

Immaterielle rettigheter

fra

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En serie webinarer,
fra grunnleggende innsikt
til IP-strategi

Del 4

26. mai 2021

14:00-15:00

**Er bedriften sikret
med gode kommersi-
aliseringsavtaler?**

Arrangør:



Norwegian Centres of Expertise
NCE Blue Legasea



Biotech North°

I samarbeid med:

BRYN AARFLOT

1947

GRUNNLEGGENDE IP 4:

ER BEDRIFTEN SIKRET MED GODE KOMMERSIALISERINGSAVTALER?

26. MAI 2021

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Norway's leading full-service IP firm

IPR | Commercialization | Dispute Resolution

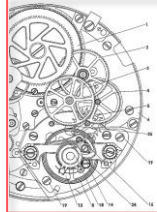
Our legal and technical services cover all aspects of trademarks, patents, designs, copyrights, domain names and unfair competition



Agenda

1. Introduction
2. Recap
3. Two functions of agreements
4. Commercialization
5. Commercial agreements
6. Negotiations
7. Take-aways

From webinar 1: IP rights



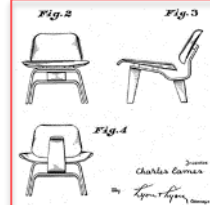
Patents

- Technical inventions
- Solutions to technical problems



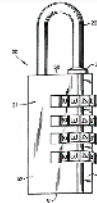
Trademarks

- Company names, product names, logos, etc.



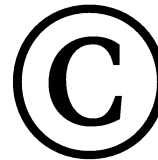
Designs

- Aesthetic, non-technical looks/shapes/forms



Trade secrets

- Information that is and should be kept secret

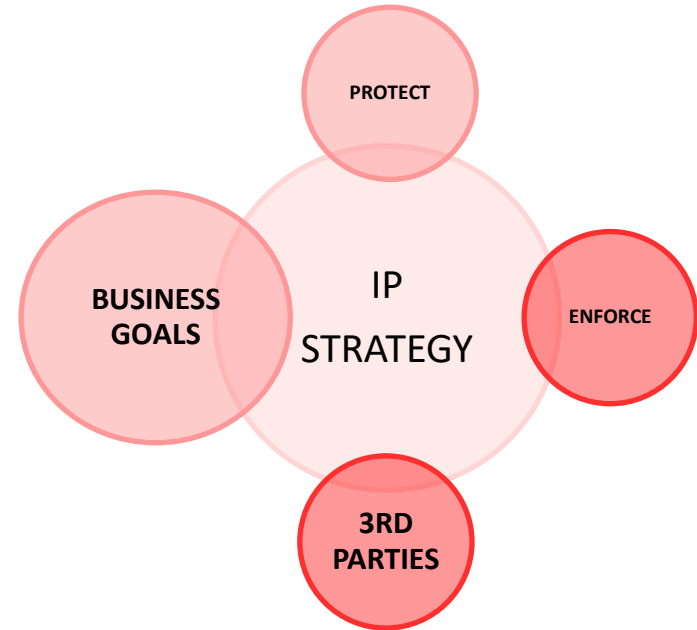


Copyright

- Original creative works

From webinar 2: From protection to commercialization

- Your IP portfolio is a tool to reach your business goals
- Develop IP and implement strategy based on business model and goals; review and update regularly; make sure to follow it
- Tailor IP portfolio to suit your needs; do not be afraid to downsize
- Approach IP holistically



From webinar 3: Freedom to Operate

- Respecting third party rights
- To ensure that commercial production, marketing and use of a product, process and use do not infringe IP rights of others
- FTO = you can make, use, sell your technology without infringing third party IP
- Having a patent \neq Freedom to operate



The two functions of commercialization agreements



**Agreements are
just tools to carry
out the IPR
strategy**

Agreements for securing rights

Non-disclosure agreements (NDA)

Material transfer agreements (MTA)

Employment contracts

Consultancy agreements

Co-operation agreements

Development agreements

Contract research agreements

Inbound license agreements

Cross licenses

Production agreements

Etc.



General considerations

- Do I *need* to own this new IP?
- Is a license sufficient?
- Right to take over ownership of IP later?
- Costs for patenting?
- Joint ownership? **STAY AWAY!**
- Willing to grant a license to others?
- Further development by partner alone?

Commercialization



Business models

- Sell products directly to end user
- Sell through retailers, distributors or agents
- Sell as a component
- License out the rights to others
- Combinations



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What can you license out

- Patents
- Trademarks
- Designs
- Copyrights
- Trade secrets
- Know-how
- Combinations

Commercialization agreements

Agreement types

- Distribution agreements
 - Agency agreements
 - Supplier agreements
 - License agreements





Exclusivity

- Total or partial
- Term
- Geographic limitations
- Product type and market segment
- Minimum Sales Requirements

Contract negotiations

Before negotiations start

Term sheet – what do you want to accomplish?

Need to have vs. Nice to have

Don't start with the full agreement



KEEP IT SIMPLE



Key terms of the agreement

- Choice of law
- Define the subject and extent of the license
- License fee/Royalty
- Further development



Key terms of the agreement (continued)

- Term and termination
- Confidentiality
- Warranties
- Indemnification and limitation of liability
- «Commercially reasonable efforts»



Pay attention to your partners

Agreements are not always respected
- Pay attention

Key take-aways

Key take-aways

- Contracts are tools to execute the IPR strategy
- Secure your rights – but do you need to own
- Find the best commercialization model
- Keep your agreements simple
- Define the granted rights properly
- Don't get caught in an exclusivity you can't terminate



Photo: Fleur Ian Schneider/Unsplash

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