

# DRAFTING A LICENSING AGREEMENT : A CASE STUDY

Ragil Yoga Edi

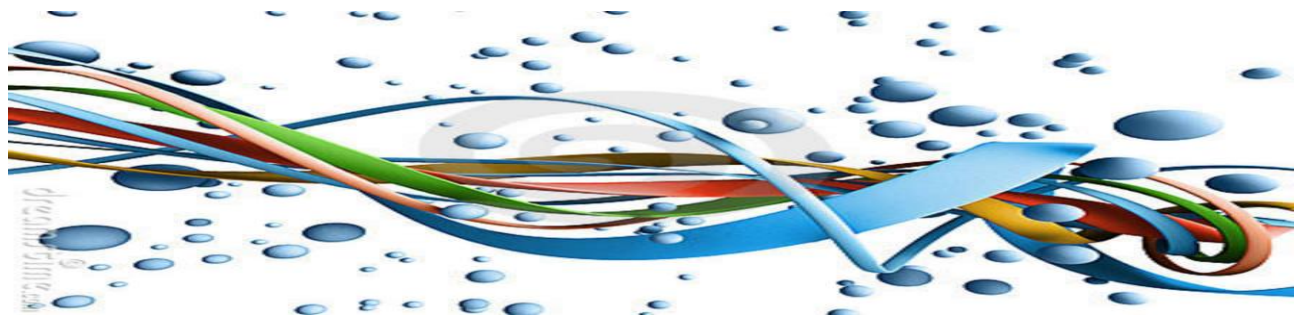
CENTER FOR INNOVATION  
INDONESIAN INSTITUTE OF SCIENCES



Mesin pembuat material nano hemat energi yang diekspor ke Malaysia.  
Inovator Nurul Taufiq Rochman.



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



# TRANSFER OF RIGHT

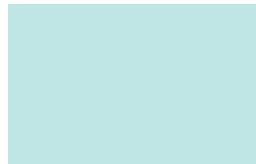
- Inheritance
- Grant
- Probate
- Written Agreement
- Other type of transfer allowed by laws

PRIVATE  
↓

PUBLIC  
↓

PROGRESS  
↓

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



# TECHNOLOGY LICENSING



Lisensi adalah izin yang diberikan oleh pemegang hak kekayaan intelektual kepada pihak lain berdasarkan perjanjian pemberian hak untuk menikmati manfaat ekonomi dari suatu hak yang diberikan perlindungan dalam jangka waktu dan syarat tertentu.

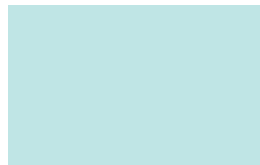


Licensing is a permit given by the intellectual property rights holder to other party based on an agreement to enjoy economic utility deriving from a given protected right in a certain period of time.



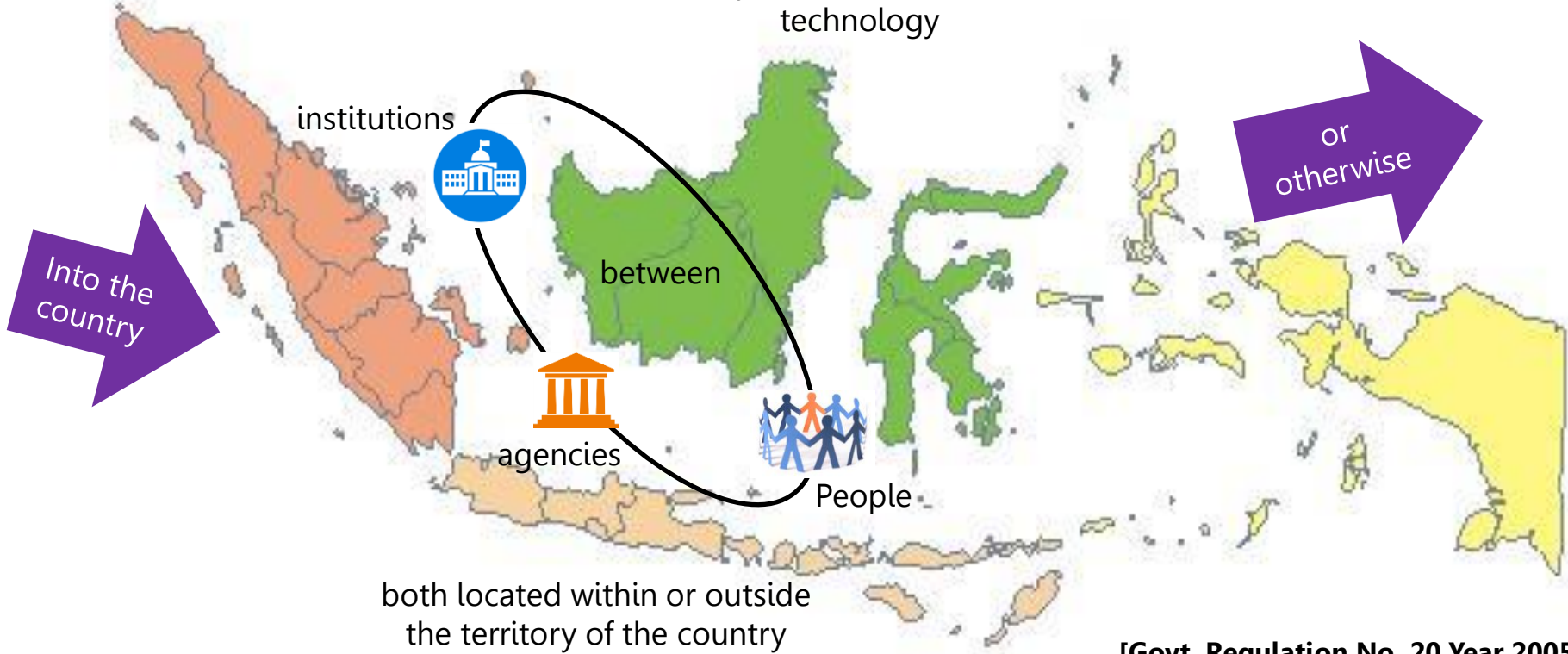
Licensing

*20 Years*



# TECHNOLOGY TRANSFER

**Technology transfer is** transfer of the ability to utilize and master of science and technology



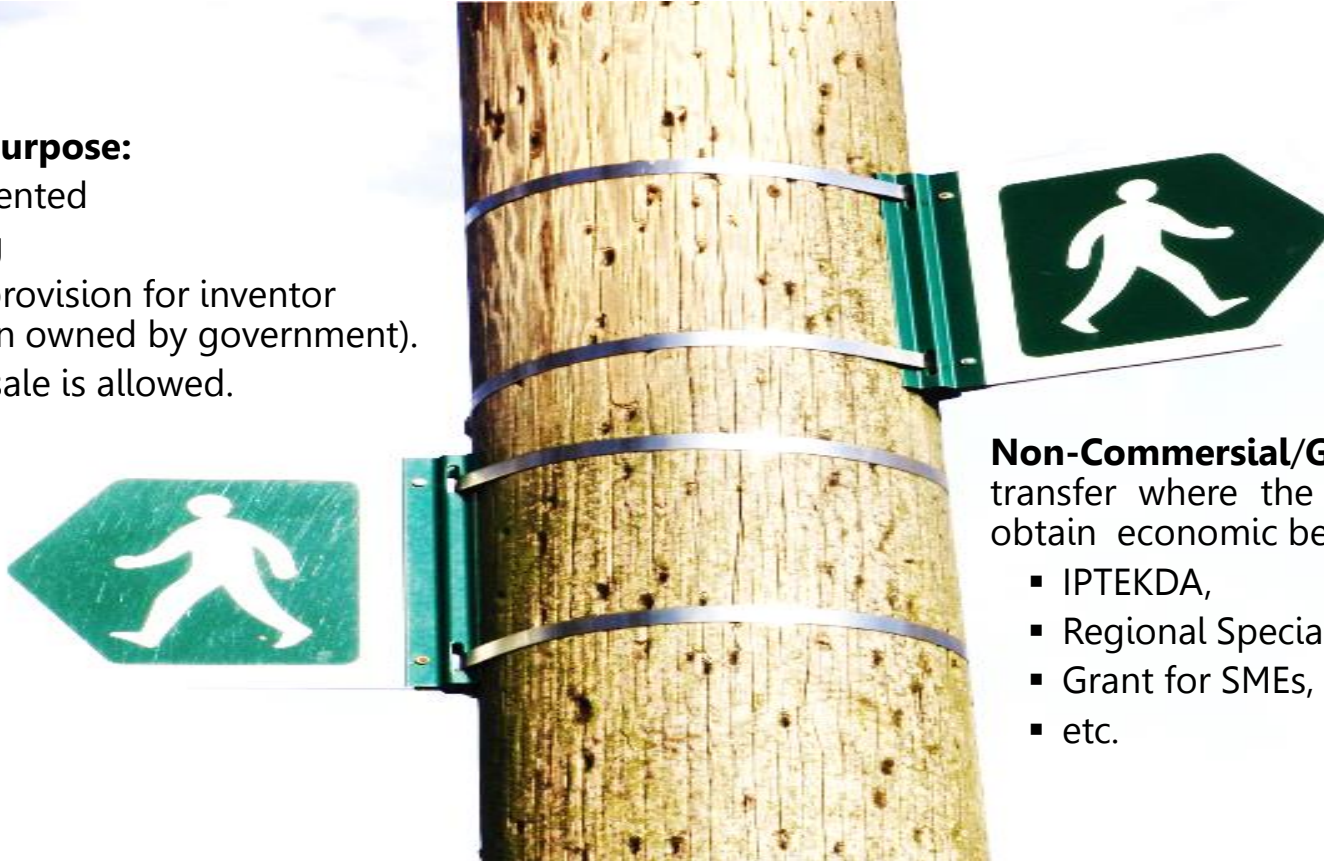
[Govt. Regulation No. 20 Year 2005, Art. 1]



# Licensing Govt. Owned Patent

## Commercial purpose:

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



**Non-Commercial/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

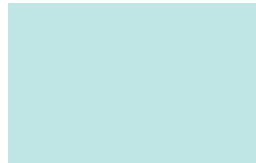
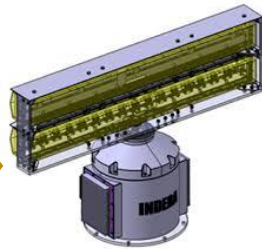
Open to public or restricted to a certain individuals

Does publication expose the essential features of the invention?

Patent will not be published if the invention is related to state security and defense



# COMMON SCHEME OF LICENSING

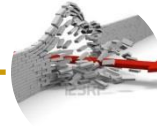


# LICENSING CHALLENGES : EXCLUSIVE OR NON-EXCLUSIVE

A Device for Producing Herbal Based Nanoparticles



High Productivity  
( $\pm 200\text{kg}$  per day)



Reducing cost of raw material  
(almost 30%)

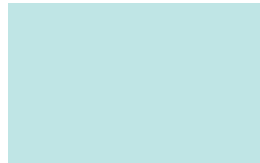


Faster raw material supply



How to determine the value?





# PRIFIT POSITIONING AND INTERSETS MAPPING



- Need to get performance test



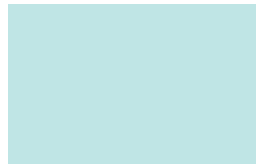
- Need profit

How is the License Scheme?

- Needs raw materials
- supports the performance test



- Need raw materials
- Desire to own the invention





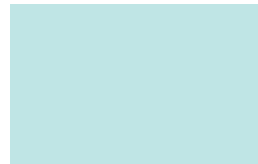
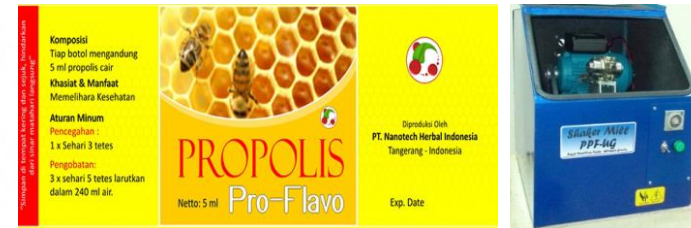
LICENSING  
No. P0020140253



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 : EXPLIOTING MORE PROFIT

Patent Owner



Demanding Market



**LICENSE  
AGREEMENT**

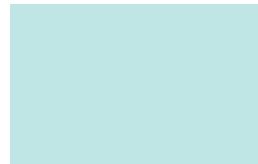


**SUPPLY  
AGREEMENT**



**NANOVASI**

- Start up company
- Pigmen producer

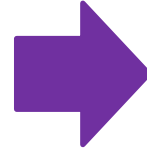
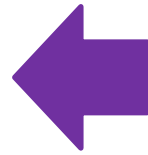


# NON-COMMERCIAL SCHEME

Patent Owner



**PATENT  
UTILIZATION  
AGREEMENT**



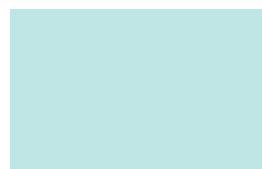
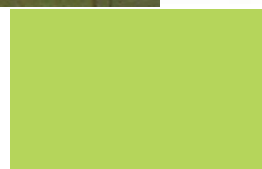
**sinarmas**

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

**Social  
Grant**



Public Need



# DRAFTING LICENSE AGREEMENT

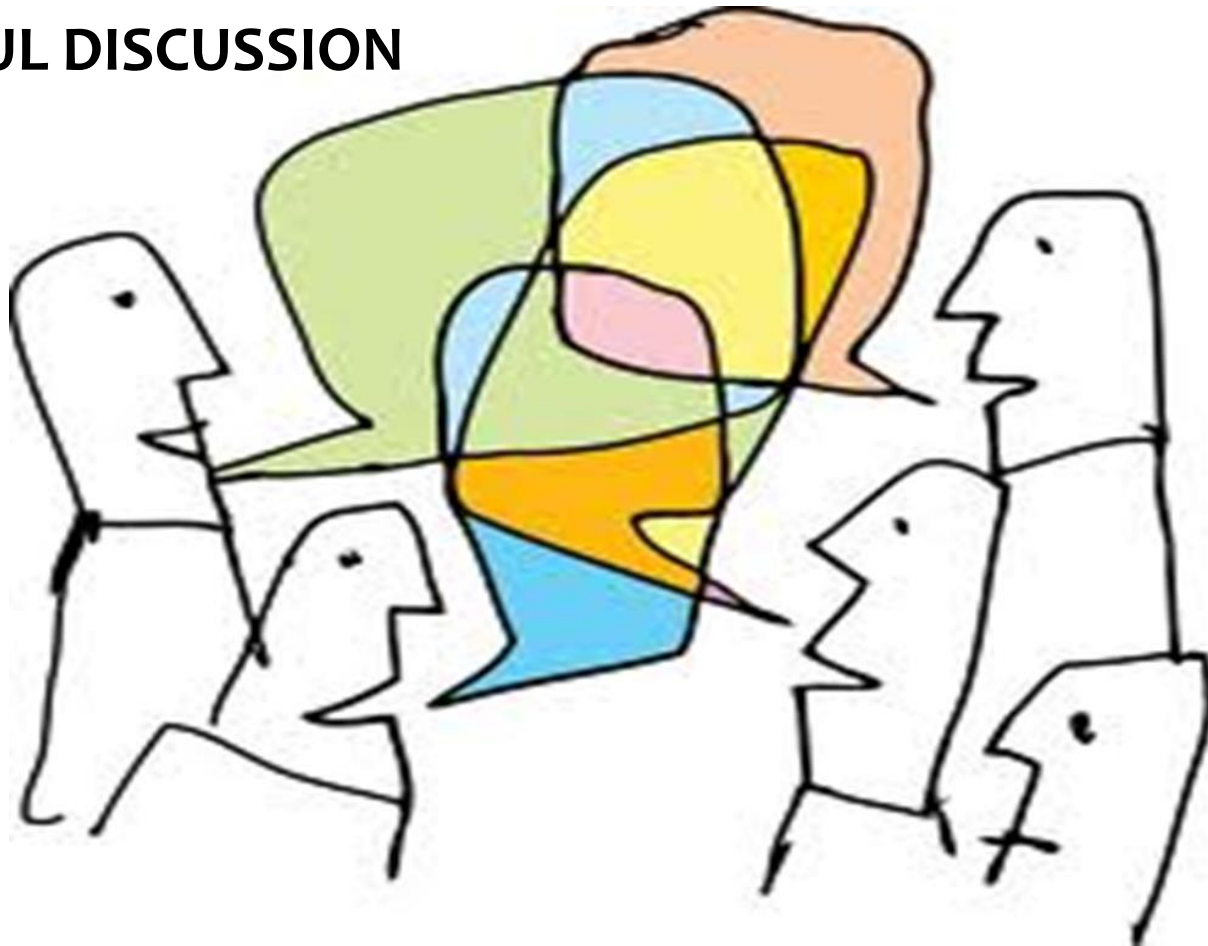
**Licensing Public Invention  
needs special attention**

**Make a mapping of profit  
positioning**

**Go on the objective of  
Technology Licensing**



**LET'S HAVE A FRUITFUL DISCUSSION**





**THANK YOU**

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