DRAFTING A LICENSING AGREEMENT: A CASE STUDY

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The materials in this presentation are taken from many sources and dedicated to education and training purpose only.
TRANSFER OF RIGHT

- Inheritance
- Grant
- Probate
- Written Agreement
- Other type of transfer allowed by laws

- License
- Cooperation
- Scientific services
- Publication
- NO TRUE SALE IS ALLOWED
TECHNOLOGY LICENSING

Licensing is a permit given by the intellectual property rights holder to other party based on an agreement to enjoy economic utility deriving from a given protected right in a certain period of time.
Technology transfer is the transfer of the ability to utilize and master science and technology between institutions and people, both located within or outside the territory of the country.

[Govt. Regulation No. 20 Year 2005, Art. 1]
Licensing Govt. Owned Patent

**Commercial purpose:**
- Profit oriented
- Licensing
- Royalty provision for inventor (invention owned by government).
- No true sale is allowed.

**Non-Commerial/Grant** ➔ technology transfer where the IP owner does not obtain economic benefit:
- IPTEKDA,
- Regional Special Program,
- Grant for SMEs,
- etc.
PATENT OWNERSHIP IN RESEARCH COOPERATION SCHEME

General Provision

- Shall be drawn up in a written agreement.
- Mutual benefit.
- Joint ownership is possible ➔ proportion depends on the contribution of respective parties.
- Right of employee upon the commercialized invention.
- Which party will be burdened for protection process
- Which party will conduct IP management.
SOME SECRECY ISSUES

• Before filing, an invention is still a secret information.

• Make a secrecy agreement to other party desiring to access the invention.

• Document depository & information management.

• If there any sample will be brought abroad, the Material Transfer Agreement shall be issued.
Patent, Publication & Secrecy

Open to public or restricted to a certain individuals

Does publication expose the essential features of the invention?

Patent will not be published if the invention is related to state security and defense
A Device for Producing Herbal Based Nanoparticles

**High Productivity**
(± 200kg per day)

Reducing cost of raw material
(almost 30%)

Faster raw material supply

How to determine the value?
PRIFIT POSITIONING AND INTERSECTS MAPPING

- Needs raw materials
- Supports the performance test

- Need to get performance test

- Need profit

How is the License Scheme?

- Need raw materials
- Desire to own the invention
Using the invention to produce cosmetics raw materials

- Applying the invention
- Produce the invention
- Sell the invention
- Distribution
- Utilize the invention
- Other economic exploitation
THE USE OF CORPORATE LOGO

- Good for promotion
- Reputation is at risk
- Strong risk management assessment
- How to control their product quality
- Do we have capacity to control?
start up company scheme: exploiting more profit

- Patent Owner
- Pigmen producer

Demanding Market

License Agreement → Supply Agreement

Nanovasi
- Start up company
- Pigmen producer
NON-COMMERCIAL SCHEME

- Needs the invention
- Desire to buy
- No technology transfer

PATENT UTILIZATION AGREEMENT

Patent Owner

Public Need

Social Grant
Licensing Public Invention needs special attention

Go on the objective of Technology Licensing

Make a mapping of profit positioning
LET'S HAVE A FRUITFUL DISCUSSION
THANK YOU

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