

The European IPR Helpdesk

Bulletin

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In the current economic environment, proper management of financial resources certainly proves to be crucial, in particular for small businesses and research organisations that do not have huge financial capabilities. A central thread of this European IPR Helpdesk Bulletin is related to the efficient management of intellectual property (IP) as a tool for commercial gains.

Through a brief description of "IP Response", an interesting tool put at the disposal of organisations by the Danish patent and trade

marks office (DKPTO), you will know how to test the strategy you have chosen for your organisation to have a first impression on whether your intangibles are correctly managed or some improvement is needed.

Two aspects at the heart of an IP strategy are the commercialisation and enforcement of IP rights acquired. You will be given suggestions and recommendations by two articles. One will introduce to you the most common commercialisations tools to help you identify the most suitable to your intangible asset and most appropriate to your organisation's business strategy. Another article will give you indications and recommendations on how to lodge a customs action –at both national and European level – to enforce your IP rights. A checklist of the necessary information to be provided to customs authorities is provided together with an informative box on the "EU Observatory on Infringements of Intellectual Property Rights".

An article specifically on trade marks will tell

you that a company investing in building its own distinctive trade mark has better chances to survive in the market than others, since a well-established brand places the product in a better position in the market. A good brand incontestably brings an added value to the company, but the success of the trade mark requires a solid and well prepared strategy.

Another article about cooperation between academia and business shows how a University Technology Transfer Division can facilitate the process of connecting industry with research institutes (and *vice versa*) and to actively support the cooperation as a whole.

The usual quiz, with the solution of the previous one, and information about the new Ambassador scheme with other events of interests will close this ninth issue of our quarterly publication, which we hope will be thought-provoking!

Your editorial team

IP Response – test your IP strategy

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The INNOVACCESS network has set up a ToolBox, containing a rich set of high quality IP tools and training materials, offered by intellectual property (IP) professionals to companies, especially to SMEs. The general idea behind the IP ToolBox is to collect best practices and to make intermediaries aware of them. The aim of the ToolBox is to be a platform to bring together providers of tools and other IP professionals, who are interested in these tools as end-users or as new providers.

In this edition of the IPR Helpdesk Bulletin we would like to introduce a tool created and offered free of charge by the Danish Patent and Trademark Office (DKPTO): IP Response.

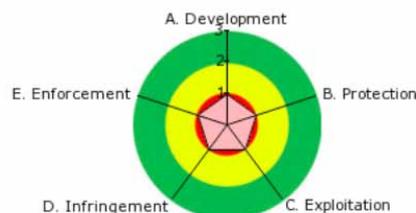
IP Response is an online management tool that allows a company to test its strategy concerning IP. This test, taking around 10-15 minutes, aims to give a company a first impression on how to manage the assets arising from its special knowledge. Based on the answers provided, the user gets a report with an overview of the company's IP strategy level and with tips on

how the company can move on from its current level.

Having a closer look on the report, the user will see a scale that rates the IP performance of the company on a scale from 20 to 60:



This rating will be followed by a general conclusion summarizing the company's IP practices and providing some recommendations on how to improve them. The report provides results of the analysis of each of the four topics studied, and displays them on four separate graphs, with a detailed explanation of the listed indicators:



At the end of the analyses, not just the IP strategy of the company will be measured, but also the management procedures and the main organisational characteristics (responsibilities, capacity building etc.). The final analysis goes through four main topics:

- IP in the overall business strategy of the company
- IP in the practical operation of the company
- In-house responsibilities and competencies regarding IP
- Product/service development and IP

This rapid questionnaire will help any company to get practical advice on the way of handling knowledge and of the assets that knowledge creates. The report provided can be used as inspiration for future work on IP. Perfect for the first steps towards making the best of IP!

The IP Response questionnaire is available [here](#).

REMARK

As a member of the Innovaccess Network of National IP Offices, DKPTO has put the IP Response tool at the disposal of interested IP intermediaries which would like to make it available on their website for the benefit of their users.

INNOVACCES – A European Network of National Intellectual Property Offices

The INNOVACCESS network currently brings together and connects national IP offices from 26 European countries. The network particularly aims to streamline IP services for SMEs. Making European SMEs recognize the importance of IP and enabling them to manage and safeguard their intellectual assets is key to ensuring innovation and competitiveness in Europe. The INNOVACCES network therefore initiates cooperation, use of synergies and sharing of best practice. It promotes the position of national IP offices as strong public IP service providers making them speak with one voice through the network. Furthermore, the network assumes a coordinating role in the sense that

it aims to serve as an interface to moderate constant exchange and communication processes among its members and with other IP support initiatives/organisations.

Vision

- Help European SMEs understand and recognize the importance of IP, to be able to manage and safeguard their IP, and thus be more competitive.
- Make National IP Offices and the network assume a coordinating role in the field of public IP services.



- Establish a sustainable and living network of National IP offices and other IP support providers in Europe.

More information:

www.innovaccess.eu

Customs for IP infringement

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1. The piracy problem in the European Union

In the last few years the phenomenon of counterfeiting and piracy has reached alarming proportions. Thus, according to a recent report, published by the European Commission (24 July 2012), in 2011 alone more than 91,000 detention cases were registered by the Customs authorities of the Member States: an increase of 15% compared to 2010 and more than 1000% over the past decade.

This geometric growth is explained by the fact that some years ago, it was a problem confined to luxury goods (especially fashion items: clothing, watches, footwear), whereas in the last decade counterfeiting has spread to countless other products, affecting even areas that seemed unimaginable a few years ago (electronics, medicines, spare parts, etc). Thereby countless small and medium-sized enterprises are affected nowadays through copies and counterfeits of their products which are introduced in markets to the detriment of the originals.

2. Customs Detention – How does it work?/How to apply it?

One of the most effective instruments that IP rights holders have at their disposal to fight piracy is customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights¹.

The great advantage of this IP rights protection mechanism is not only the possibility for it to be applied with preventive effect in order to try to avoid future infringements of IP rights, but also the fact that it is possible to use this instrument on a European level, designating Member Sta-

tes in which you would like the customs authorities to control those goods which are introduced into the EEA. Basically there are two types of action by the customs authorities:

a) **On explicit request.** When an IP rights holder considers it necessary to control the entrance of goods suspected of infringing his rights into the territory of a Member State or in all of the EU, he can ask the customs authorities to intervene when they actually find goods suspected of infringing IP rights. In these cases, the rights holder should apply for a Customs Detention Order (CDO). The request must be made in accordance with the official form² and has to contain certain information as described in the checklist on the following page.

After receiving the request, the customs authorities have a period of 30 days in which to decide whether to grant the CDO or not. If it is granted, the CDO is valid for one year with the possibility of renewal.

b) **Ex officio.** The customs authorities may also, on their own initiative and without a previous application for a CDO, detain goods which presumably violate IP rights. In those cases, the rights holder will be notified in order to allow him to submit this application within a period of three days. If not presented, the customs authorities will approve the release of the goods.

3. Types of CDOs

There are two possibilities when applying for customs action:

a) Firstly, to submit a **national application for a CDO** by the customs authorities³. This national request is based on the ownership of any national IP right – therefore, its scope is limited to the territory of the Member State in question (for example, the protection of a Spanish brand has to be sought by the Spanish Customs, since only they have the competence to intervene).

b) Secondly, to submit a **Communi-**



Danish custom authority

nity application for a CDO by the customs authorities⁴. This community request has to be based on the ownership of community IP rights (basically, community trade marks, design rights, plant variety rights, designations of origin, geographical indications or geographical designations) – therefore, its scope applies to the entire EU territory.

This Community application can be filed with any customs administration, who will then issue a pan-EU CDO, valid in all EU Member States. This CDO will then be communicated for enforcement to all EU customs administrations. The advantages are numerous: less paperwork, a uniform expiry date of the CDO, a simplified renewal procedure, etc.

4. Outcome

Once customs authorities have received the CDO application, they examine it and the contributed documents, providing, where appropriate, the CDO for a period of one year – indefinitely renewable.

From then on, they begin to control more strictly the import of goods into the territory. Thus, in cases where they suspect that certain goods may violate intellectual property rights, the customs authorities detain the goods and inform both the importer and the rights holder.

Once the holder of the rights has been informed, there are different scenarios:

¹ All these practices are regulated by Commission Regulation (EC) No. 1891/2004 of 21 October 2004, laying down provisions for the implementation of Council Regulation (EC) No 1383/2003, and by Commission Regulation (EC) 1172/2007 of 5 October 2007.

² The form is set out in Annex I to Commission Regulation (EC) No. 1891/2004.

³ This must be done in accordance with the form set out Commission Regulation (EC) No. 1891/2004.

⁴ This must be done in accordance with the form set out in Commission Regulation (EC) No. 1172/2007.



Danish custom authority

a) The IP rights holder may state, after examining the goods and within ten days of receiving the information from the customs authorities (extendable for another ten days maximum), that his rights have been violated and sends to the customs authorities evidence that he has filed the corresponding complaint with the competent judicial authority. In this case, the customs authorities become the custodian of the goods until the judges decide on the matter and determine the destination of the goods.

b) He may present, within these ten days after receiving the information from the customs authorities, a written agreement with the recipient – the person receiving the goods in question –, in which both sides recognise that the goods infringe IP rights, and the recipient abandons the goods with the intention of destroying the same. In these cases, it is not necessary to initiate a proceeding determining whether there is infringement of the rights in order for the goods to be destroyed.

c) However, it may be that he does not present within the aforementioned ten days either a proof of a legal action for infringement of his IP rights or a written agreement between the right holder and the recipient requesting destruction of the goods. In that case, the customs authorities shall release the goods.



5. Recommendations for SMEs

The rights holder should support as far as possible the customs authorities in their search of infringing products. His application however should contain simple but detailed information about his product, such as photos of the original products or information about well-known counterfeits.

Due to the high number of imports into the EU, the customs authorities rely on the information which the right holder shares. The overall suc-

cess of the customs detentions depends on the active collaboration of the rights holder.

The rights holder should not rely on the simple application for a CDO, but should also be an active part of the procedure. It is his job to study the market and to share information with the customs authorities about specific deliveries.

Without evidence it is almost impossible to find counterfeit goods. Therefore, the active participation of the rights holder is extremely important to the success of customs detentions.

CHECKLIST

Who can lodge a custom notice?

- Holder of the IPR
- Representative of the rights holder
- Anyone who is authorised to use the IPR

Crucial aspects when lodging a custom notice:

- Before filing an application, the **registration** of the IPR **must be completed** or there must be **proof of unregistered rights**
- An application can even be filed as a **preventive measure** – a reason to think the IPR is likely to be infringed is sufficient
- The **application** has to be filed with one of the designated national customs departments ([published on the European Commission website](#))
- When submitting an application, it is highly recommended to use the **forms** which are published on the website cited above, available in all official languages (in some Member States an electronic application is also possible)
- Mandatory information:**
 - accurate and detailed technical description of the goods (the more detailed the better: descriptions, photos, authorised importers, transport routes, distribution channels, packaging, etc)
 - proof that the applicant holds the rights for the goods
 - name and address of a contact person
 - declaration of liability and agreement to bear all costs incurred in keeping goods under customs control (the official form is published on the website)
 - specific information concerning the type or pattern of fraud (if present and known)
 - in the case of Community registration: indication of the Member States in which customs action is requested and the names and addresses of the rights holder in each of the Member States
- Optional information:**
 - Information is essential. The more the better! The rights holder should actively study the market and forward information in as much detail as possible that he may have: planned deliveries, changes in the market, and so on
- The holder is **obliged to inform** the customs department if there is a change to any information, if there is new information or if he is no longer the rights holder
- Extension** of the validity period:
 - Only if requested – recommendation: at the latest 30 working days before validity expires (but it is not possible to add new IPR)

For further information: [see the Manual for applications for customs action](#)



EU OBSERVATORY

EUROPEAN OBSERVATORY ON INFRINGEMENTS
OF INTELLECTUAL PROPERTY RIGHTS

The European Observatory on Infringements of Intellectual Property Rights plays an important part in supporting European creativity and innovation; its platform-based approach brings private and public sector stakeholders together in a vibrant, dynamic forum of exchange and cooperation to pool resources, identify best practices and work collectively to tackle infringements of intellectual property rights on a pan-European level.

The Observatory was transferred from the European Commission to the Office for Harmonisation in the Internal Market (OHIM), the EU's main agency dealing with IP matters, in June 2012. The Observatory works with all parties interested in intellectual property rights, including enforcement authorities across the EU.

Different groups of enforcers have different needs, and the enforcement-related training that the Observatory provides for this community reflects that. One good example

is a recent event on design awareness for Nordic customs officers – Nordic countries are synonymous with design, but as these goods often are not labelled, it makes it more difficult for customs officers to spot fakes. The design awareness training was given by OHIM's design experts, and specially tailored for these officers.

The Observatory also hosted a very successful knowledge-building conference on fake pesticides (which are thought to represent up to a quarter of all pesticides used in some EU countries), gathering enforcement and policy experts from across Europe and beyond to discuss ways of tackling the issue. But the Observatory's work with customs and enforcement officials goes beyond training. Specialised IT tools are being developed, which will support and connect enforcement professionals across the EU.

The *Enforcement Database tool* will aggregate statistics and information to help assess the extent and range of the problem and will

also help enforcement officials, such as police and customs officers, to better focus their resources.

The *Information Exchange System* contains a database of products and product information from across the EU and will facilitate the easy and rapid exchange of data between enforcement authorities, customs and rights holders. Synergies will also be built with DG TAXUD's (The European Commission's Taxation and Customs Union Directorate-General) customs information tool, COPIS, which is due to be introduced soon.

Finally, the *Information Centre on IP Infringement* will be a one-stop repository and library of information and tools that will help European enforcement officials to understand and investigate issues related to anti-counterfeiting and piracy.

The tools are due to be launched in the second part of 2013.

The role of trade marks in cross-border trade

Ewa Grabiak

European Communities Trade Mark Association

In the context of the current economic crisis, companies have realised the importance of intellectual property rights. A company investing in development, protection of creations, or building its own trade mark has better chances to survive in the market than others. A well-established brand not only provides numerous advantages but also places the product in a better position in the market. Nowadays, a good brand incontestably brings an added value to the company. It is a valuable asset. For the consumers it is a guarantee of the quality. But the success of the trade mark requires a solid and well prepared strategy.

The misleading perception that trade marks are only reserved for big companies has prevailed

over recent years. Fortunately the situation starts to change and trade marks created by SMEs (Small and Medium Enterprises) become more successful in the market. However, it is extremely important to remember a few things before creating a trade mark.

Each company is different and works in a different way. Therefore, the protection they seek for their trade marks will also be different. Depending on the most appropriate type of trade mark, protection and registration can be granted nationally, internationally or at the European Union level. All these trade marks coexist and complement one another.

First of all, it is important to carry out an extensive analysis of the market. What are our projects? What kind of market do we want to conquer? What are our expectations regarding the trade mark? What kind of consumers do we

ECTA

European Communities Trade Mark Association

want to reach? What scope of geographic protection should we prefer; national, European or international? It is fundamental to have a global vision of the trade mark before its entry into the market.

One of the above-mentioned questions deserves more attention. It is extremely important to determine whether the scope of protection should be national, European or international. If the enterprise wishes to focus its activities exclusively on the domestic market, a national trade mark seems to be the most appropriate one. If the expectations regarding the sales and thus the trade mark go beyond the borders, European or international registration should be preferred. This is particularly relevant in

case of SMEs planning to establish their activities in another European country. This decision is fundamental, as it involves the company's input and resources necessary to create and develop the trade mark.

The next step is to check whether somebody else had already the same or similar idea before, especially if the company plans to extend its activities and promote the trade mark in other countries. Very often things become complicated, because of the incomplete search made by the SME beforehand. It is imperative to insist on the importance of a complete search, as it will decrease the risk of further complications and potential legal disputes.

Yet the solution is easily available for SMEs. The Office for Harmonization in the Internal Market (OHIM) has developed useful tools, which allow making an extensive search in the framework of the European Trade mark and Designs Network (TMDN). This initiative brings together OHIM and national offices. The Network is a combined series of systems and practices designed to support users in obtaining the best possible service from the national, regional and EU bodies that are responsible for trade mark and design protection. In the framework of this common initiative, different tools are offered, namely:

- **TMview:** an online consultation tool allowing any Internet user to search for the trade marks of all trade mark offices involved in the initiative. The major advantage of the tool is that it covers data from all the participating official trade mark offices. It is also free of charge. The information is provided in all of the languages used in the different participating offices. The information is provided by the trade mark offices that own the content and are responsible for its daily update. Therefore, TMview is in constant evolution. In other words it is the platform for data from all 27 EU Member States in addition to the information available from OHIM and WIPO. TMview is an excellent tool to check the availability of a trade mark name and to discover what is already protected by the competitors.
- **TMclass:** This is an online search tool, which allows translating or classifying goods and services at the stage of the trade mark application. The description of the goods and/or services for which the protection is required must always be provided. TMclass is a central point from



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which it is possible to access the terms that appear in the classification databases of each of the offices participating in the initiative.

- **Search Image:** This is a service that aims to improve the current results of the figurative trade mark searches, with a possible extension to designs in the future. In the IP world similarity between trade marks is better known under the concept of "likelihood of confusion" and the "same overall impression" for designs. It is determined by combining several results, verbal ranking and using "word" elements; the conceptual ranking: using classifications; and the technical ranking: using image recognition technologies. The main beneficiaries of the tool will be the users of TMview, who will have the possibility to search for similar images in a simpler and more efficient way.

As mentioned above, some companies may have international or global business needs from the very start. In this case, the best solution is international registration. The World Intellectual Property Organization (WIPO) also provides assistance for trade mark search, namely:

- **Madrid Goods & Services Manager (Madrid G&S Manager):** This tool assists trade mark applicants and their representatives in compiling the lists of goods and services that they need to submit when filing international applications under the Madrid System for the International Registration of Marks ("the Madrid system"). It gives access to standard terms accepted by WIPO under the Madrid system procedures. It enables applicants to browse and search for relevant terms which may be translated into any of the three working languages of the Madrid system.

- **Madrid Real-time Status (MRS):** This tool provides the status in real time of trade mark documents being processed by WIPO.
- **Madrid Electronic Alert (MEA):** A free "watch service" designed to inform anyone interested in monitoring the status of certain international trade mark registrations.
- **Madrid Portfolio Manager (MPM):** A Web service that grants to holders of international registrations and their representatives the access to their international trade mark portfolios.

This is especially helpful when submitting new requests for recordal in the WIPO International Trade Mark Registry.

Trade marks are a perfect tool for SMEs wishing to expand their activities in and other country of the European Union. An extensive search will help to choose a strong and distinctive trade mark and therefore will decrease the chances of future legal disputes. The tools mentioned above will help you to choose an optimal protection for your future trade mark, adapted to your needs. However, it is always highly recommended to have the professional opinion of a legal expert, who will help you to evaluate the possible risk of confusion and therefore avoid further complications.

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Intellectual Property commercialisation highlights

Roberto d'Erme

European IPR Helpdesk

When it comes to transfer technology from research organisations (ROs) to the business sector or to manage the intangible assets in small and medium-sized enterprises (SMEs), the intellectual property (IP) commercialisation practice is a key factor. Indeed, it is by commercialising their intellectual capital that organisations are able to reap the economic benefits from their knowledge and make it a bit more physical¹.

Commercialisation is therefore the process of bringing the IP to the market in order for it to be exploited in return of business profits and growth. The financial success of any IP commercialisation will certainly depend on the choice of the most appropriate commercial tool. Intellectual property may be commercialised by an in-house exploitation, by a permanent assignment or by entering into different types of business partnerships, such as licensing, franchising, joint venture or spin-off company.

The choice of one of these practices should however be appropriate to the form of the IP created, be consistent with the organisation's business goals and be appropriate to the

economic resources and technical competencies that the organisation has to enter the potential market. In fact, not all IP is created to be commercialised or ready for exploitation immediately after its conception. Likewise, not all organisations have the necessary financial and technical capabilities to bring their intangibles to the market by themselves, simply because they do not have sufficient human or economic resources or because a prospective contractor is better placed to commercialise their product in a given market.

Ownership of IP

To start with, the assessment of the issues related to the ownership of the IP asset to be commercialised should be made to avoid any future dispute. It is important to establish whether the organisation owns the IP concerned or there is any joint owner; whether the organisation holds the full rights to commercialise the intangible or there is any contractual restriction to that.

IP evaluation

The importance of the evaluation of the IP asset should be also taken into account. An

assessment of the validity, strength, protection and remaining life of the IP is very much needed before starting an exploitation activity. In the same way, after the conception of an invention it is important to consider whether the IP still needs further development or it is ready to be commercialised.

It should be borne in mind that where it is decided to commercially exploit an IP asset that is still in the development phase, the business effort can be greater, given the greater uncertainty surrounding its commercial success and the consequent economic return.

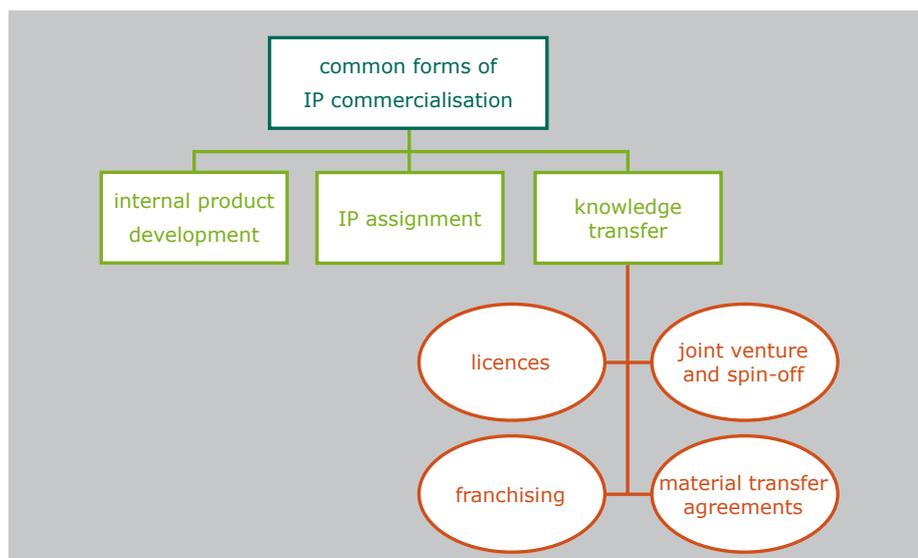
Market analysis

The likelihood of commercial success also passes through an analysis of the potential market where the new product or service is intended to be commercialised. This would entail an evaluation of the customer demand, the competing or similar products or services already in the market, an examination of the actual competitors' business strategy and of the potential business partners – e.g. licensees or buyers. The result of this analysis, together with the other issues considered above, should be embodied within a business plan.

IP enforcement

Once a new product is successfully marketed, it is more than likely that the IP embedded will be infringed by competitors. Organisations should therefore be ready to defend their IP by any means placed at their disposal by the juridical system – i.e. letter of demand, custom notice, alternative dispute resolution mechanisms and court actions. To this end, the allocation of economic resources – which can also be done by purchasing IP insurance – to pursue infringers should be envisaged. The enforcement of IP rights is, in fact, essential to avoid losing the investment made to create and commercialise the intangible and as a deterrent to any prospective infringer.

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¹ It is nevertheless crucial that the IP assets be duly protected before any commercialisation activity.



Forms of IP commercialisation at glance ²

After having protected and made an assessment of the value of the IP asset, commercialisation is the next step for the intangible to be exploited for profit. In fact, commercialisation can be considered as the last phase in the IP life cycle.

There exist several practices to get a protected IP into the marketplace. The most used are:

- **Internal Product Development:** this is one of the most common ways to commercialise IP assets by those organisation having the competencies and resources to manufacture and supply goods or services. It is worth noting that an optimal management of the IP concerned is needed here if the organisation wishes to leverage its business growth with its own development of the knowledge produced.
- **Licence:** another effective commercialisation tool is the grant of licences. This often happens when organisations lack financial or technical capabilities to directly exploit their IP. Through a licence agreement they – the licensor – allow a third party – the licensee – to access and use their IP for a certain time period in return for financial compensation, either in the form of royalties on products sales or payment of a lump sum. The terms of licence agreements may vary widely, but they commonly provide for the exclusivity or non-exclusivity of the licensed technology, namely the right for the licensee to use the IP solely or in conjunction with the licensor. A licence can also be restricted to a particular purpose, such as research,

development, selling or manufacturing purposes.

- **Assignment:** this is meant to be an ordinary sale and occurs when an assignor permanently transfers the ownership of its IP asset to an assignee, who will acquire the full rights to dispose of the intangible asset in question, unless the assignor asks to be licensed back. It is usually done through *ad hoc* assignment contracts but it is possible to include assignment clauses within partnership and employment agreements. As with licences, assignment of IP is done in return for a payment of a lump sum, royalties, or a combination of both³.
- **Spin-off Company:** spin-offs, also known as “spin-outs”, are separate legal entities created by a parent organisation (PO) to exploit its IP assets. Once the company is established, the PO will assign or license the IP concerned to the spin-off to commercialise it. Spin-off is considered as a common commercialisation practice in Universities and Research Organisations in order for them to exploit and maximise the economic benefits of the knowledge created.
- **Joint Venture:** this can generally be described as a form of business association between two or more independent organisations (joint venturers) to undertake a common project or to achieve a certain goal. More specifically, the parties to the joint venture share risks and contribute with their intellectual capital towards technology research and development, production, marketing and commercialisation. Because the role that IP plays in

conducting such collaboration is a central one, it is fundamental that joint venturers clearly define at the outset the ownership of the IP to be created by the joint venture and the other parties’ rights to it.

Risks management

Risks should also be taken into account in any IP commercialisation. Although the very nature of risks will depend on the type of commercialisation and its arrangement, their preventive identification, assessment and management would give organisations a lower exposure to risks. The IP risks specific to commercialisation activities are those related to the nature of the IP, confidentiality, nature of the product/service, financial matters, legal issues and business reputation.

An assessment of the risks can be based on the likelihood of the event occurrence (e.g. ownership disputes, third party infringement, etc.) and the associated consequences (e.g. irrelevant, moderate or important). Built on those outcomes, organisations will be able to make adequate decisions about the risk management actions to be adopted (e.g. take out an appropriate insurance, revise relevant clauses within contracts, etc.).

Prior to commercialising their IP, any organisation should therefore consider all these issues and refer to their IP and overall business strategy as IP management and business planning are of great importance in this phase. In addition, seeking advice from IP professionals is strongly recommended before taking further steps in the commercialisation process.

² The European IPR Helpdesk is producing a series of fact sheet under the heading “Commercialising IP” whereby the most common commercialisation tool will be examined. The first fact sheet issued is on “Joint ventures” and next two to come are on “Licences” and “Spin-offs”. To have a better understanding of all of these practices, you can access the fact sheets in the European IPR Helpdesk [library](#).

³ Note that the choice of the payment of a lump sum or royalties, both in licence and assignment transactions, may affect the way taxes are to be paid. It is suggested therefore to seek the advice of tax specialists.

Case Study

University – SME Cooperation: RWTH IP leads to new radar reflector for life boats

Linda Klee and Stephan Dahm

RWTH Aachen University, Technology Transfer Division

The European Union (EU) adopts standards to ensure the safety and quality of maritime equipment carried on board ships.

In 2010 the ISO 8729 standard was amended

the patent process by preserving the novelty of the intellectual property involved. Moreover, with sketches from the IHF, a prototype of this new radar reflector was built.

Afterwards, new tests were successfully conducted by the IHF, concluding that the newly developed solution meets the amended MED. In consequence, the RWTH Aachen University and Peters+Bey GmbH negotiated a licence

model registered, enabling the company to present the new radar reflector at trade fairs and on the internet.

The importance of professional knowledge transfer services in a public research organisation

The IHF was supported by the Technology Transfer Division of the RWTH Aachen University during this project, ensuring professional management of the intellectual property matters and a successful transfer of knowledge between the University and the small company. The Patent Scouts supported them during the whole process of managing the invention (disclosure) and patent application as well as the utility model registration.

Let's hear a bit more about this case study from Linda Klee and Stephan Dahm of the Intellectual Property advisors' team at the Technology Transfer Division.

EUROPEAN IPR HELPDESK: In this case the University was approached by an SME, who needed assistance with a concrete problem. How does the University ensure a close cooperation with industry and in particular with SMEs?

The Technology Transfer Division of the RWTH Aachen University is active in two main areas – IP Management and Industry Cooperation. Both areas are closely interlinked with each other.

Our Industry Cooperation Unit helps to integrate industry partners early in the development process of an IP valorisation strategy and coordinates the follow-up for further cooperation projects. Another key task is to act as a navigation aid for companies on the lookout for potential cooperation partners among the diverse research areas of the RWTH Aachen University. We aim to facilitate the process of connecting industry with research institutes (and vice versa) and to actively support the cooperation as a whole. This ranges from planning and coordinating collaborative actions, such as site visits and technical discussions with our researchers,



Figure 1: General ship equipment

ded to ISO 8729-1 and as a consequence the EU changed the Maritime Equipment Directive (MED)¹.

Peters+Bey GmbH, a ship service company from Hamburg, Germany, asked the RWTH Aachen University in 2012 to check whether their existing radar reflector was in compliance with the new requirements set by the Directive. Unfortunately, the results showed that the radar reflector did not meet the new standard. Therefore the Institute of High Frequency Technology (IHF) of the RWTH Aachen University developed a solution for a radar reflector which fulfilled the new standard by simulating several geometries.

Peters+Bey GmbH was very interested in the solution which was developed and consequently completed a confidentiality agreement with the RWTH Aachen University to positively influence

agreement allowing the company to use the new radar reflector. After the conclusion of the contract, a patent was applied for and a utility



Figure 2: Radar reflector

© Peters+Bey

¹ See 7th amendment Annex A, 2011/75/EU.

to the initiation and establishment of long-term agreements, for example framework contracts and strategic partnerships. We always try to develop customised solutions with interested companies, thereby also taking into account individual needs in relevance to company size.

EUROPEAN IPR HELPDESK: In terms of internal management of Intellectual Property, how do researchers know when to sign confidentiality agreements or to disclose an invention to your division? Does the University have an IP policy? Do you provide training to them?

In Germany the Act of Employee Inventions clearly regulates the general conditions for disclosing an invention, and these rules also apply to university researchers and professors, which again automatically leads them to us. The main task of the Patent Scouts of our division is to raise awareness of researchers in regard to the handling of intellectual property. They consult and support future inventors in

all aspects concerning university inventions. Furthermore, they organise workshops and information events about the requirements for dealing with intellectual property, such as treating results as confidential. The RWTH Aachen University has two Patent Scouts, each responsible for one half of the nine different faculties of the university.

EUROPEAN IPR HELPDESK: You mention that the University has applied for a patent as well as a utility model. Can you tell us a bit more about this? Is it a common strategy of your University?

In this specific case, the utility model was registered as the company involved wanted to present the new radar reflector at a trade fair very soon after the development concluded. This was done in order to provide some protection for the invention, before the final granting of the patent. The decision whether to apply for a patent and/or utility model is tactically made on a case-by-case basis.



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Fancy a little quiz?

As you know in every issue we include a quiz to help you develop your patent searching skills using Espacenet. The solution of the quiz will be given in the following issue. Why don't you try using Espacenet today? Here comes our new quiz:

QUIZ

Noisy airports

Aircraft noise is noise pollution produced in particular by aircraft during take off or during landing. When an airport is close to a town, much is done to reduce those noises.

At Schiphol (the Amsterdam airport) some interesting experiments have been conducted. When the surrounding fields were ploughed, some noticed that this resulted in noise reduction. Some experiments were conducted to check if digging ditches had an additional positive effect. The report in Dutch can be found [here](#).

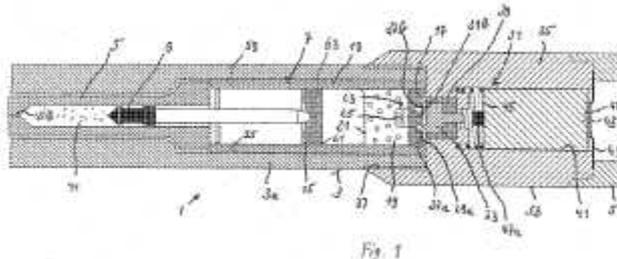
Try finding patents covering such a method to reduce noises around airports or roads by searching [Espacenet](#). This search is a rather difficult one and you may just find neighbouring inventions.



SOLUTION OF PREVIOUS QUIZ

Do you suffer from aichmophobia?

Injection via needle or syringe is the classiest way to inject medicine into one's body. But some of us are really afraid of shots. This fear is called "aichmophobia". Some scientists have found a solution to this phobia by inventing a new way to administer drugs, replacing the needle with an injector sending drug into your skin via a high-pressure stream. Try finding patents covering needleless syringe by searching [Espacenet](#).



A film depicting such an invention can be seen [here](#).

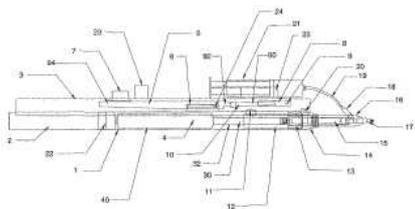
Step one: To find similar patents, identify the most pertinent aspects of the invention – common technical features that may be found in related patents – and for each aspect, define a comprehensive set of synonyms. To perform the search, this set of synonyms can be combined as keywords in the patent database.

In this case, the following concepts – groups of synonyms covering the different aspects of the invention – can be defined:

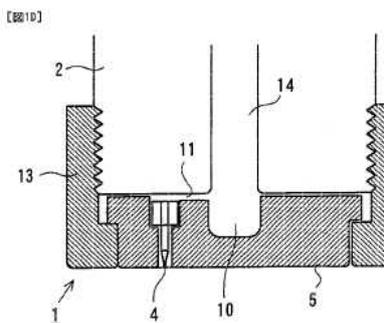
- Inject*, syring*;
- needleless*;
- pressur* ;
- skin*

The number of relevant patents being high, simple combinations quickly result in a list of relevant documents. The combination inject* pressur* skin yields for instance some [interesting results](#):

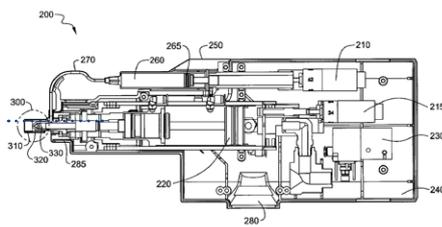
[EP2532378 \(A2\) - Needle-free injector](#)



[WO2012039454 \(A1\) - SYRINGE](#)



[US2011015567 \(A1\) - Intradermal Needles Injection Device](#)



Those results can be considered as a good indication that this field has been heavily patented. To have a more focused search, it is best to continue the search using classification symbols assigned to those relevant documents.

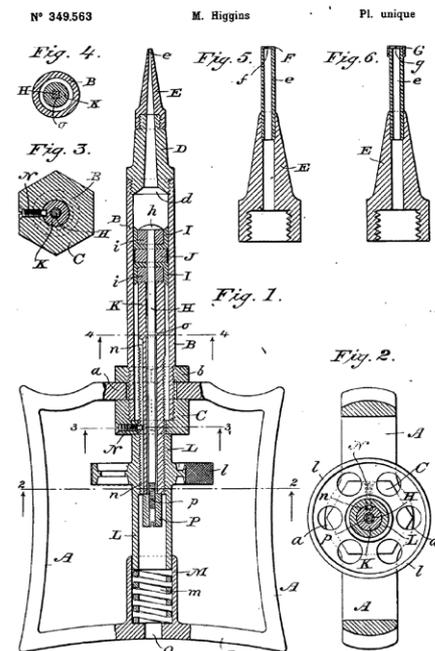
There is a classification symbol that matches the invention:

[A61M5/30](#) Syringes for injection by jet action, without needle, e.g. for use with replaceable ampoules or carpules

A search using this symbol and the ones corresponding to a finer subdivision of this domain yield [a list](#) of more than 4000 patent documents. Obviously, such syringes are not new as they answer a strong need for painless injections that has always existed.

Interestingly, there are quite old patents relating to such syringes like the one below dated 1904:

[FR349563 \(A\) - Seringue hypodermique à pression](#)



Successful kick-off: Newly appointed EU IPR Helpdesk Ambassadors meet in Brussels

Last year in December the EU IPR Helpdesk team launched the first round of open calls for Enterprise Europe Network members to become ambassadors of the Helpdesk. The idea behind this specific cooperation scheme is to further increase awareness of IP and IPR particularly among European small and medium-sized enterprises (SMEs), to build capacities and to provide basic IP services (e.g. training, advice) at a national/local level throughout Europe. For this purpose the EU IPR Helpdesk ambassadors have privileged access to training and informative material developed by the Helpdesk team.

With 26 newly appointed EU IPR Helpdesk ambassadors from 13 countries the first application round proved a big success. All of the Enterprise Europe Network members who are now part of the ambassador team have outstanding IP expertise and a strong track

record in dealing with IP-related issues faced by SMEs. In order to officially welcome the new "team members", and to kick off joint activities and collaboration the EU IPR Helpdesk organised a first meeting at the Executive Agency for Competitiveness and Innovation (EACI) in Brussels on 20 February 2013. More than half of the new ambassador team was able to attend and profit from the opportunity to get to know one another and discuss the details of the scheme, thus paving the way for a constructive cooperation in the coming months.

Following the successful start of the scheme the EU IPR Helpdesk has just closed the second application round with additional ambassadors ready to get on board soon. A final third round is scheduled to end in the second half of this year completing the Helpdesk team's search for local Enterprise Europe Network representatives in 2013.



Further details on the cooperation scheme and the current team of ambassadors can be found [here](#).

Upcoming training

Please find below an overview of our upcoming training events:

- IP training for Marie Curie Fellows and NCPs in cooperation with EPA and Open Aire: Reykjavik/Island, 23 & 24 April 2013
- IP training for Academia and SMEs at Scientific and Technological Research Council of Turkey, Ankara/Turkey, 26 April 2013
- IP workshop for Academia and SMEs – at ESSS, Lund/Sweden, 08 May 2013
- IP workshop "Biotech", Zagreb /Croatia, 14 May 2013
- Workshop on IPR and Open Access, JPI „Healthy Diet for a Healthy Life“ – Brussels/Belgium, 21 May 2013
- IP Workshop for Members of InnovaWood – Brussels/Belgium, 13-14 May 2013
- Workshop on Licensing; Prague/Czech Republic, 05 June 2013

Upcoming webinars

Join the EU IPR Helpdesk webinars in May!

Interested in learning more about licensing, including negotiation tips and legal traps? Or would you like to deepen your knowledge in Technology Transfer? Then, please feel free to register for our upcoming virtual training courses in May. You can join our webinars conveniently from your own computer, either from your office or home. Participation in the training courses is free of charge.

Detailed information on registration and learning objectives is available on our website:

6 May 2013: [Licensing](#)

27 May 2013: [Technology Transfer](#)

For further information, please have a look at our [online event calendar](#).

GET IN TOUCH

Should you have any ideas, comments or suggestions related to topics you would like us to cover in future Bulletin issues, please get in touch with us on LinkedIn: www.linkedin.com/groups/European-IPR-Helpdesk-3834260

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GLOSSARY

Counterfeiting is a practice of intentional imitation of a genuine article and selling it under a genuine article's brand name without the brand owner's authorization with the intent to take advantage of the superior value of the imitated product.

Piracy is an unauthorized copying, use, reproduction and/or distribution of materials protected by intellectual property rights for commercial purposes.

IP Infringement refers to a violation of rights resulting from a patent, copyright, database right, design, trade mark, etc.

Assignment of IPR means the permanent transfer of rights and obligations of an IPR to another individual or legal entity.

Spin-off is a separate legal entity created by a parent organization to exploit some of its IP assets.

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