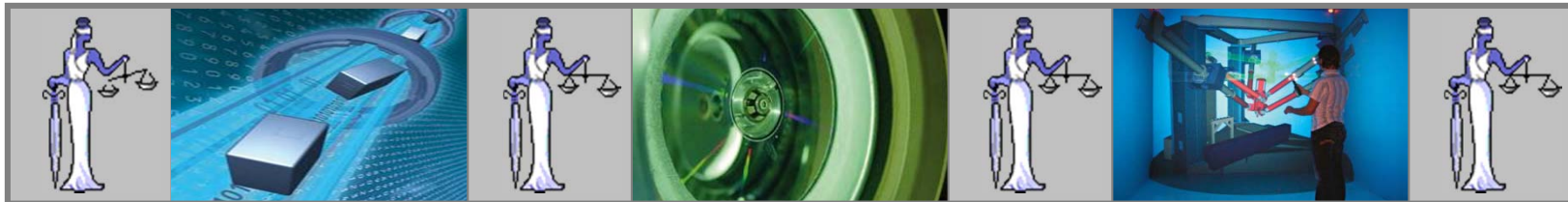

Contracts in the Technology Transfer Chain

WIPO – Conference
2012 Vienna

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Fraunhofer Headquarters Munich



Sky light sky bright – in the office



© Fraunhofer IAO

Working under the open sky – it sounds enticing, but it's seldom really a practical option.

Now, a dynamic luminous ceiling brings the sky into office spaces by creating the effect of passing clouds. This kind of lighting generates a pleasant working environment.

**A sound Agreement starts
before the Agreement**

Know-how Protection in the Preparation Phase

Naive trust in the confidentiality obligation of the partner

Missing factual control mechanisms of own Know-how

Unprotected exchange of Know-how in the preparation phase



The Use of Non Disclosure Agreements for Damage Compensation in Case of Breach of confidentiality??

- **Most Legal Systems do not compensate the real loss in case of breach of confidentiality.**
- **Disadvantage in competition cannot be figured out**
- **No legislation about this question available (at least not in Germany)**

Consequence

**Find additional effective technical protection of your IP
esp. protect electronic data against espionage**

Essential Measures for Know-how Protection

Technical:

Control **electronic data**, separate internal server recommended with **reduced access to sensitive data**

Remove Mobiles and **Memory Sticks** out of the meetings

Install a **person responsible for Know-how protection**

Legal:

Confidentiality Agreements with **satisfactory rules**

Check rules of **labour contracts** about confidentiality clauses, also **"for the time after"**

IP - Professionals for Contract-Negotiations

Check, observe and complete patent portfolio

Impact of IP in Different Forms of Cooperation

Internal IP Management and Licensing

The IP success story

Time Lag - Track Record MP3

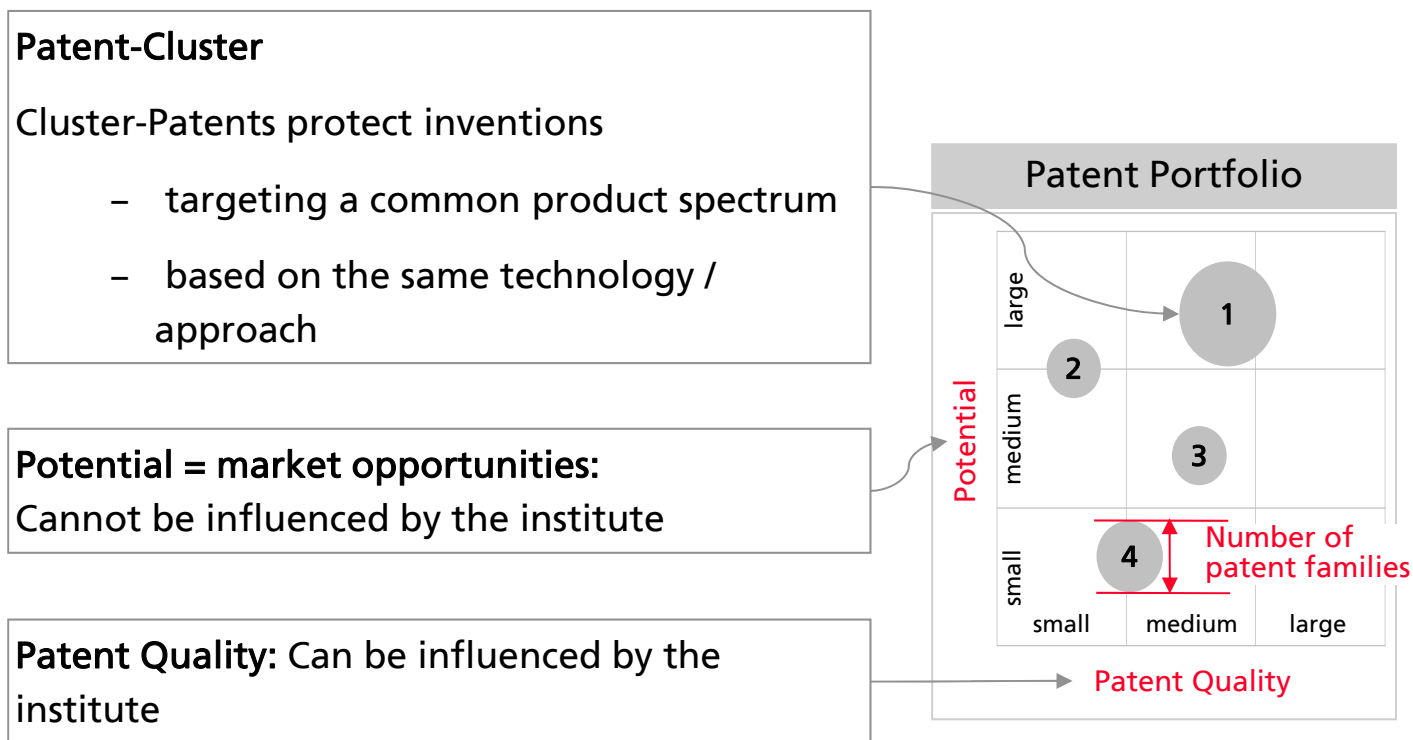


Inventors of MP3, 1987

Development of the Audio- Coding at Fraunhofer IIS in Erlangen

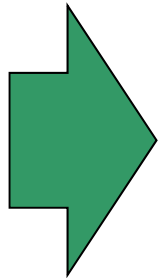
- **since 1981** Field of Research at the University of Erlangen
- **since 1987** Audio-Coding at Fraunhofer IIS
- **1992** MPEG-1 Layer 3 becomes international standard
- **July 14th, 1995** the name "MP3" is defined
- **1997** starts MP3 Internet Boom
- **1997** MP3- successor MPEG-2 AAC becomes international standard
- **2000** Federal President awards the "Future-Prize" to the inventors of MP3
- **2004-2007:** licencing venues on highest level
- **2013:** basic patent protection will elapse

A specific Portfolio-Technique tries to help to identify patent utilization Opportunities of Fraunhofer institutes



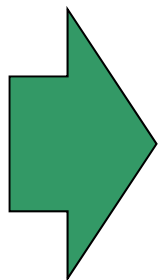
Licensing Problem: The Development Gap

In most sectors, companies will only license fully developed technologies this especially true in:



- engineering
- electronics
- physical sciences

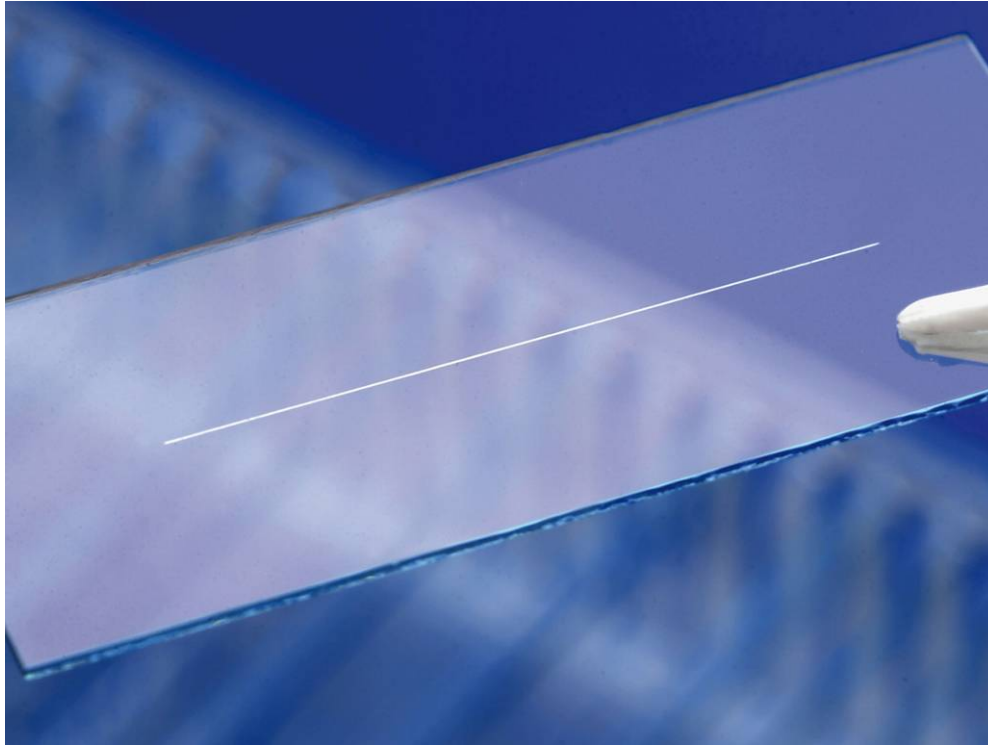
> patent protection phase is 20 years



Life Science is an exception. Projects start later;
Less time for exploitation caused by longer development
and clinical test series

> patent protection phase can be prolonged to 25 years

Conductor paths for marvelous light



© Fraunhofer ILT

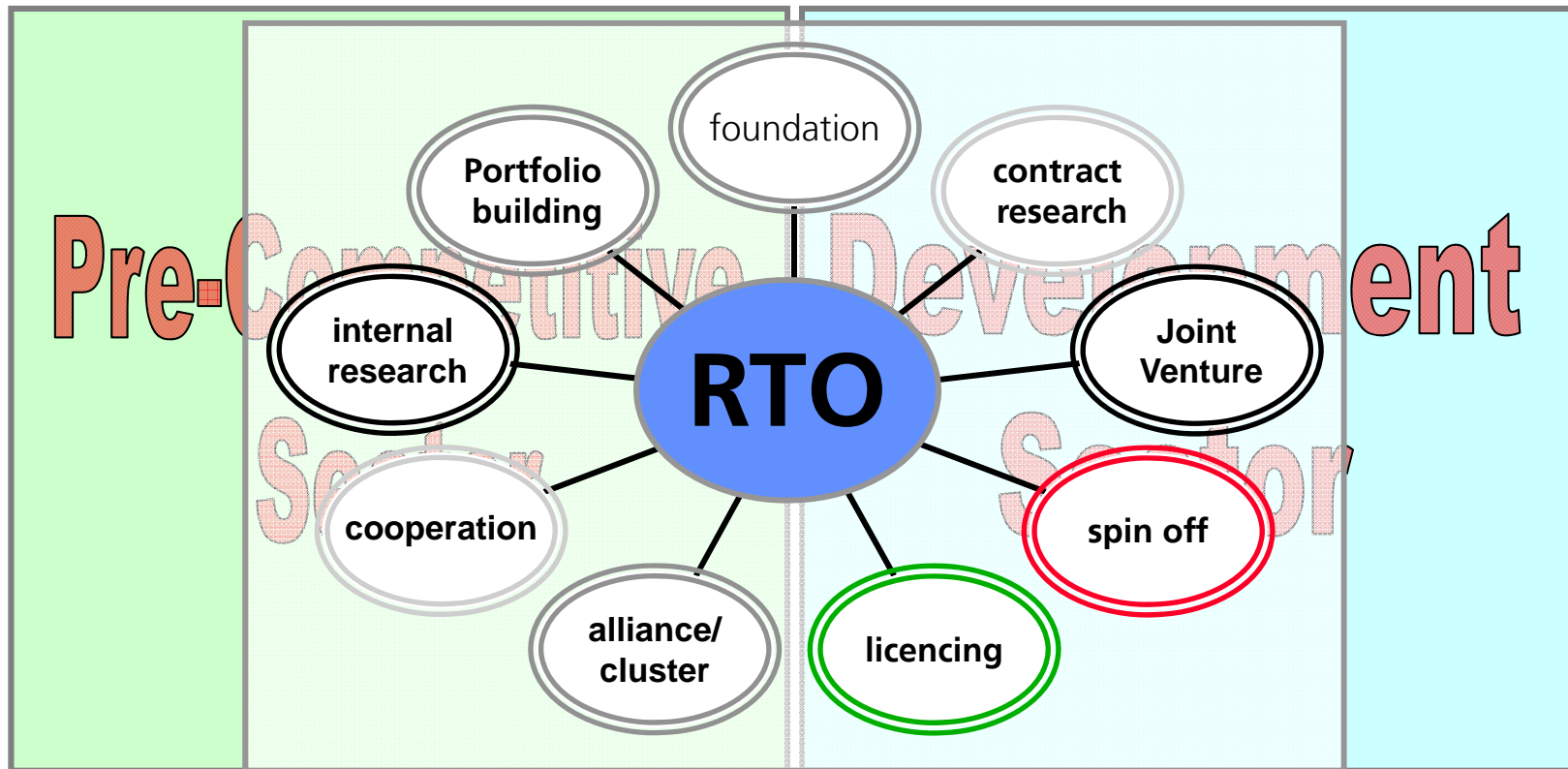
Organic light-emitting diodes are seen as the basis for a new generation of lamps: Large-area lamps that can be randomly shaped and flexibly integrated into interior design. But the “illuminated glass” is still very expensive.

Researchers want to optimize the lamps of the future and reduce the price by a new manufacturing process.

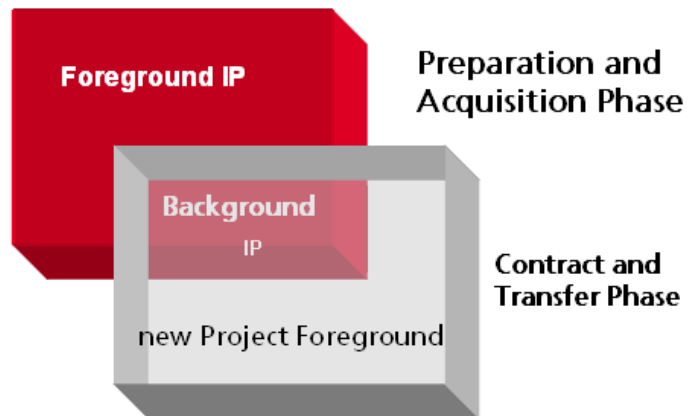
Impact of IP in Different Forms of Cooperation

Contracting (vertical and horizontal cooperation)

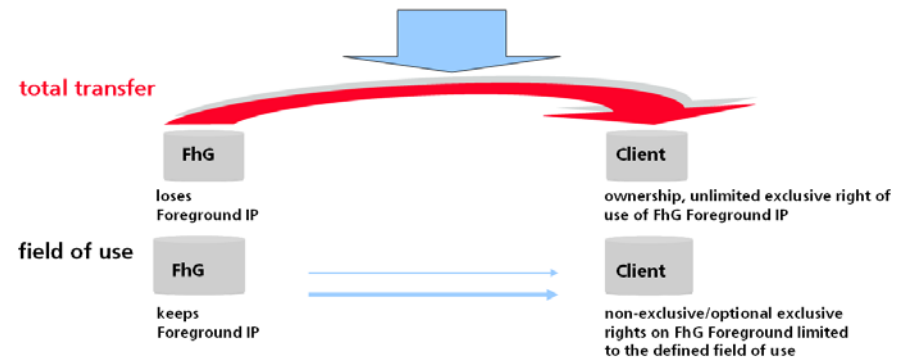
Forms of Cooperation in a Research and Technology Organization (RTO) as Knowledge Hub



Rights on the Results



Contract Research Strategies:



Europe: different - mostly total transfer (see EU guidelines 2008)

US: Universities grant regularly non exclusive license (Bay Dohle Act)

Asia: Different situation. Similar to Europe

Success and Failure close together

The Different Applications of Service-Robots

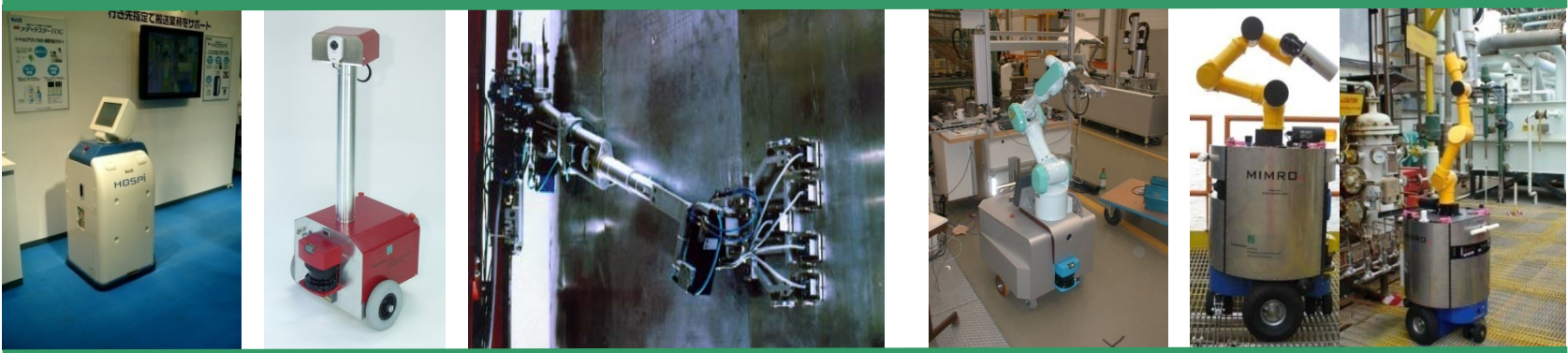


Entertainment / Info / Guidance

Housekeeping

Windowcleaning

Floorcleaning



Hospital

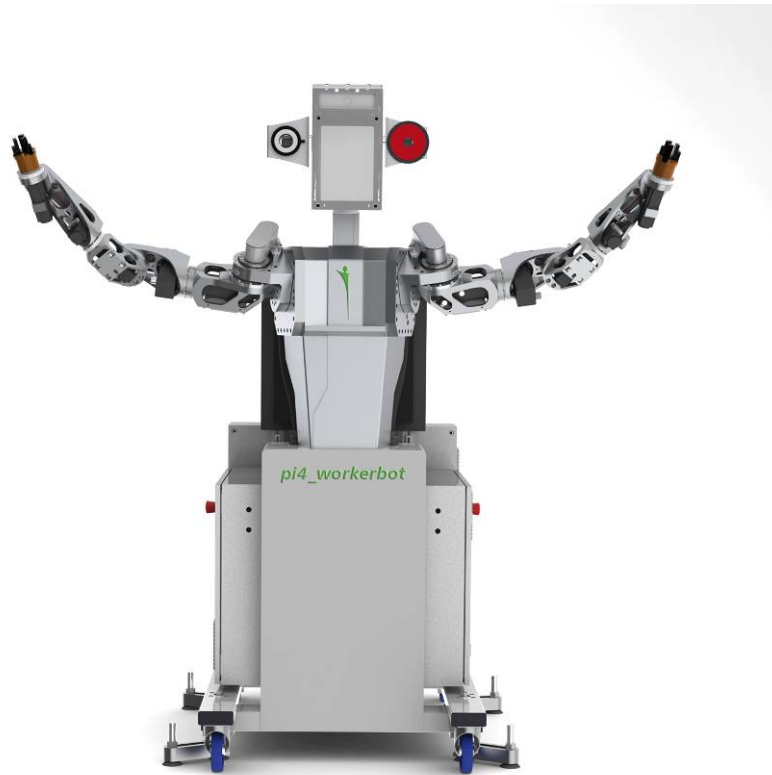
Guarding

Maintenance and Inspection

Manufacturing

Inspection of chemical facilities

A robot with finger-tip sensitivity



Two arms, three cameras, finger-tip sensitivity and a variety of facial expressions – these are the distinguishing features of the pi4-workerbot. Similar in size to a human being, it can be employed at any modern workstation in an industrial manufacturing environment.

Its purpose is to help keep European production competitive.

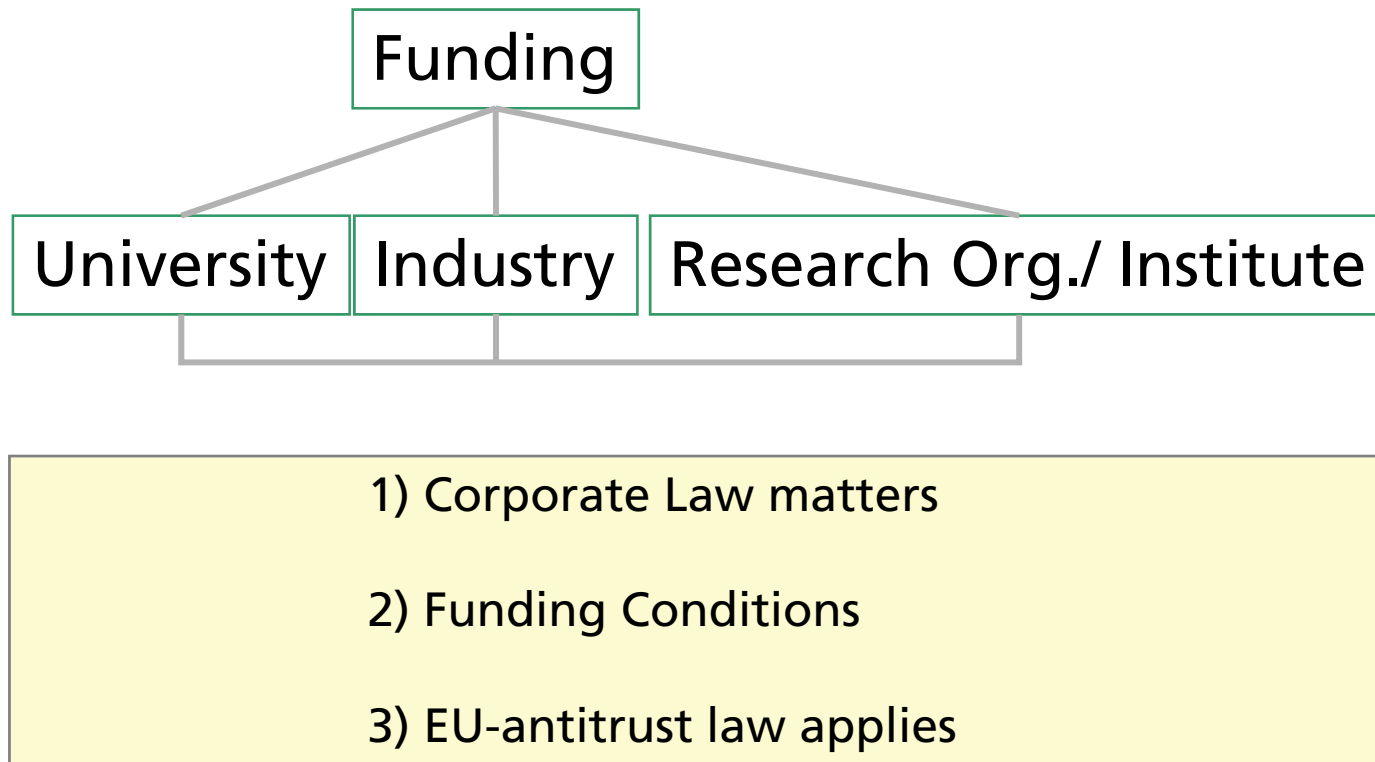
© pi4_workerbot

The Infringement Problem in R&D Contracts

Client: guarantee for no conflicting rights in the commercialisation phase
R&D Performer: No guarantee, but hold harmless against third party claims

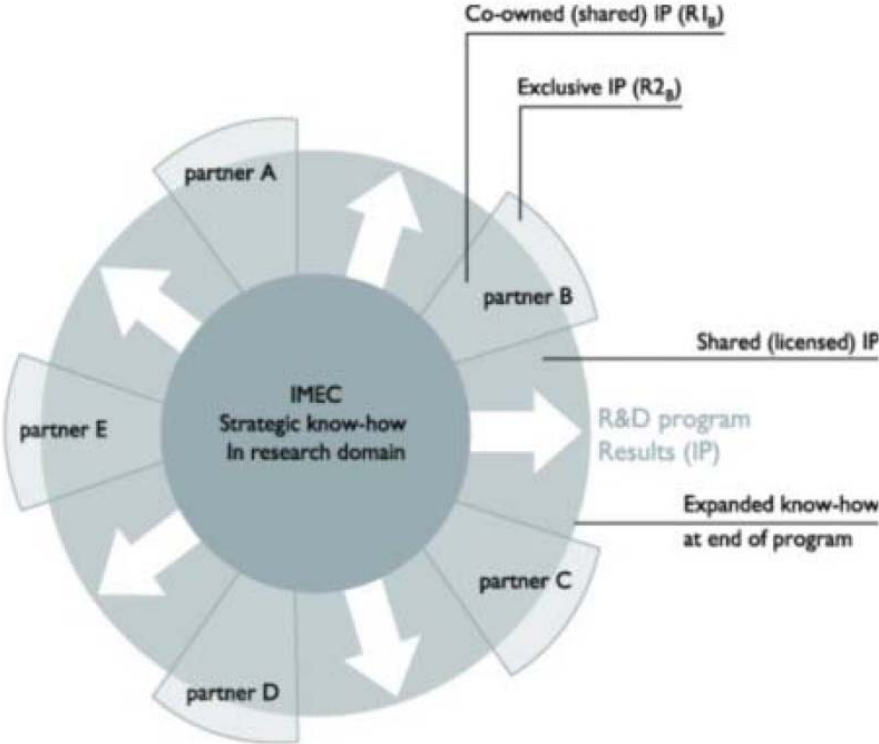


Collaborative Research



Collaborative Research

IMEC-model - Best Practice



<http://www.imec.be/ScientificReport/SR2008/HTML/1225271.html>

In brief

**Challenges of Strategic Alliances
and Joint Ventures in R&D**

Alliances or »Joint Ventures« in R&D

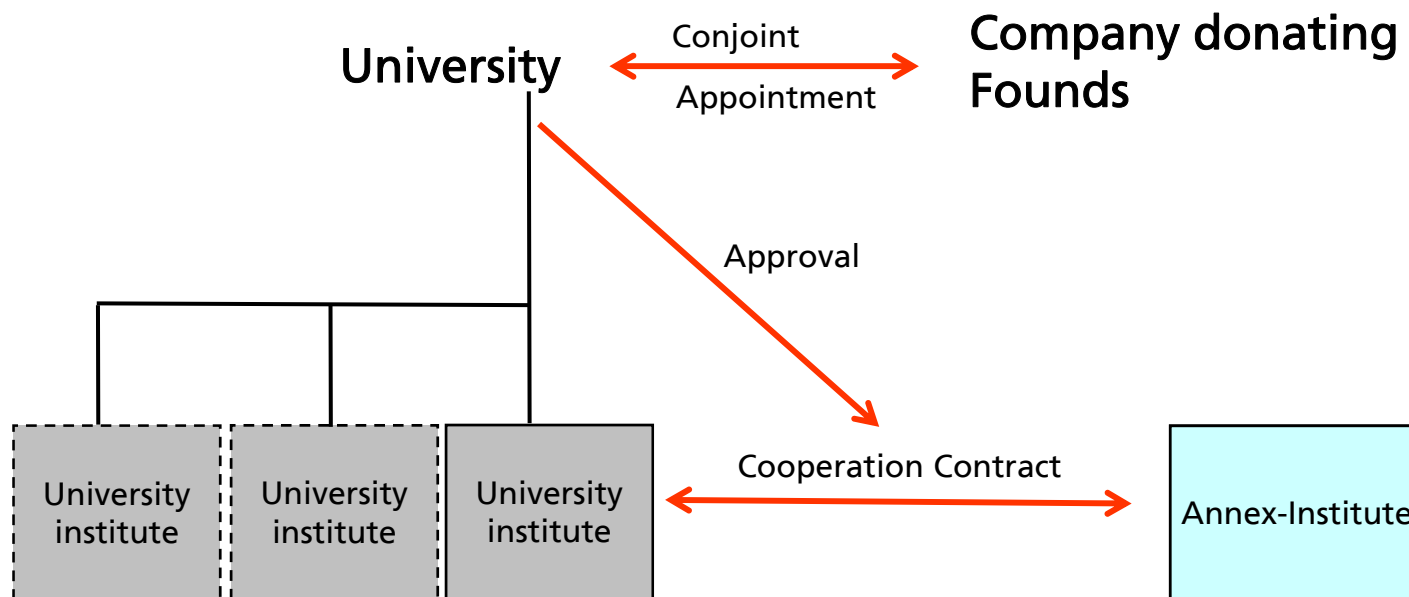
Negotiations about

- IP Pools - question of costs
- joint ownership - how to exploit
- industry exploitation -sharing the revenues
- joint development and/or exploitation company

Legal problems

- EU - Competition law "cross subzidation"
- Non for profit - Status of PRO's
- Virtuelbinding models : EIT, JTI, with different exploitation schemes
- Balancing the interests of stake-holders is often extremely difficult

University Cooperation Model: »Annex-Institut« (Research Institute associated with a University)



IP-Scheme »Annex-Institute«

excellent basis for creating joint IP competence, Research and industry cooperation under the roof of the university

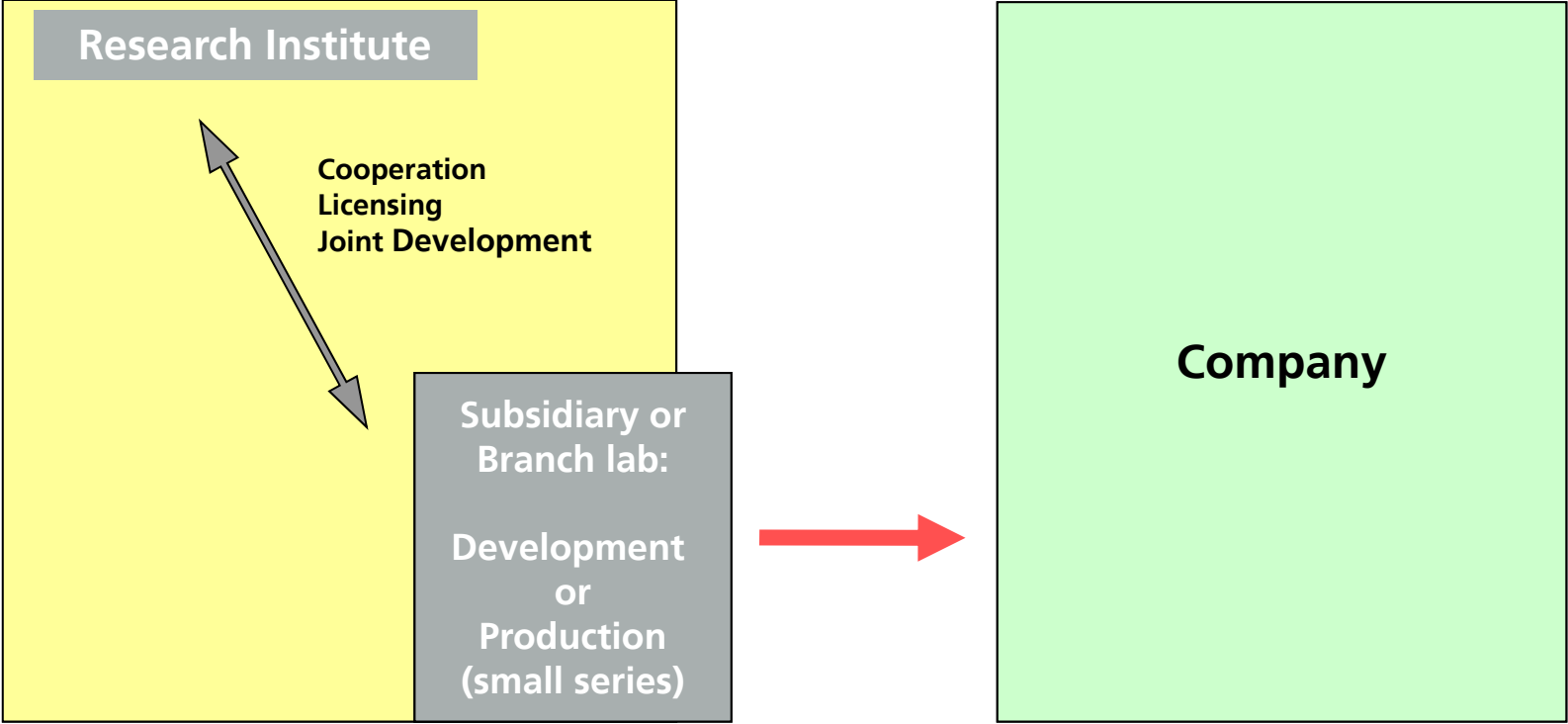
IP-schemes enable direct transfer

Annex-Institute is directly involved in creating and exploiting IP

Transfer of IP through brains, university staff may be hired by company

Neighbour institutes have chance to increase knowledge base

Cooperation Model »Spin In«

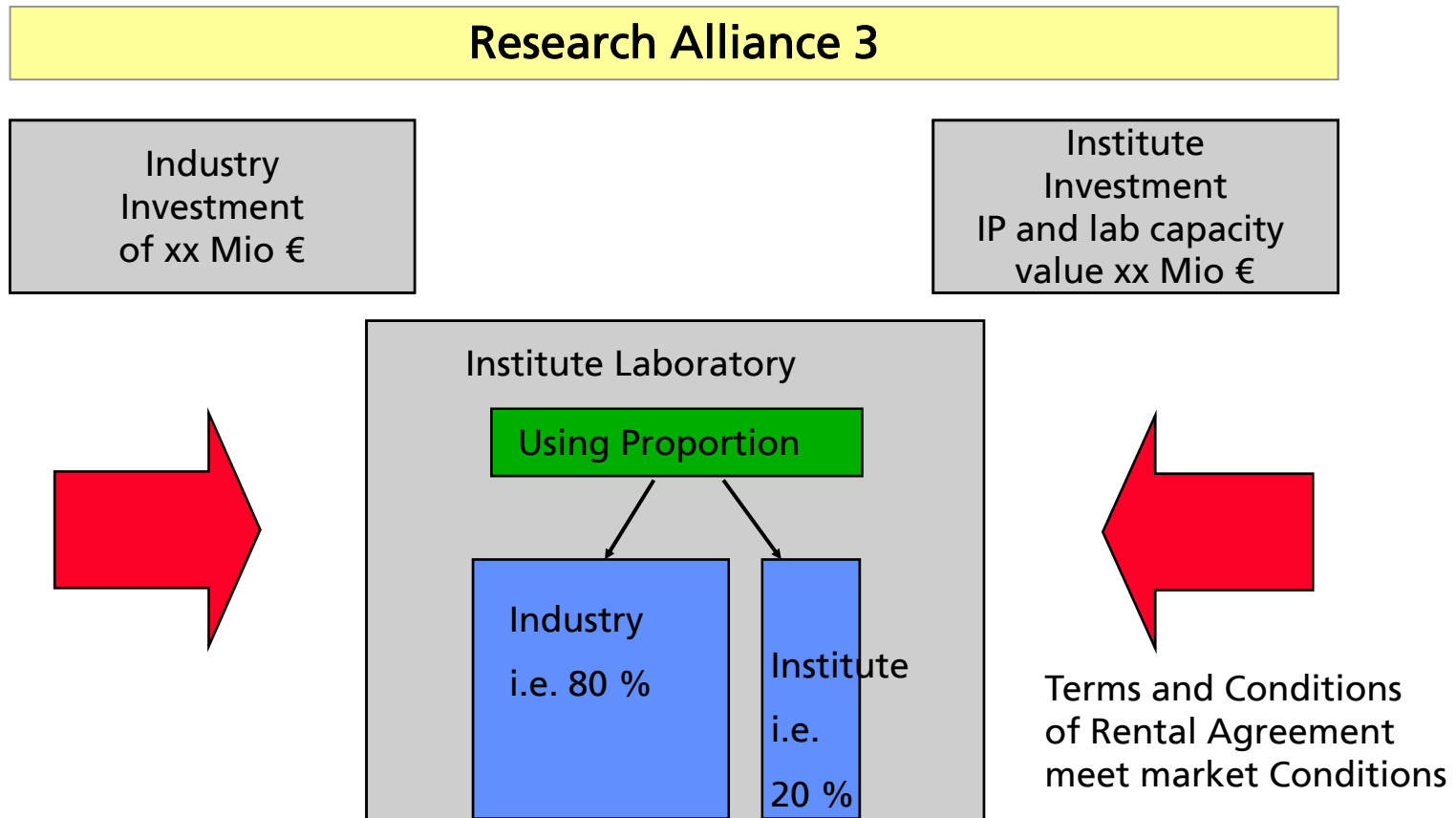


IP-Scheme »Spin In«

Rental-models do not influence the IP-rules directly
Additional cooperation schemes determine the IP-rules

IP-access on preferential conditions
discussions about IP-Property

Cooperation Model: Joint Platform Science / Industry (compare JTI -system of the EU)



IP-Schemes Sharing the Resources

Joint use of resources and mutual "learning by doing":
no exclusive transfer of institute's competence!

Strong impact of competition law

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2012 -Vienna

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GAME OVER

