



Facultad de Derecho
Universidad Zaragoza

IP, IPRs and Corporate Strategy

Pedro-José Bueso Guillén

Prof. Dr., LL.M. Eur.

*Tenured Professor of Commercial and Business Law
University of Zaragoza, Spain*

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Summary

- A First Approach
- Preliminary Market Consultation
- Call for Tender
 - IPR Management Scheme
 - Background IPR
 - Foreground IPR
- During the Execution of the Procurement
- After Execution of the Procurement
- Final Remarks

A First Approach

- Focus of Concerns May Vary
 - Which Public Buyer (PB): Motivation (Real Need vs. Founding) / Experience Degree in IP
 - Which Contractor = Company? Motivation (R&D vs. Service) / Big Corporation vs. SME – Start Up (Tech)
 - Modality of IP: PCP vs. PPIS vs. InP
- PB is Leader
- Risks Management: Vendor Lock-In vs. Vendor Back-Out
- Competition Law Concerns – State Aid

Preliminary Market Consultation

- Information Flow
 - PB Checks / Improve Knowledge about SoTA – New Options /Better Options
 - PB May Ask about
 - IPR Scenarios
 - IPR Ownership
- Confidentiality
 - Identify Confidential Information
 - EUCJ Re. Antea Polska

Call for Tender: IPR Management Scheme

- Main Component
 - Ownership PB
 - Exceptional (defence and public security)
 - Co-ownership
 - No First Best: Property Rules
 - Ownership Company
 - First Best: In Combination with License of Use on the Results in favour of PB
 - Scope: Subjective (Beneficiaries) – Duration – Geographic – Objective: for what purposes?
 - Extension: Non Exclusive – Sublicenses/Right to Order Licenses to Third Parties – Right to Evolve/Modify – Access To Updates/New Versions – SW: Proprietary vs. Open
 - Price: Free/Royalties

Call for Tender: Background IPR

- Background IPR Provided by the Company
 - Own IPR / Third Parties' IPR
- Background IPR Provided by the PB → Condition of Execution
- Access to Background IPR
 - During the Execution of the Procurement
 - To PB / Third Parties
 - After the Execution of the Procurement
 - Extension of Licenses on Background IPR
 - Cost of Licenses on Background IPR → Price of the Procurement

Call for Tender: Foreground IPR

- Expected Results
 - Extended Provisions in Call for Tender – Patents, Trade Marks, Designs, Trade Secrets, Copyright (SW)
- Duty to Report on Results
- Duty to Protect Results
 - Maturity Level of the Results
 - Cost of the Protection

During the Execution of the Procurement

- Reporting of Progress → Documentation of Results
 - Important for PB / Important for Company
- Protection of Results → IPR Choice
 - Trade Secrets (Algorithms) / SW / Data Sets
- Confidentiality
 - On Company's Side / On PB's Side
- An the End: License Agreements

After the Execution of the Procurement

- Granting Access to Third Parties
 - Conditions – FRAND, Market, MFN
- Duty of commercial exploitation of the Results/Foreground IPR
 - Maturity of the Results/Foreground IPR
 - Call-back Provision
- Royalties to be Paid to the PB
 - Access to Accounting Information

Final Remarks

- IP Strategy = IPR Strategy in IP
- IPR Strategy → Win-Win Scenario for the PB and the Company → Decision TO GO vs. NOT TO GO
 - Strategic for PB: Satisfaction of Future Needs, Payment of a Fair Price and Support of Innovation
 - BUT ALSO Strategic for the Company → R&D Investment / Business Plan
 - Principle → Share Risks and Benefits → IPR Management Scheme → Share Results: Scope and Extension of the Use License granted to PB
 - Leadership → PB; BUT Companies CAN Help to Shape a Proper Scenario

Thank you for your attention!

e-mail:
pbueso@unizar.es



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