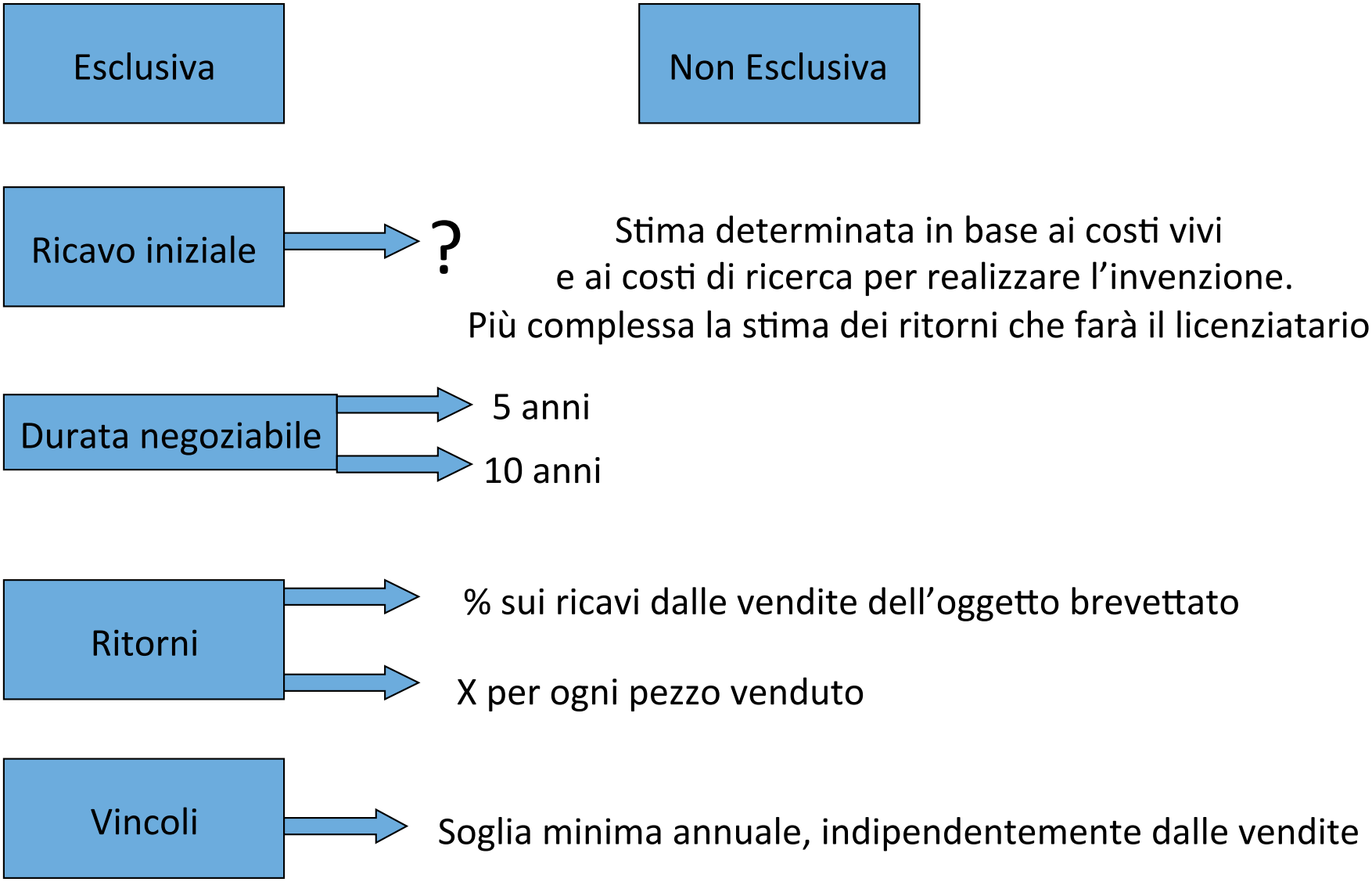
- ✓ Pubblicità dichiarativa attraverso la trascrizione presso il registro competente per i diritti concessi.
- ✓ Il cessionario si accolla tutti i rischi: tecnologico, di brevetto, di protezione, di mercato: importanza della due diligence (accertamento della titolarità di IP, diritti di terzi, status della procedura di protezione, validità), anche in funzione architettura delle garanzie contrattuali
- ✓ Nei casi di invenzioni accademiche più che mai è necessario un meticoloso accertamento sulla vita del titolo preesistente alla cessione (rapporto Università/ricercatori; rapporto Università/ricercatori/finanziatori; rapporto Università/ricercatori/committenti pubblici o privati).

Il contratto di cessione

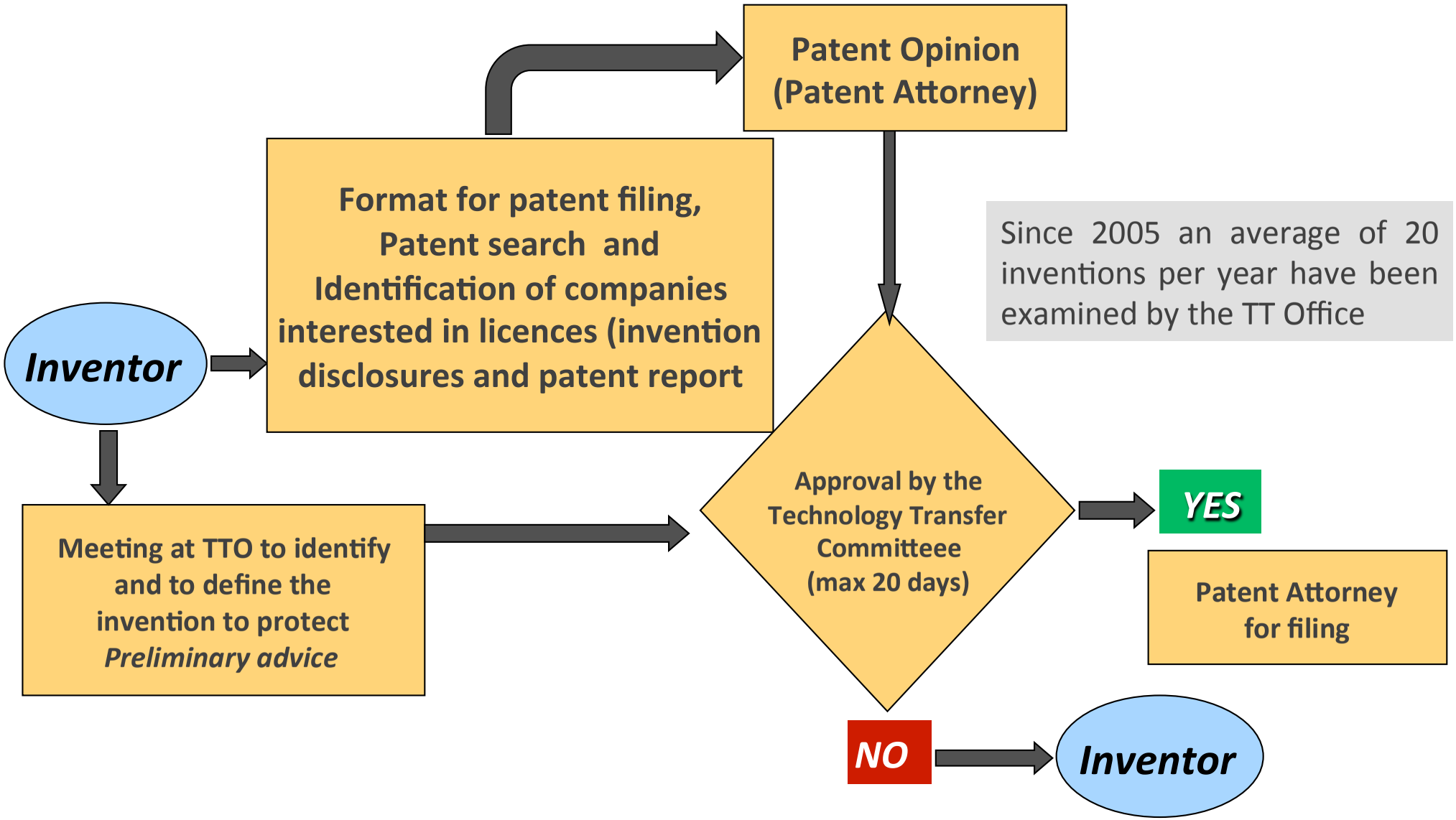
- ✓ Pur trattandosi di un trasferimento a titolo definitivo, la cessione in ambito accademico viene tendenzialmente accompagnata dalla **previsione della collaborazione degli inventori-ricercatori anche nella fase successiva al trasferimento**. E ciò per agevolare il passaggio della tecnologia, e consentire al cessionario-acquirente di realizzare al meglio la tecnologia acquisita. **Nel caso in cui unitamente alla cessione non venissero previste obbligazioni di collaborazione in capo ai ricercatori, possono essere stipulati dei contratti di consulenza professionale ex post**.

- ✓ Problematica **della determinazione del valore della tecnologia per la determinazione del corrispettivo**:
  - pagamenti una tantum (lump-sum payment)
  - corrispettivi variabili e continuati nel tempo tipo royalty.

To summarize: Licensing and cross-licensing



Il caso della Scuola Sant'anna: un esempio di procedura



Since 2005 an average of 20 inventions per year have been examined by the TT Office

Support to IP management

- ✓ UVR provides support to the Institutes and cooperate with the Legal Department for the drafting of the clauses relating to the aspects of IP, particularly in contracts research with third parties - usually companies – and other agreements (NDAs, MTAs)
- ✓ UVR has drawn up some templates of agreements and evaluates the draft of the agreements trying to find the most appropriate solution to protect the interests of researchers

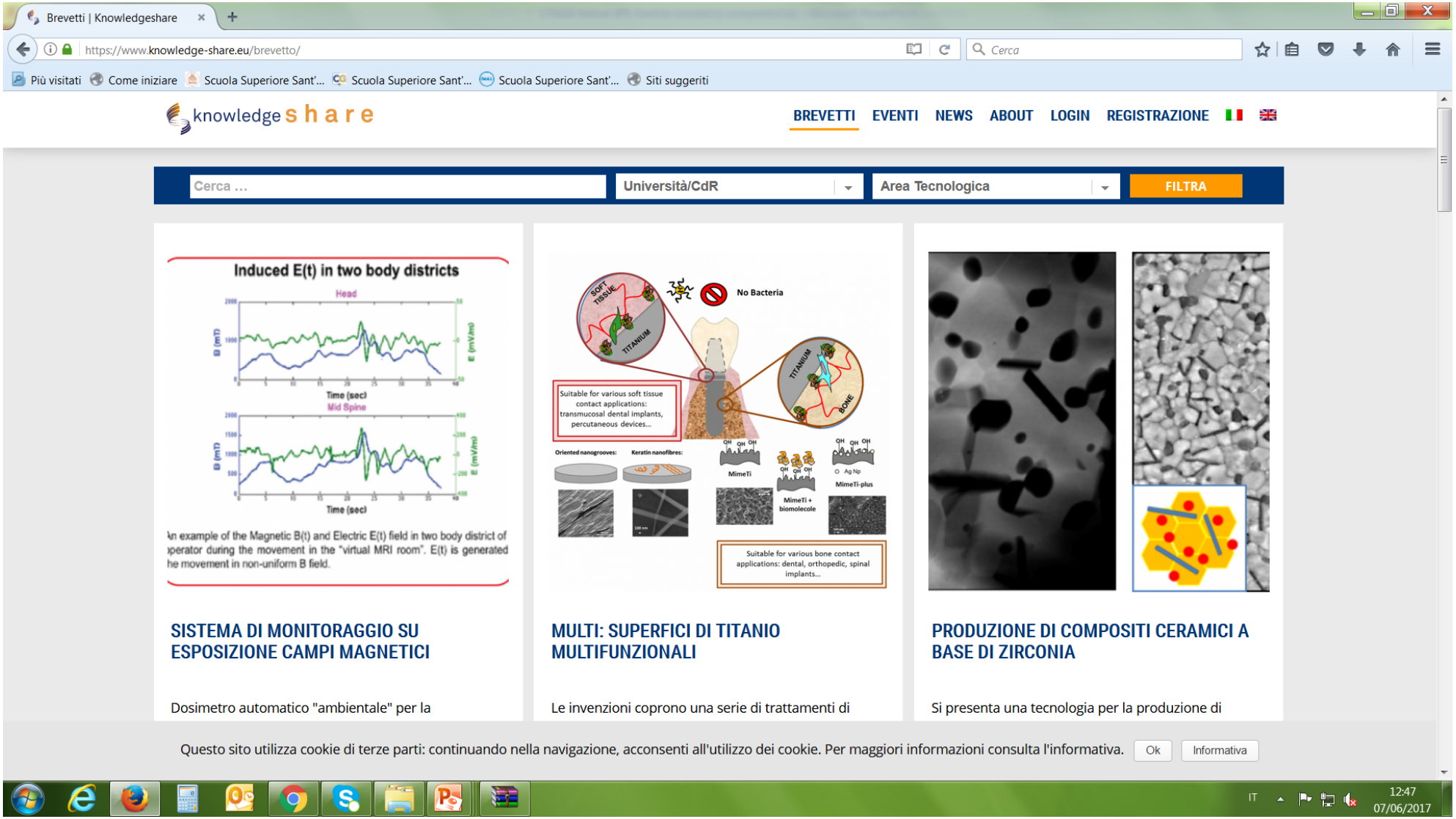
Licensing at SSSA

✓ ***Direct Licensing:*** along with other researchers, through business partners (spin-offs, project partners, local businesses)

✓ ***Licensing through:*** SSSA has established an agreement with a company
(MITO S.r.l.) for promoting the licensing of five patents

✓ ***Internal procedures*** for the assignment of patents of SSSA to third parties (approval by the Board of CVR, revision of the agreement and monitoring of revenues and contract and expiry dates)

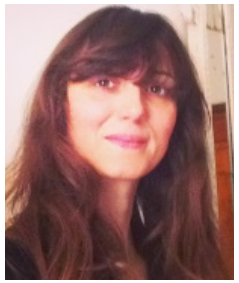
Qualche esempio di promozione



Thanks for your attention!
Q&A





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http://www.santannapisa.it/it/ricerca/valorizzazione-della-ricerca

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