IP, IPRs and Corporate Strategy

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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 \(\rightarrow\) Documentation of Results
  – Important for PB / Important for Company

• Protection of Results \(\rightarrow\) 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!

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