

How do we do Knowledge Transfer?

Contractual tools:

Introduction to licenses and
KT partnership agreements

What is a license?

It is a bit like **renting** your house

You let the tenant use your house for a specific period of time, in exchange for a fee

Although they are allowed to use it, they do not own the house

They agree to a particular set of terms and conditions

If they break the agreement, they might not be allowed to use the house any more



LICENSES

MAIN ELEMENTS OF THE AGREEMENT

What are we licensing?

Subject matter

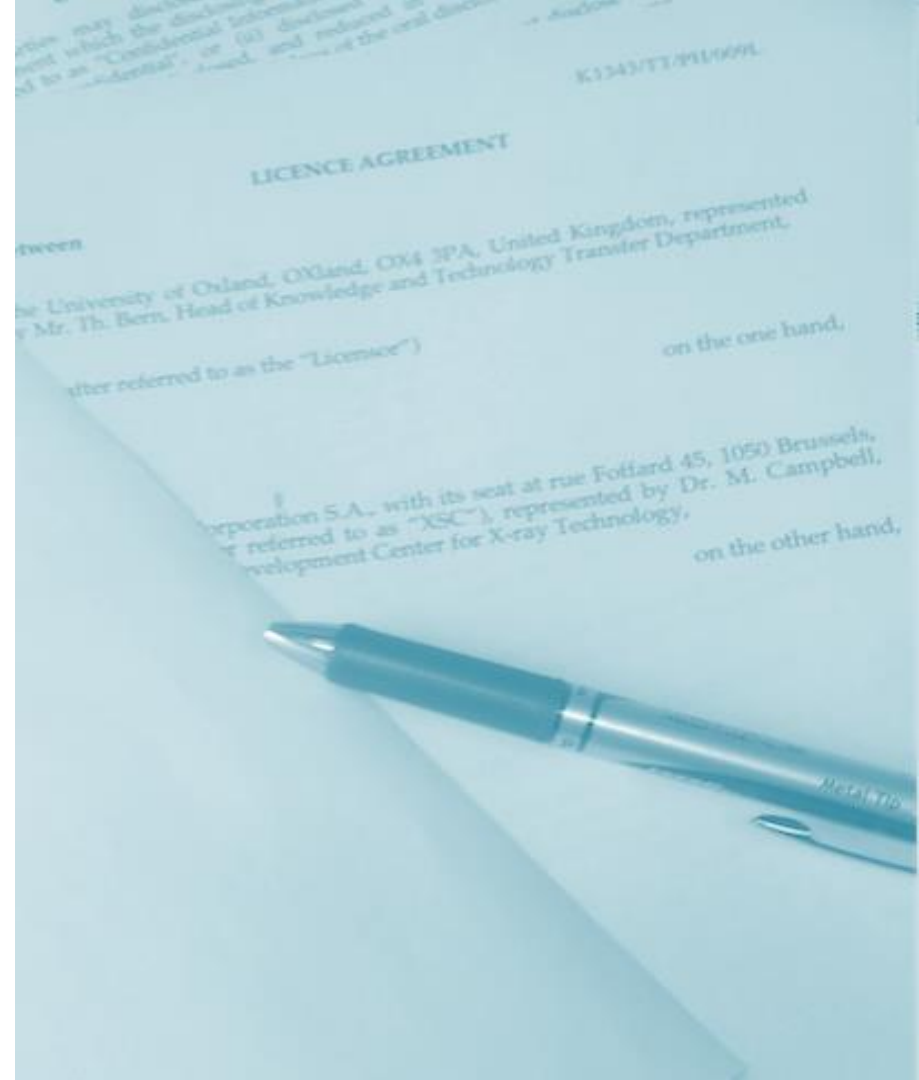
Terms and conditions:

- What rights are we granting?

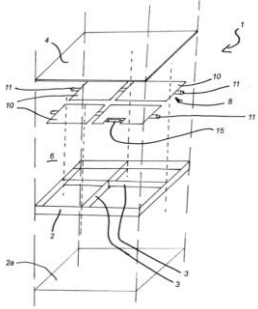
Scope, Field, Territory, Exclusivity,

- What and how will the licensee pay?

Payment models



What is the subject matter of the license?



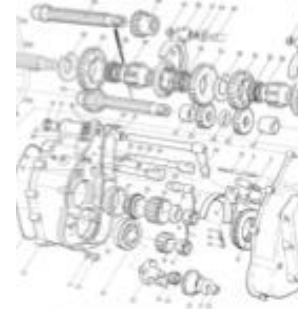
Invention?



Software?



Trademark?



Know-how?



Database?

... or a combination of these?

Do we own the technology?

What rights are granted on the IP/technology?

Article 1

GRANT OF RIGHTS

1.1 *Subject to the provisions of this Agreement, University hereby grants the Licensee an exclusive license to the IP, with the right to sublicense, to carry out research and development, to manufacture, use and sell Product only in the Field in the Territory*

USE: what can be done with the IP / technology

Research and development with
and on the IP/technology

=> R&D license

Manufacture product incorporating
the IP/technology

Internal use

Have it manufactured

Commercialisation (sell products,
services, leasing, ...)

Article 1

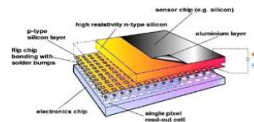
GRANT OF RIGHTS

1.1 *Subject to the provisions of this Agreement, University hereby grants the Licensee an exclusive license to the IP, with the right to sublicense, to carry out research and development, to manufacture, use and sell Product only in the Field in the Territory*

FIELD: in what application domain(s) can the IP / technology be used?

Some technology may be used in different application domains

Photon counting detector



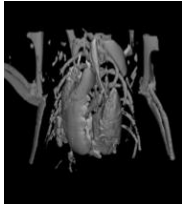
(courtesy of Medipix Collaboration)

Material analysis



(courtesy of PanAnalytical)

Medical imaging



(courtesy of MARS Bioimaging Ltd)

Space dosimetry



(courtesy of NASA ISS)

Article 1

GRANT OF RIGHTS

1.1 *Subject to the provisions of this Agreement, University hereby grants the Licensee an exclusive license to the IP, with the right to sublicense, to carry out research and development, to manufacture, use and sell Product only in the Field in the Territory*

TERRITORY: where can the IP / technology be used?

Europe and USA?

Europe?

Germany?

The world?



Article 1

GRANT OF RIGHTS

1.1 *Subject to the provisions of this Agreement, University hereby grants the Licensee an exclusive license to the IP, with the right to sublicense, to carry out research and development, to manufacture, use and sell Product only in the Field in the Territory*

Exclusivity

No licenses

Just the IP owner



Exclusive

Just one licensee



Sole

One licensee and the IP owner



Non-exclusive

More than one licensee, and the IP owner



Article 1

GRANT OF RIGHTS

1.1 *Subject to the provisions of this Agreement, University hereby grants the Licensee an exclusive license to the IP, with the right to sublicense, to carry out research and development, to manufacture, use and sell Product only in the Field in the Territory*

Exclusivity

Different territories

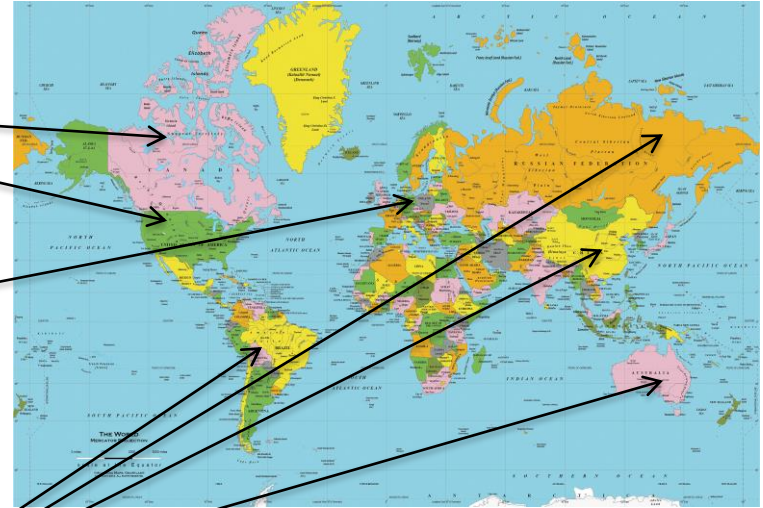
Exclusive license



Exclusive license



Non-exclusive licenses



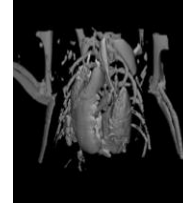
Exclusivity

Different **fields** of exclusivity

Exclusive license



Exclusive license



Non-exclusive licenses



License payment models

Lump sum

“Give me €2,000,000 and you can use this technology as much as you like”

For equity

“Give me 10% of the shares in your company and you can use this technology as much as you like”

Not at CERN

Royalties-bearing

“Give me €1 every time you sell a product using this technology”

- Fixed sum per sale
- Percentage of sale



Open source license

Software-development model that encourages open collaboration

Subject matter:

Source code (open!)

Terms and conditions:

Anyone has the right to copy, modify and redistribute the source code without paying royalties or fee

Type of license	E.g.	Redistribution conditions
Close “Proprietary software”		Depend on the terms of the license
Open non-permissive	GPL	Under the same license conditions
Open permissive	BSD	Possibility to license under different conditions

Policy on Software Dissemination:



What are the different KT partnerships?

R&D collaborations

R&D where the research goals are agreed by the partners who all contribute IP/technologies and/or resource to generate results having a potential for exploitation.

Research contracts

R&D based on CERN technology/IP mainly executed by CERN, financed by a commercial partner and the results are targeted to a specific market

Consultancy agreements

Provision of expert advice or specific studies to a third party. There is normally no generation of new IP.

Service agreement

Provision of services by CERN with specific equipment or infrastructure and related know-how. There is normally no generation of new IP.



KT PARTNERSHIPS

MAIN ELEMENTS OF THE AGREEMENTS

Scope

The work to be done and the expected deliverables:
R&D project, service or consultancy

Management and monitoring

Collaboration board,
implementation committee, ...

Resources of the parties

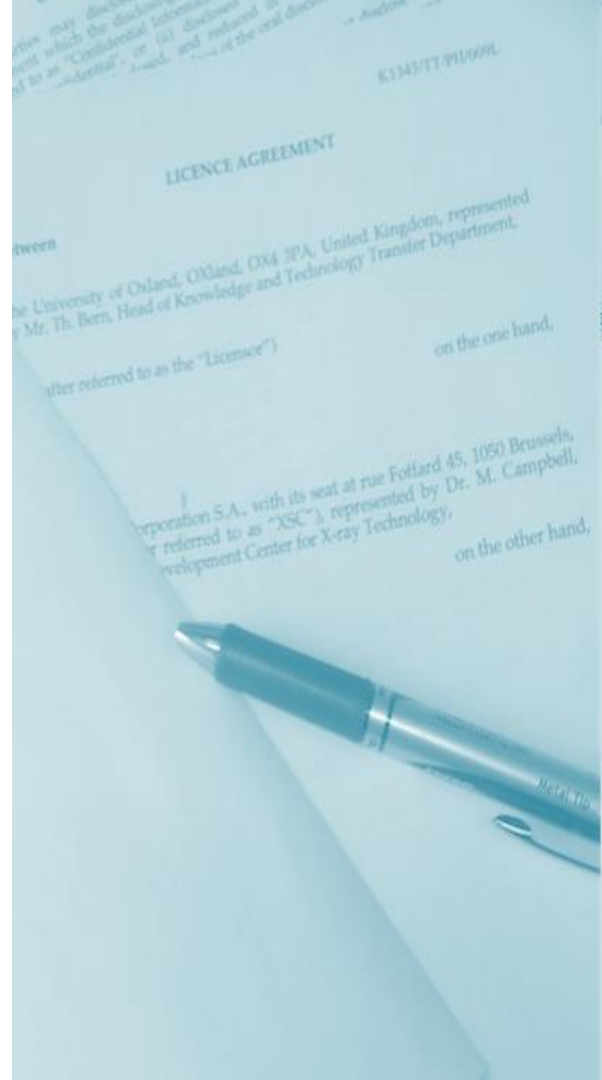
Equipment, infrastructure (availability), consumable, ...

Payment conditions

Who paid what?

Intellectual Property

Publication



Payment conditions

Contract research and services contract

Direct costs and expenses + overhead

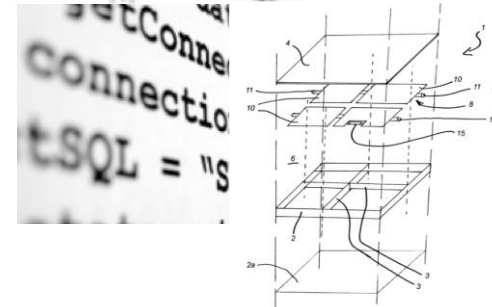
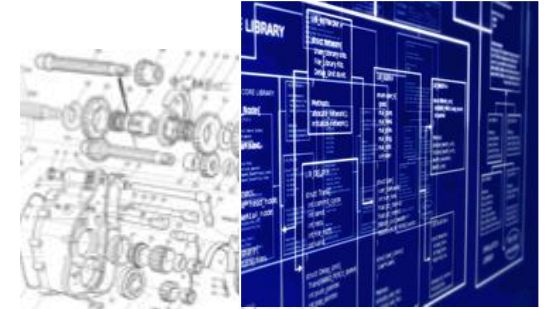
Consultancy

Standard daily rates

Collaborative R&D

On a case by case basis

Financial contribution will have an impact on the ownership and/or the revenue redistribution



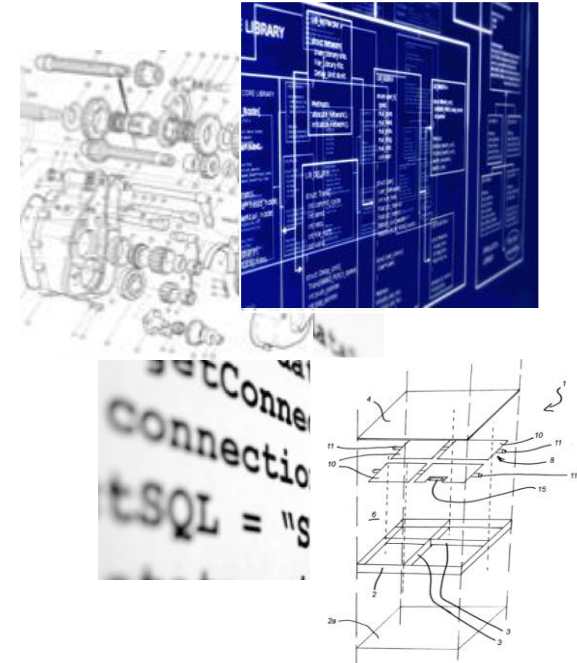
Intellectual property in KT partnership

Results or foreground IP

Results, information and IP generated during the execution of collaborative R&D or contract research.

Pre-existing technology or **background IP**

IP rights held by the partners at the outset of the collaborative R&D or contract research and necessary for its execution or to use the results.



Intellectual property in KT partnership

Identification and ownership

Identification of background IP

Applicable limitations to background IP

Ownership of the results

Protection

Obligation to protect

Role and responsibilities for prosecution and payment of the associated costs

Access rights

Access to results

Access to background to use results

Access for CERN scientific program (always!)

Sharing and distributions of revenues from commercial exploitation

Policy on the management of IP in KT activities:

<small>CERN/TC/5414/EA Original: English 5 March 2010</small>		
ORGANISATION EUROPÉENNE POUR LA RECHERCHE NUCLEAIRE CERN EUROPEAN ORGANIZATION FOR NUCLEAR RESEARCH		
<small>Action to be taken</small>		<small>Voting Procedure</small>
<small>For Information</small>	<small>FINANCE COMMITTEE 135th Meeting 17 March 2010</small>	<small>.</small>
POLICY ON THE MANAGEMENT OF INTELLECTUAL PROPERTY IN TECHNOLOGY TRANSFER ACTIVITIES AT CERN		

Concluding remark

