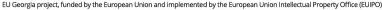






# **IPPD Objectives &** Templates

Dr Alison Orr, Inngot Ltd | Day 2, May 2022



EUG

EU Georgia Intellectual Property Project





# On this session we will cover (1)

# Insights from similar schemes (EU; UK...)

What further help is available to assess the requirements of SMEs' IPRs e.g.

- Process and Templates based on EC (EUIPO) IP Scan Service
- How to guide SMEs through IP Scan interview
- Intro to IP Scan Templates IP Scan Interview Guide; IP Scan Report Template



### On this session we will cover (2)

# IP Scan service - what does 'good' look like for Sakpatenti?

- More SMEs engaging with Sakpatenti and awareness of benefits of IP in general?
- How to better protect IPRs by way of registered IP rights or other means, such as contracts and the like (more registrations)?
- How to guide an SME through an IP Management Plan?









EU Georgia Intellectual Property Project

# Insights from previous IPPD schemes

EU GEORGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

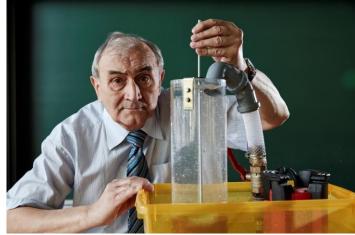




# **Objectives of the IP Scan (EC)**

- Facilitate and promote using intellectual property by innovative European SMEs
- Show the benefits of IP in the individual case of the SME
- Help develop and/or continue to implement an IP strategy (not only encourage to register IP rights)
- Ultimately: improve competitiveness

Source: Directorate General Internal Market, Industry, Entrepreneurship and SMEs, November 2020





# Aims of IPPD (Sakpatenti)

IP pre-diagnostics (IPPD) identified as means of building an SME's IP strategy enabling:

- Access IP experts to review their business models, products and/or services and growth plans and providing advice on an IP strategy.
- More SMEs engaging with IP and Sakpatenti
- SMEs becoming more aware of the benefits and value of IPR
- SMEs understanding the benefits of registered IPR and pursuing same (if appropriate)









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EJ GEØGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EJIPO)





### **Reminder - What is an IPPD?**

An introduction to IP and a broad overview of an SMEs IP and wider intangible assets, aiming to:

- Identify the company's IP and intangible assets
- Identify risks related to its IP or use of third party IP
- Introduce the company to the value and strategic aspect of IP
- <u>Provide a summary of key IP Management actions</u> identified as part of audit
- Provide follow up support/signposting to help implementation of IP management actions



### What IPPD is not?

IPPD is not:

- <u>Legal advice</u> experts should not give advice but provide information to assist the SME to make informed decisions
- <u>Commercialisation</u> advice questions in relation to its business plan and IP can assist to identify risks/opportunities
- Formal IP Searches and Analysis, drafting or filing of IP applications or legal contracts

A follow up session (Post interview/report) can help to determine whether report summary and recommendations have been understood. This may lead to signposting for further support or funding to implement IP management recommendations



# **USES OF IPPD\***



\*Not drafting applications/contracts



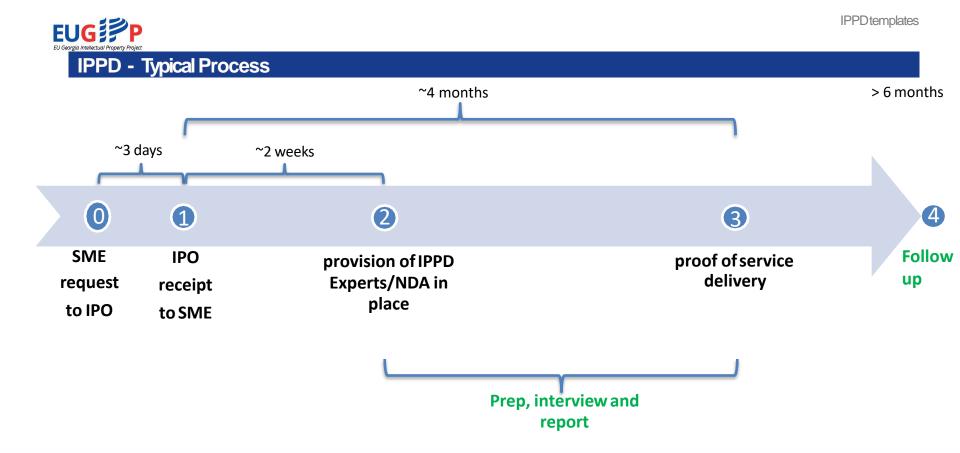




### DISCLAIMER

**Disclaimer:** the Intellectual property (IP) pre-diagnostic service provided either by external providers or the national IP offices to SMEs is partially co-financed by the European Commission (COSME Programme) and the European Union Intellectual Property Office (EUIPO) under the SME Fund initiative. It is meant to provide a practical, objective and factual analysis to help European SMEs better understand the value of intellectual property for businesses and in particular, identify the intellectual assets they hold and the possible IP protection options for those assets. **Neither the EUIPO, the European Commission, nor the IP pre-diagnostic service providers are liable for the consequences of the actions taken on the basis of the IP pre-diagnostic service recommendations. Beneficiary SMEs are solely liable for any consequences of the actions they take based on strategic recommendations proposed. Before taking specific actions in relation to IP protection or enforcement, all beneficiaries are advised to seek independent advice from a qualified IP attorney. [to be modified if needed at national level]** 

EU GEORGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO







**Templates** 





EU Georgia Intellectual Property Project

EU GEORGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO





### **One Way Non-Disclosure Agreement**



#### IP scan Non-Disclosure Agreement



#### **Non-Disclosure Agreement**

This Agreement is entered into on this [insert number of day] day of [insert Month and year] by and between:

1. [Insert official beneficiary SME name], having its registered office or based in [insert the Legal Address of the Entity], represented by [insert name and basis for representation] hereinafter referred to as the **Discloser** and

[Insert IP pre-diagnostic expert's name], based in [insert the Legal Address
of the Entity or of the expert] hereinafter referred to as the Recipient [modify as
above if you need to have a signature on behalf of the institution and not the
expert]

#### WHEREAS:

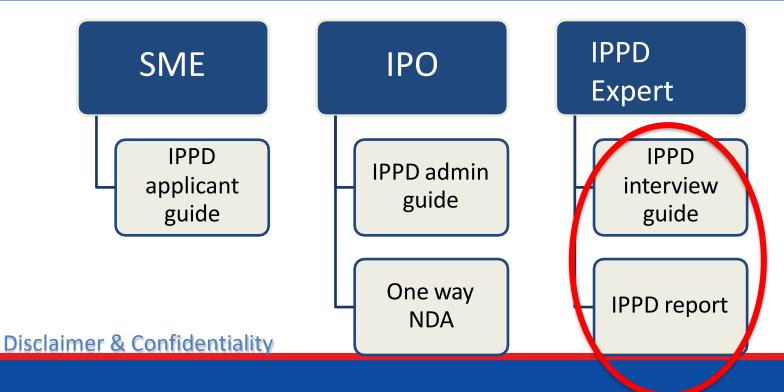
The Discloser hereto requests/qualifies to receive the intellectual property prediagnostic service and the Recipient hereto agrees to provide the intellectual property pre-diagnostic service to the Discloser.

Throughout the duration of the intellectual property pre-diagnostic service, the Discloser may share confidential information with the Recipient subject to the terms and conditions set forth below.

IT IS AGREED AS FOLLOWS:



# **5** Templates



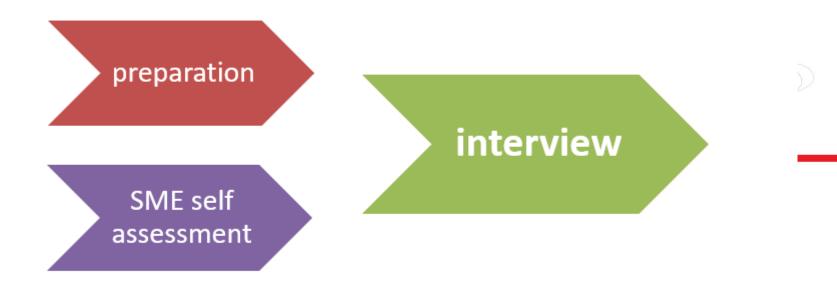
**IPPD** templates







# **IPPD INTERVIEW GUIDE**



www.eugipp.eu

**IPScantemplates** 



# IP SCAN INTERVIEW GUIDE - PREPARATION - DESK RESEARCH

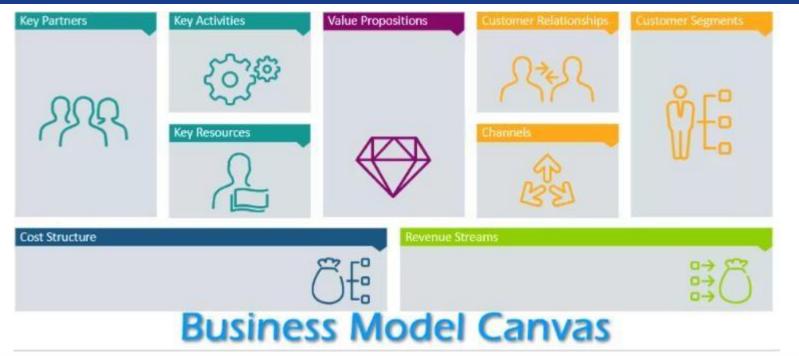
SME self assessment\* and basic economic data from the application [\*eg template or Goldseam IP Profile tool]



Corporate structure	Company website, social media	Business partners	
Competition	IPR databases	Financial situation	



# SME'S BUSINESS MODEL



https://www.osmoscloud.com/blog/business-model-canvas, https://en.wikipedia.org/wiki/Business\_Model\_Canvas





## **IPPD INTERVIEW GUIDE - INTERVIEW**

Introduce IPPD Service

Identify SME's business model

**SME** Organisation

Identify and analyse existing IPRs and other IP relevant assets

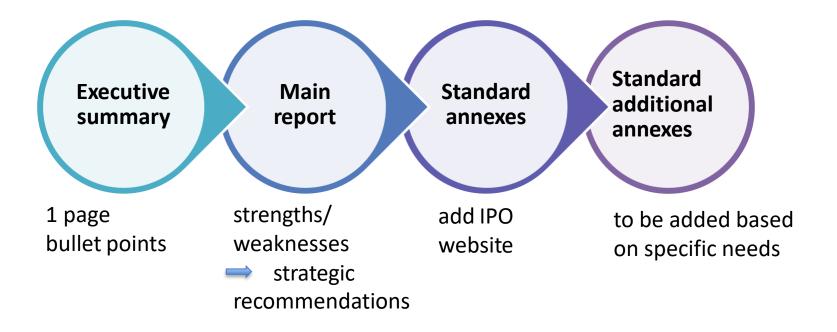
Inform about IP Searches

Discuss IP management and strategy

**IPPD** templates



# **IPPD REPORT**

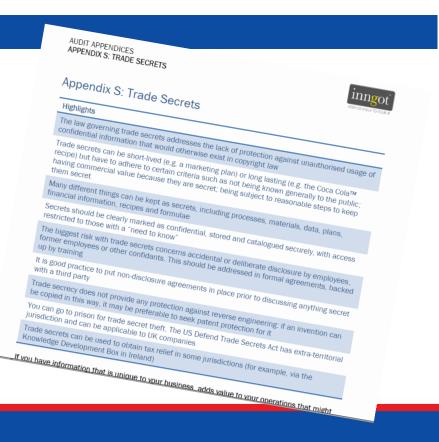




### **Report – use of standardised annexes**

Example -

As well as the main, tailored report – appendices may be useful to set out further (standard) points on individual rights – or links to further reading.





**IP SCAN MAIN REPORT** 

SME's business model and company strategy

Identification and analysis of existing IP and IP-relevant intellectual assets

Use of IP searches

**IP** management

Summary and strategic recommendations

**IPScantemplate** 



### **IP SCAN REPORT – IPO QUALITY CHECKS**

the clarity of the business
model description for
suggesting an initial IP
strategy

have the IP relevant intellectual assets been identified in a plausible manner (in comparison to the business model)?

# is there a section on IP management?

are the recommendations relevant to the business model described? do the recommendations include references to public support and private services to facilitate their implementation?

is the annex adapted to the recommendations that have been made?



# **IP SCAN CHECK - FOR IPO**

# delete what does not apply in the table below:

Identified IP and IP- relevant assets registration recommendations	IP related actions recommendations	IP risks recommendations	Business strategy recommendations
* Trade marks * Designs	* Integration of IP searches into		*IP integrated business models
* Patents	the IP management processes	*Third party IPR's (infringement of others)	*Organisational methods (internal and external)
* Utility models * Trade secrets (NDA)	* Financing methods for IP protection	*Enforcement (infringements of one's	*Internationalization strategy
* Copyright * Domain names	* IP based business (monetization): licensing, selling, franchising, cobranding	own rights) *Ownership of IPRs in contracts	* Financing strategy
* Geographical Indications	* IP Internationalization (geographical scope)	*Loss of benefits due to lack of protection	* R&D strategy *Marketing and branding strategies
* Topographies of Integrated circuits	* Consultation to IP advisers		*Market and customer
* Plant variety			access recommendations





# Other Examples (UK)



# **Objectives of the IP Audit Plus Scheme (UK)**

- To connect businesses with good quality guidance and advice along with the services that they need to make their IP work for them as they work to grow their business.
- More than putting registered rights in place; making sure that businesses can identify opportunities to use their IP to generate income/value, such as through licensing and franchising.
- Making sure that businesses are aware of the risks/limitations and understand how to manage them (not just potential infringement but also internal IP management strategies; for example, ensuring that employee contracts, amongst other things, are sound).
- Long term goal is to ensure that businesses are able to integrate IP into their wider business strategy.





#### **IP Audits Evaluation**

Report Version: Final V3.0 Prepared for: Intellectual Property Office Ref. JN1566/DD/JM Date: March 2014

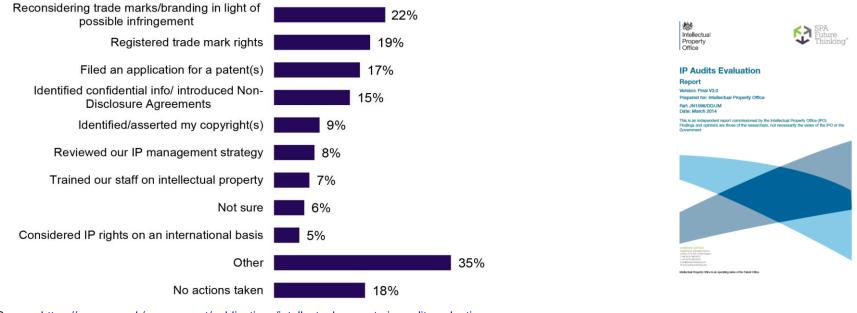
his is an independent report commissioned by the intellectual Property Office (IPO), indings and opinions are those of the researchers, not necessarily the views of the IPO or the overment



Source: https://www.gov.uk/government/publications/intellectual-property-ip-audit-evaluation



# Lessons from the IP Audit Plus Scheme (UK)



Source: https://www.gov.uk/government/publications/intellectual-property-ip-audit-evaluation



## Lessons from the IP Audit Plus Scheme (UK)

A summary of 67 IP audits found:

- 55 additional patentable inventions (on top of 21 already owned and 23 in progress)
- 115 potential new trade marks (in addition to the existing 62)
- 81 registrable designs (only 9 were previously registered) and 70% of companies had design registration potential
- Over 75% of audits found previously unrecognised non-registrable assets, including copyright material, database rights, trade secrets and software code
- Source: <u>https://www.gov.uk/government/publications/intellectual-property-ip-audit-evaluation</u>

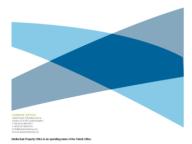




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is is an independent report commissioned by the intellectual Property Office (IPO). dings and opinions are those of the researchers, not necessarily the views of the IPO or the verment





Typical report format (full IP Audit)

# 1. The business context

Identify the core business and the key features of the business plan, in particular the features by which the business intends to differentiate over its competitors.





# IP Audits (UK) - 2. Audit of existing IPRs and IP assets

- Identify:
- a. Granted patents and pending patent applications
- b. Registered trade marks and trade mark applications
- c. Registered designs and design applications
- d. Unregistered trade mark rights, including trading names and branding
- e. Domain names
- f. Potentially patentable inventions
- g. Potentially registrable trade marks
- h. Potentially registrable designs

- i. Technical know-how
- j. Other forms of confidential information, including trade secrets & other commercial information
- k. (Unregistered) design rights
- I. Potential sources of copyright (eg databases, websites, promotional materials, product information, internal documentation)
- m. IP-relevant contracts (eg licences, franchises, joint venture agreements, material transfer agreements)
- n. Known or likely sources of other IP rights, eg database rights, semiconductor topography rights, plant variety rights, moral rights.



Identify potential IP-related threats e.g.

- a. Third party IPRs
- b. Ownership issues surrounding the IPRs identified in (2) above
- c. Infringements of those rights
- d. Trade mark non-use issues.

Consider potential financial issues relevant to the IP assets, for example financial (including tax) aspects of the ownership or licensing structure; the role of the holding company, if applicable; the country(ies) in which the assets are held; and any charges over the IPRs. Recommend responses, for example conducting searches, establishing contracts and/or obtaining further professional advice.



### IP Audits (UK) - 4. IP management

Recommend practices and procedures for improving IP management, for example:

a. Use of confidentiality (non-disclosure) agreements

b. Ownership safeguards e.g. contractual terms in agreements with contractors, consultants, licensees and other partners; job descriptions for key staff; terms for nonemployee directors; appropriate transfers of IP both within the organisation and externally

- c. Capturing and recording know-how and other confidential information
- d. Capturing and recording unregistrable IP such as design right, copyright and unregistrable or not-yet-registrable trade marks
- e. Capturing and recording evidence of use of trade marks
- f. Capturing and evaluating potentially registrable IP (patentable inventions; registrable designs and trade marks)
- g. Prioritisation of registrable and registered IPRs, in light of the business plan, and implementation of registration and exploitation tactics to match

h. Infringement clearance procedures, in particular for new projects such as the adoption of a new trade mark, the development or launch of a new product or the



### IP Audits (UK) - 4. IP management (cont/d)

i. More general awareness of relevant third party IPRs, for example using watching searches or "landscape" searches

j. Taking expert advice on IP-relevant contracts and, where appropriate, their registration

k. Taking expert advice on possible risk mitigation options including IP Insurance I. Publication clearance procedures, to avoid loss of protectable IP

m. Maintaining up to date proprietor, licensee and contact details for registered IPRs, including domain names

n. Marking – for example flagging application and registration numbers on product literature; use of the <sup>™</sup>,
® and © symbols

o. Improving staff awareness of IP issues and policies

p. Regular reviews of IP rights and strategies, in particular in light of developments in the business plan.



- Recommend key actions to align the IP strategy with the general business strategy over the short to medium term. Identify "quick wins" for safeguarding and/or exploiting the IP. Advise on suitable options for exploiting the company's IP, again to fit with the overall business plan, eg by licensing and/or enforcing and/or using the IP to attract and reassure investors and business partners.
- Flag potential options for IP-related tax savings, eg through R&D tax credits and/or Patent Box.
- Warn of potential weaknesses and threats which might impact on the value of the IP and IP strategy in the context of the short to medium term business plan. If feasible, provide indications of the likely costs of adopting the audit recommendations over the short to medium term.









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Other resources – Inngot example

EU GEORGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)



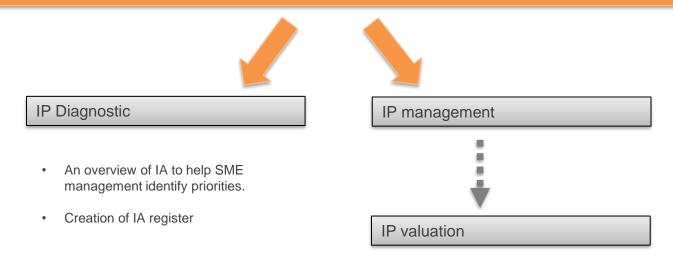


### **ONLINE TOOLS TO HELP WITH IP 'PREDIAGNOSTIC' AUDITS**

"An IP audit allows a firm to gain a clear picture of

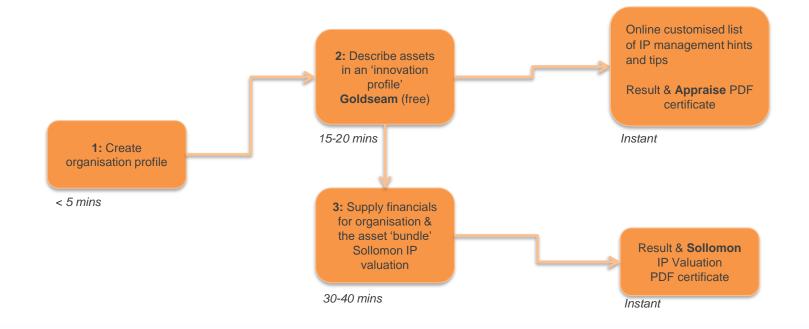
a company's IP assets to ensure that it

is able to manage its own IP and develop an effective management plan or strategy to run and grow the business."



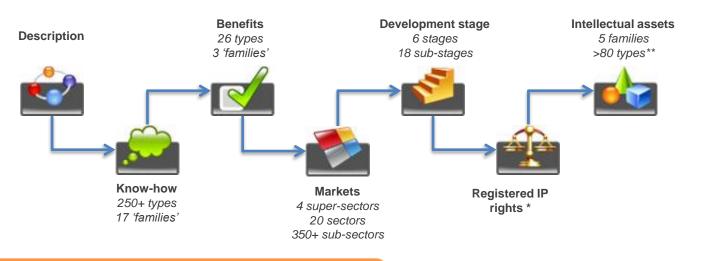


### FURTHER ONLINE TOOLS – AN OVERVIEW OF THE ONLINE PROCESS





### **Goldseam innovation profile**



Helps you generate a standardised, comprehensive inventory

Patent families can be populated from one family member saving you time

\*\* Constantly being updated based on new research



# IP DIAGNOSTIC – YOU CAN USE GOLDSEAM TO CAPTURE IPR

Rights available in	most countries	Rights only re-	gistrable in certain cou	22	
Trade mark				untries	
	Patent Design	Copyright	Utility model	Geographical in	dicat
elected registered	d rights:				
Right type	Number	Title	Status	Activity date	
Trade mark	2507 <b>4</b> 68	Carbonweave	Registered	Registration date : 16/10/2008	1
				Registration date	
				Registration of 16/10/200	late 8



### **GOLDSEAM IP PROFILING TOOL – INTELLECTUAL ASSET SELECTION:**

#### **Copyright assets**

As defined in law, but broken down to make them easier to understand, like software code

#### Contracts

#### **Resources & relationships**

- Assets that are 'built-in' to the offer, like trade secrets and proprietary • processes
- Assets linked to knowledge and contracts, like specialist/technical know-how • and licences

#### Endorsements

Evidence of acceptance, like awards and accreditations

♠ > General > Know-how > Benefits > Market sectors > Sub-sectors > Registered rights > Intellectual Assets > Summar

Lastly, identify all the non-physical assets you believe to be relevant from each of the five categories below.

You are likely to have assets that fall into a number of categories. Click each icon to review the content and descriptions, then just drag the items you want from the 'available' to the 'selected' list or double click to select. Choose as many from each category as you consider relevant.







#### **Appraise report outputs = IP audit management points**

#### Instant on screen report

- A personalised Action Plan (to IP profiled by Goldseam)
- Highlights risks requiring attention
- · Information to help make most of your IP
- · Tips on how to make IP stronger or more commercially stronger

e.g. What should you be doing to protect your IP, exploit it and generally getting your intangibles working harder on your behalf – e.g. Do you own your IP? Do you use NDAs (includes links to model templates)? Are you at risk of infringement? Can you protect rights better with registered rights? Information on international Systems

- Useful online layout that can be managed online and shared with work colleagues/business advisers
- Tailored precisely to your profile to make sure it is 100% relevant to your innovation challenges.
- Regularly updated, including for country use (specific national IP laws)



	Other information to help you make the most of your IP
i	Tips on how to make your IP stronger or more commercially successful

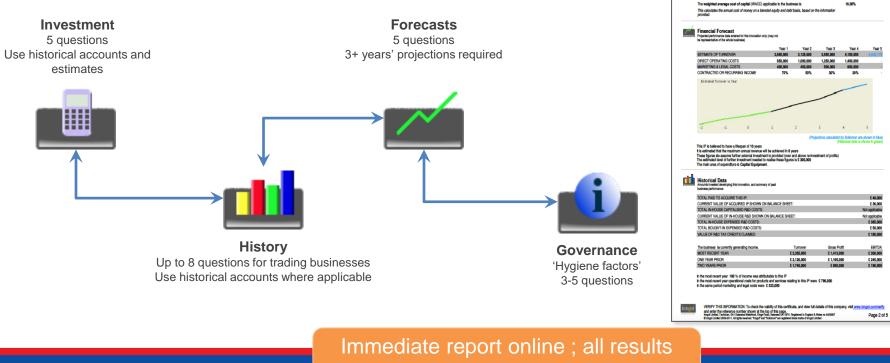
#### Your IP action plan for: Sollomon valuation methodology for IP & intangibles

Reg	istered Rights	
•	General Information	[Hide All] 🕜
⚠	Beeners of unofficial registrical When your rights are applied for, publiclined, registered or granted, you may receive a number of official-looking letters offening to record your rights in private, non-official directories. Unless the letter comes from National/Regional IPOL or of showarded from your partiest attorney. please check the validity of short letters 0	Hide Done
	Make sure you stay on top of all your registration, renewal or office action dates, otherwise you will lose valuable assets. Reminders are rarely sent by official offices, and missing a deadline can cause irrevocable damage.	Hide
	Have you considered what you will do if someone infringes your rights? And how will you find out whether anyone has? It is highly advisable to have a plan to deal with both points.	Hide Done
Â	Don't forget to keep the registration authonties (like the intellectual Property Office) advised of any changes to your contact details for correspondence, and tell them if you add or change information on your professional advises - otherwise you could miss out on important reminder.	Hide Undo
<u>^</u>	Choose a reminder system based on your budget, the size of your registered IP portfolio and your organisation's internal IP knowledge. Options include instructing your patent attorney to take responsibility for date monitoring; contracting with a specialist firm to pay fees on your behalf when due; or managing deadlines internally with a calendar and reminder system.	Hide Done
-	Trademarks	[Hide All] 💡
j	Make sure you keep the status of your trade mark up to date on the inngot system, so that you'll receive the right information from the two as a status before a sure confis to right the base	Hide

www.inngot.com/tools Price - £95/approx EUR110/Lari 360 \* Regularly updated; optimised for UK but countryspecific forms available



### SOLLOMON IP VALUATION: SIMPLE AND CONSISTENT



checked/moderated offline

SLYZ-QODM-WYTD-GGGD

22 Nov 2013 13:58:14 GMT 1

3.25% - 4.25%

23.00%

iolomon uses the information provided to project cashflow over the life of the IP. It then applies a "relief from royally" principle and brings he value back to a present day estimate by discourding the cashflow, applying an appropriate tax rate and a weighted cost of capital elevation below to the he whome and IP incourdence the cashflow, applying an appropriate tax rate and a weighted cost of capital

sollomon

Calculation Details

The royalty rate most applicable to the organisations activities is:

This represents the average level of royally currently being achieved through technology loo provides the basis for calculating the benefit to the business of having the IP. For the purposes of deriving a long-term value for the IP, we have assumed an effective tax.



### The indicative online tools: 'Sollomon'

#### Assets are captured and 'scored'

User completes a profile to identify registered and unregistered IP, other intangibles, markets, benefits, know-how and development stage

#### Financials are entered and 'scored'

Investment in IP development, historical trading performance, projected future incomes, 'hygiene factors'

#### Relief from royalty engine estimates risk-adjusted current value range

A well understood methodology; helps users by surfacing applicable licensing rates; capable of being driven from any good business plan

#### **Cost Methodologies**

Cost-based calculations using both a cost equivalent (reproduction) and invested value (amortisation) basis also provided in this single report.Used by banks as part of lending process to provide baseline view of current value of accumulated IP and intangibles expenditure,

#### Reports produced instantly, then moderated offline

- From approx £495/EUR 455/ Lari 1880
- Identified over £800/EUR 945M in hidden assets to date

<u>.</u>	ollomon	De	te issued		ODM-WYTD-GGG 2013 13:58:14 GM	г
SU		Ve	reion	1		
		Th	e current status	of this valuation	Is: GREEN	
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<u>^</u>	Financial Forecast Projected performance data entered for this innovation of the representative of the whole business)	niy (may not				
	PETRUTE OF THE PROVIDE	Year 1	Year 2	Year 3	Year 4	Year
	ESTIMATE OF TURNOVER DIRECT OPERATING COSTS	2,650,000	3,125,000	3,550,000	4,150,000	4,542,1
	MARKETING & LEGAL COSTS	400,000	450,000	500,000	600,000	
	CONTRACTED OR RECURRING INCOME	70%	50%	30%	20%	
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A cost-effective way for any company to undertake an IP valuation for different purposes – as set out in session 2









EU Georgia Intellectual Property Project

Other resources

EU GEORGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)





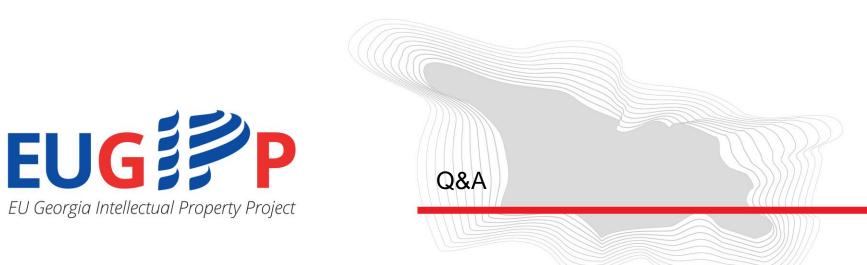
### Other resources

- Sakpatenti resources?
- WIPO Diagnostic
- Other NIPOs
- EU IP Helpdesk
- IP Databases
- Inngot online tools [Goldseam; Appraise; Sollomon]









EJ GEØGA project, funded by the European Union and implemented by the European Union Intellectual Property Office (EJIPO)











EU Georgia project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

