



Rigorous empirical
research on
intellectual property



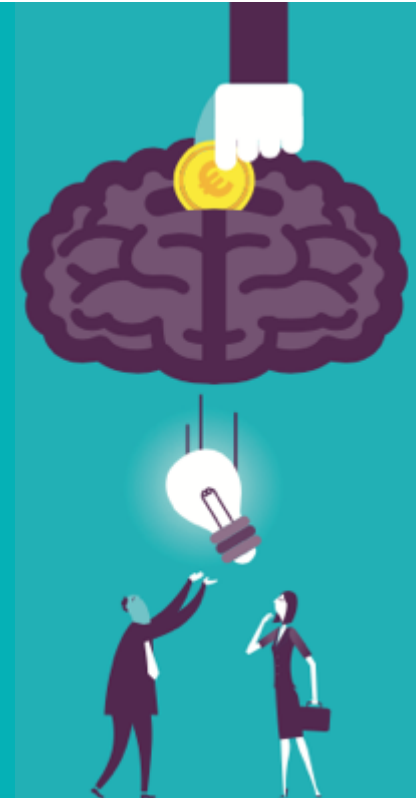
License Your Valuable Assets

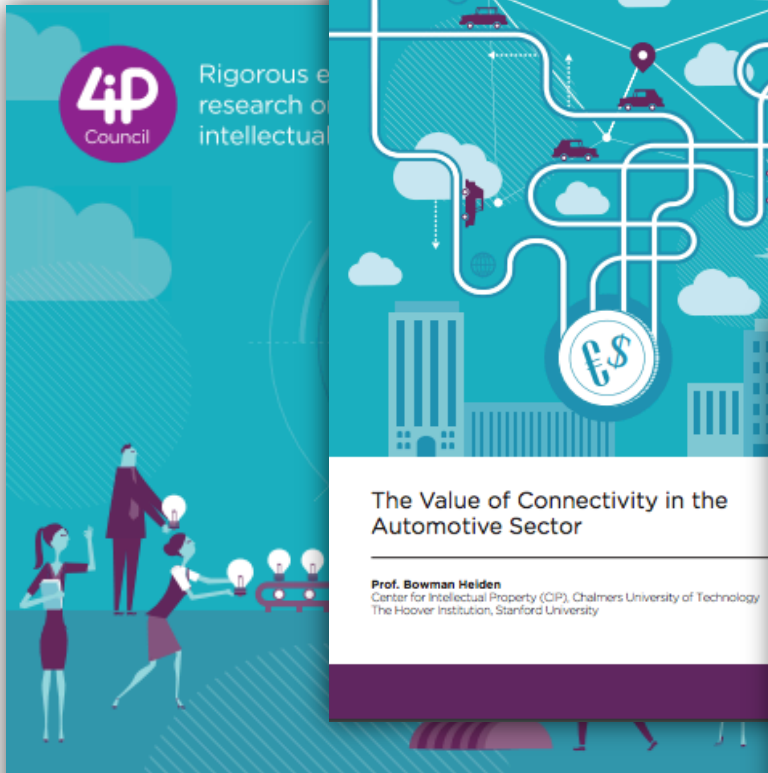
Hosts: Claudia Tapia, Chairperson, 4iP Council & Dana Colarulli, Executive Director

Presenters:

Eszter Szakács, Attorney-at-Law and Partner, Danubia Legal

Dr Anke Nestler, Managing Director and Partner, VALNES Corporate Finance GmbH





Case Law post CJEU ruling *Huawei v ZTE*

4iP Council Case law home CJEU Huawei v ZTE German court decisions Italian court decisions English court decisions English/Irish court decisions Romanian court decisions French court decisions Dutch court decisions National Courts Guidance

Authors & contributors

National Courts Guidance

Negotiating Licenses for Essential Patents in Europe

Increased clarity provided on the principles established by the Court of Justice of the European Union in *Huawei v ZTE*.

The Court of Justice of the European Union clarified, in *Huawei v ZTE* (Case No. C-170/13), European law relating to the availability of injunctive relief for infringements of FRAND-based standard essential patents. In doing so, the Court provided a legal framework focused on the good faith

FRAND licensing levels under EU law

Dr Jean-Sébastien Borghetti
Professor of Private Law at University Paris III Panthéon-Assas

Dr Igor Nikolic
Senior Fellow at University College London (UCL) Centre for Law, Economics & Society

Dr Nicolas Petit
Professor of Law at the University of Liège and at the College of Europe

Summary

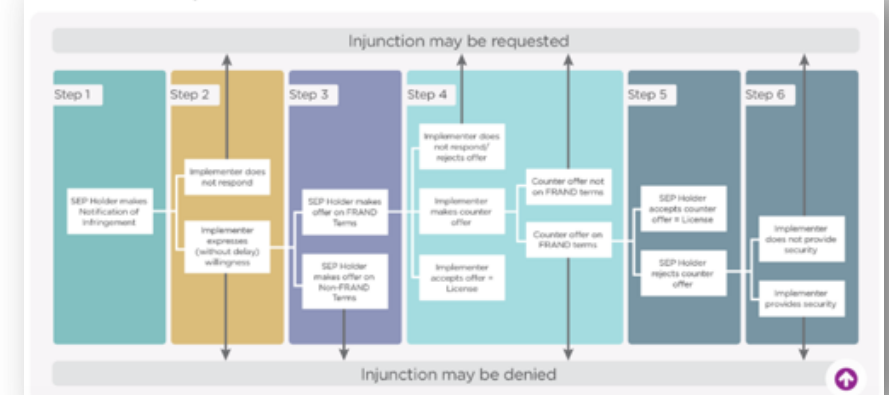
February 2020


Patents to climate rescue: how intellectual property rights are fundamental to the development of renewable energy

Arielle Aberdeen

October 2020

Huawei v ZTE process





Latest research
The Value of Standard Essential Patents and the Level of Licensing
By Bowman Heiden, Jorge Padilla, Ruud Peters

The value of (partially) invalidated patents

One has to recognize the strengths and weaknesses of IP valuations: **IT IS AN OPINION**

Hear about the value of intangible assets

Learn about IP and renewables

4IP Council The 4IP Council Research Award

Taking entries until 7 December 2020

4 REASONS TO PATENT

- 1 - MARKET ACCESS
- 2 - NEGOTIATING
- 3 - FUNDING
- 4 - STRATEGIC VALUE

Explore how patents add value with our **interactive guide**.

4 REASONS 4 COPYRIGHT

- 1 - COMPETITIVE EDGE
- 2 - REPUTATION
- 3 - COLLABORATION
- 4 - FUNDING

Explore the benefits of copyright with our **interactive guide**.

4 REASONS 4 TRADEMARKS

- 1 - DIFFERENTIATION
- 2 - PROTECTION
- 3 - REPUTATION
- 4 - REVENUE

Explore the benefits of trademarks with our **interactive guide**.

4 REASONS 4 DESIGN RIGHTS

- 1 - EXCLUSIVITY
- 2 - COMMERCIALISATION
- 3 - REPUTATION
- 4 - VALUE

Explore the benefits of design rights with our **interactive guide**.

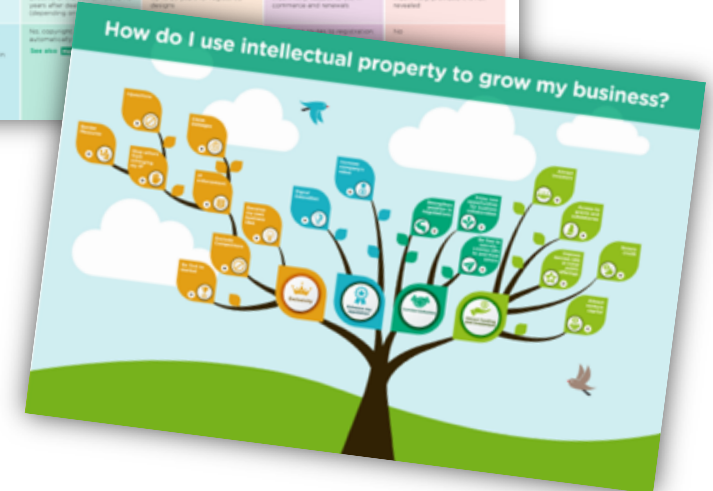
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Which types of intellectual property do you need?

Filter table columns

	PATENTS	COPYRIGHTS	DESIGNS	TRADEMARKS	TRADE SECRETS
What do they protect?	An invention a new and innovative way of doing something or solving a technical problem See also More	A work an original intellectual creation See also More	A new and original visual appearance of a product See also More	Destructive signs that identify goods or services See also More	Any type of useful information for business that is secret and kept confidential See also More
Examples of what is protected	Inventive products and processes in all types of business For examples of successful inventions for SMEs See also	Audio-visual works, software, graphics, architecture, databases, website designs, literary works, poems, plays, music and video, dramatic works See also	Figurines, containers, furnishings, graphic symbols, computer icons, logos, graphical user interfaces, logos and maps More on Designs	Words, personal names, designs, letters, numbers, colours, shapes, packaging, sounds More on TMs	Any confidential information: business methods, customer lists, R&D data, financial information, coding recipes, software, databases, know-how, algorithms More on trade secrets
How are my rights protected?	Prevents unauthorized making, using or selling of the patented invention	Prevents the work being: Central authorities (e.g. publishers, distributors) or made available online Protects the integrity and attribution of the work Related rights: Public performance and rights of the 9 years See also	Prevents unauthorized use of an identical or similar visual appearance for the same kind of products or services See also	Prevents unauthorized use of distinctive signs for the same or related products or services See also	Prevents others from using the confidential information as long as it remains secret Allows to claim monetary compensation in case of unlawful disclosure of the confidential information
How long is my innovation protected?	Up to 20 years	Lifetime of the author (plus 70 years after their death) See also	Up to 25 years for registered designs See also	Indefinitely, subject to use in commerce and renewal See also	Indefinitely, provided it is not revealed See also
Do I have to register it?	Yes, filing an application to a patent office is required More on patent applications See also	No, although automatic protection is required See also	No, although automatic protection is required See also	No, although automatic protection is required See also	No See also

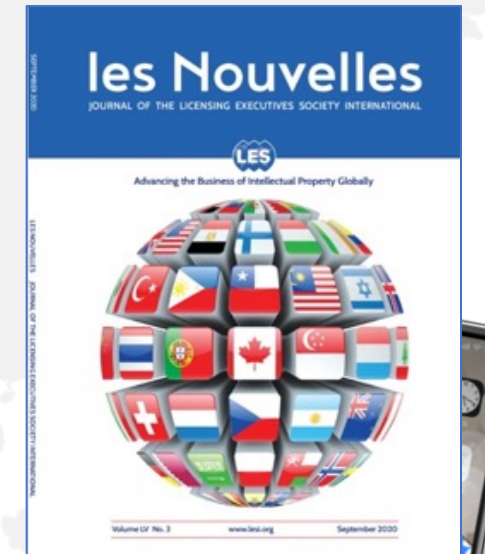


Who is LESI?

The Licensing Executives Society International (LESI) is an umbrella association of 33 national and regional Member Societies in more than 90 countries serving more than 7000 individuals.

- Provides a global platform that enables businesses, professionals, and industry players to network, learn, encourage IP transactions and understand licensing, amongst licensing professionals around the world.
- Provides leadership on key issues important to licensing professionals in companies, firms and other organizations
- Maintains an international and diverse board where women prominently serve in the leadership
- Offers a variety of meetings, conferences, webinars and certifications to inform and educate professional – both in person and now virtually too!
- **Save the Date:** Annual Meeting May 2021 – a global (virtual) conference

LESI: Advancing the Business of Intellectual Property Globally





We can cherish our business innovation and expect it to soar. But we might wish to fulfil the potential and capabilities more rapidly by allowing others to use our Intellectual Property. So how do you protect and share this with interested parties? This third LESI Briefing for Business explores how you can effectively ...

LICENSE YOUR VALUABLE ASSETS



**LESI
BUSINESS BRIEFINGS
2020**

- Today's session will focus on the third in a series of Business Briefings published by LESI in May 2020: ***License Your Valuable Assets***.
- Written specifically for SMEs, useful for all.
- For those involved in the business of IP for the first time, these briefings provide critical information that may help your enterprise to be successful.
- The three briefings are written by LES members who are experts in their subject and active in licensing in various markets throughout the world.

www.lesi.org/publications/business-briefings

LESI Business Briefing: License Your Valuable Assets

Today's presenters



Eszter Szakács,
Attorney-at-law and
partner at Danubia
Legal in Budapest

Dr Anke Nestler,
Managing Director
and Partner at
VALNES Corporate
Finance in Germany



LESI Business Briefings – Licensing Your Valuable Assets

Part A

Eszter Szakács – DANUBIA LEGAL



What are we going to discuss?

- What is a license – why do we need them?
- How do you prepare? – finding IP, finding partner, negotiations
- Types of license
- The nuts and bolts of a license agreement
- The legal stuff you need to consider
- Determining the best financial outcome
- Royalty rates



What is an IP license?

- The permission granted by the licensor to the licensee to use a specified intangible asset, under agreed conditions

What IP can be the subject of an IP License Agreement?

- Patents
- Trademarks
- Copyright
- Registered design
- ... and more

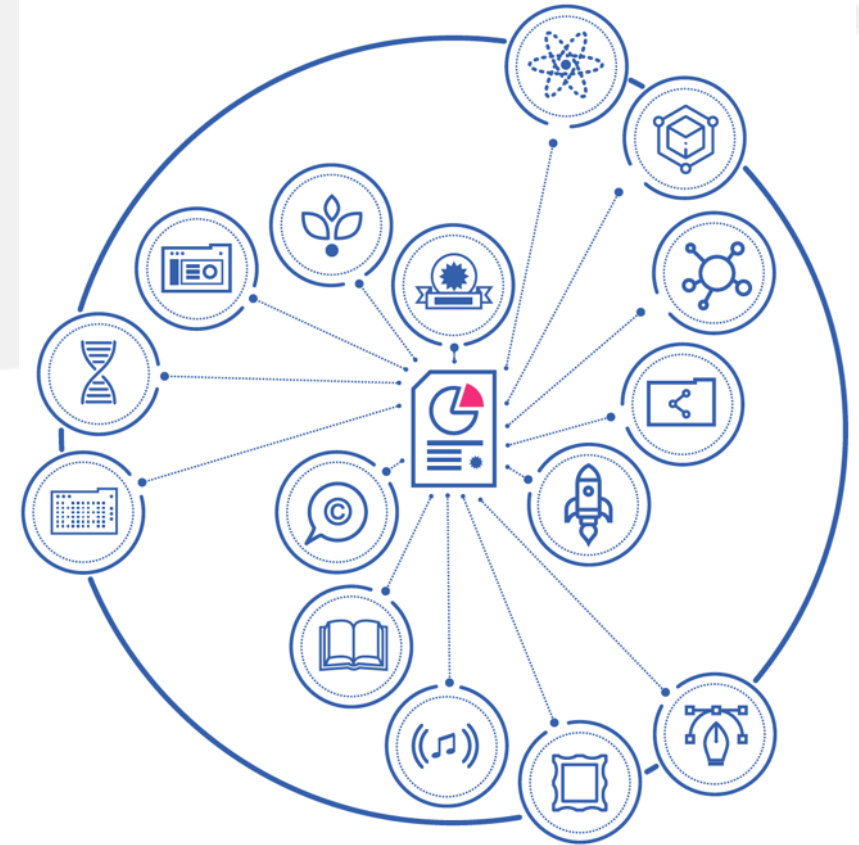
Why license? - pros and cons for the Licensor

Pros

Generates cash flow
Geographical expansion
No production investment risk

Cons

Creates competition
Monitoring difficulties
Loss of control

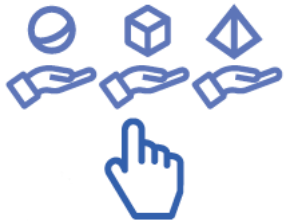


How do you prepare for an IP License Agreement?



Finding your IP

- Identify your IP
- Be sure you have the right to license



Finding a partner

- Market power and expertise
- Financial stability



Protecting confidential information

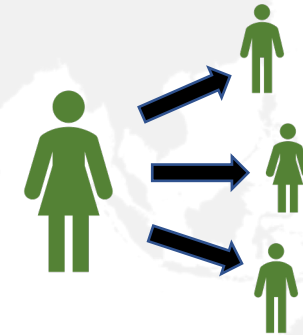
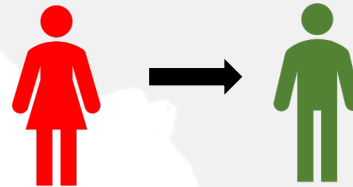
- Careful in disclosing your IP in negotiations
- NDA is crucial

Types of License



Sole License

Exclusive License



Non-exclusive License

The Nuts and Bolts of a License Agreement



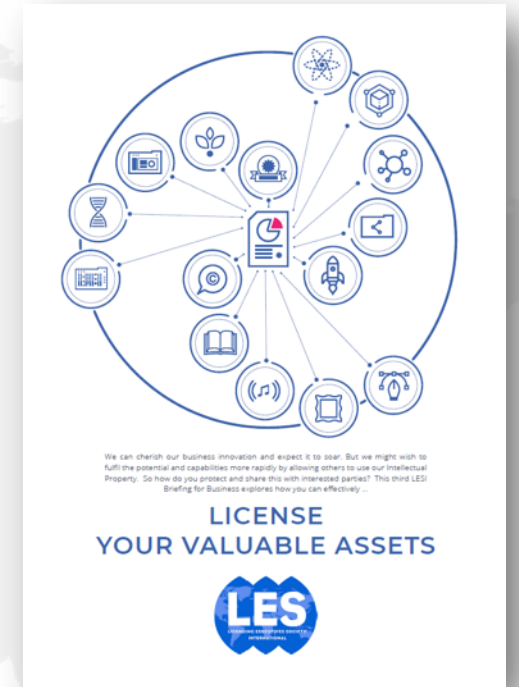
The legal stuff you need to consider



LESI Business Briefings – Licensing your Valuable Assets

Part B

Dr. Anke Nestler – VALNES Corporate Finance GmbH



Determining the Best Financial Outcome

What is a license fee?

- A consideration for granting of an IP right
- The 'rent' for a defined use of an intangible asset

What to consider when choosing the fee structure?

- The nature of the asset
- The split of risks and opportunities

Types of license fees

Fixed fee

Royalty

Fixed fees + Royalty



Royalty Rates

Why is royalty base so important?

- Informative value
- Net sales is often the preferred royalty base
- ‘Royalty-bearing portion’

Why not just use an ‘industry typical royalty’?

- Every contract is unique
- Each party should do its homework
- Royalty databases as a non-deterministic benchmark

What makes Standard Essential Patents (SEP) so special?

- Only FRAND licensing
- Regulation ‘guides’ contracting

Gross sales

- Returns and rebates
- Shipping costs

Net Sales

Contacts

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Certified Valuation Analyst (CVA)

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Thank you

Q & A



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Next webinar: **The Value of Standard Essential Patents and the Level of Licensing**

Presented by:

- **Bowman Heiden**, Co-Director, Center for Intellectual Property (CIP), Chalmers/UGOT/NTNU; Visiting Professor, UC-Berkeley.
- **Jorge Padilla**, Senior Managing Director, Compass Lexecon.
- **Ruud Peters**, CEO, Peters IP Consultancy B.V. ; Former Chief IP Officer and Executive Vice President at Koninklijke Philips N.V.

[Research paper has just been published.](#)

28th January 2020, 7am PST | 10am EST | 16.00 CET.

Registration is open. Save your seat on www.4ipcouncil.com.