

Financial institutions
Energy
Infrastructure, mining and commodities
Transport
Technology and innovation
Life sciences and healthcare

 **NORTON ROSE FULBRIGHT**

Reengineering your company in the digital era

Monday, June 6, 2016

*motion*2016
discussing what matters

Join the conversation



Tweet using #NLawMotion and connect with @NLawGlobal



Connect with us on LinkedIn
[linkedin.com/company/nortonrosefulbright](https://www.linkedin.com/company/nortonrosefulbright)

Speakers

Anthony de Fazekas



Partner

Norton Rose Fulbright Canada LLP
Toronto

Anthony de Fazekas' practice focuses on all areas of information technology law, including the formation of winning IP strategies and the development and prosecution of original patent applications in a wide range of IT-related technologies.

Stephen Whitney



Of Counsel

Norton Rose Fulbright Canada LLP
Toronto

Stephen Whitney has significant international expertise in complex technology transactions. He works with companies of all sizes from start-ups to large international corporations.

Mihnea Moldoveanu



Vice Dean, Learning, Innovation and Executive Programs, Rotman School of Management, University of Toronto
Toronto

Mihnea Moldoveanu is the Vice Dean of Learning and Innovation, Director of Desautels Centre for Integrative Thinking and Marcel Desautels Professor of Integrative Thinking. He has enjoyed parallel careers as an entrepreneur and academic.

“Most of the innovation and disruption are coming from new entrants — young, fearless, and not afraid to take on the status quo. So now what? Existing corporate strategy and structures have proven unequal to adapt to this changing economy. Every existing company will have to deal with this common economic problem: how do you build an effective organization in a time of continuous disruption — one where the old rules and structures no longer work. Companies will need to adapt a new strategy that embraces disruption, sustaining innovation, and execution. Crucially, they need to build new organizational structures that embrace those changes.”

– Steve Blank, The Godfather of Silicon Valley

What does open innovation mean, practically speaking to an enterprise?

- Enterprises cannot respond to challenges of disruption merely with “closed innovation”
- They need to embrace strategies for engaging in “open innovation”, which is where companies use external ideas and technologies to accelerate their internal innovation and commercialization of innovation (today’s innovation model)
- Programs (that also include flexibility) that formalize how the enterprise supports research/development projects and bringing products/services based on these projects to market, and collaborates with innovative third parties including startups.

Collaboration Agreements & IP Ownership

- The most contested issue in negotiating Collaboration Agreements is IP ownership
- There are lots of ways IP ownership can be addressed

Collaboration Agreements & IP Ownership

Background Intellectual Property

- the easy part to agree on is that each party owns what each party brings into the relationship – often called Background Intellectual Property

Collaboration Agreements & IP Ownership

Project Intellectual Property

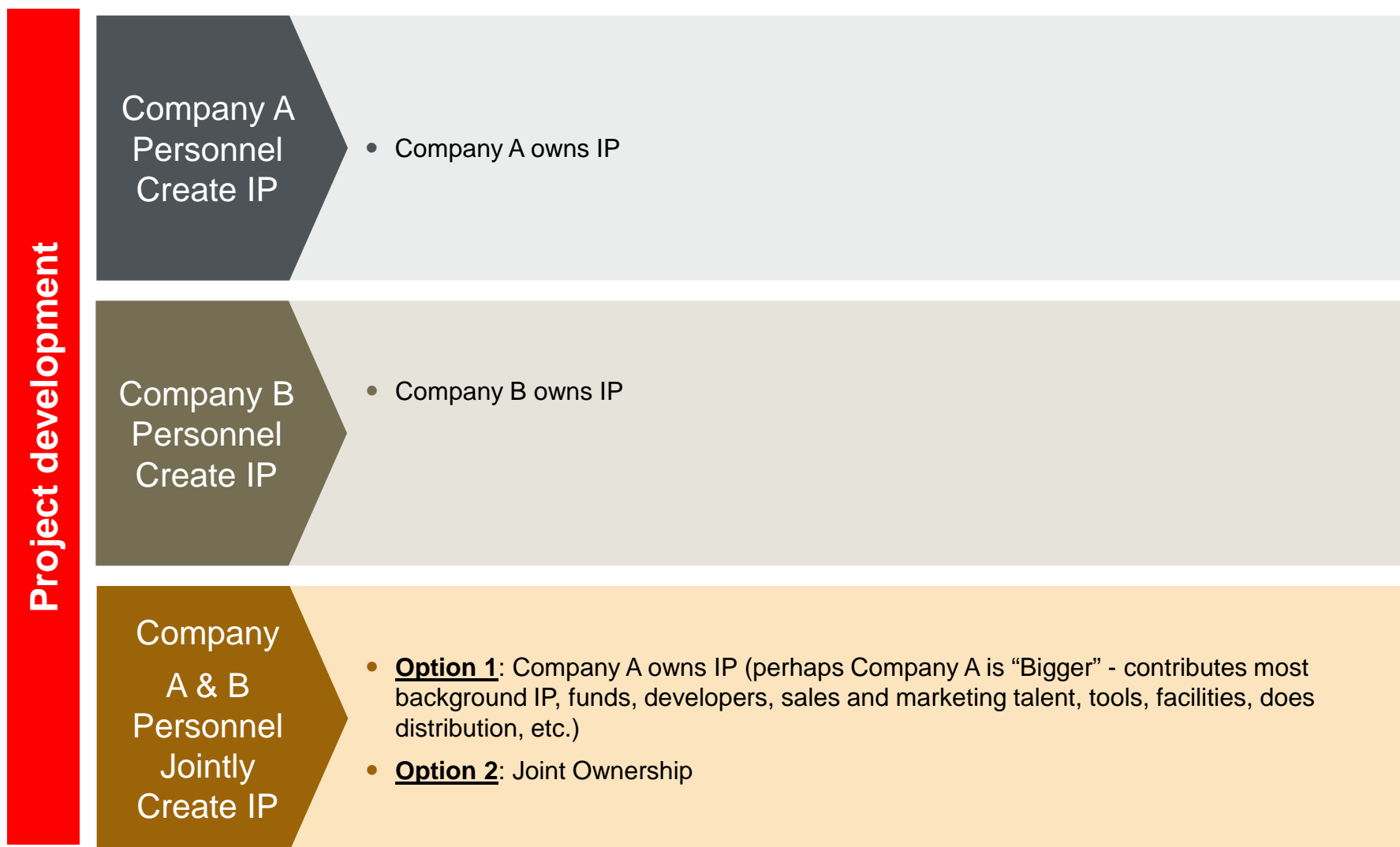
- Project Intellectual Property is the IP that is created during the project
- the most contested issue when negotiating Collaboration Agreements is who will own the Project Intellectual Property
- will it be owned exclusively by one party or will it be jointly owned?
- will there be any licenses of the Project Intellectual Property?

Collaboration Agreements & IP Ownership

Project Intellectual Property (cont)

- sometimes the parties do not know at the beginning of the relationship what each party will contribute and who will contribute more so the parties are very hesitant to give up ownership of IP
- equally important is that IP ownership is a major obstacle in getting deals done and there is often pressure to get deals done quickly, so often the parties agree to joint ownership, but would other IP ownership models be more beneficial to you and accepted by the other side?
- Let's review some IP ownership models that may help you in your discussions with your clients and collaborators

By Inventor with Sole or Joint Ownership



By Field, No Joint Ownership

Project development

Company A
Personnel
Create IP

- Company A owns IP if in Field A
- Company B owns IP if in Field B

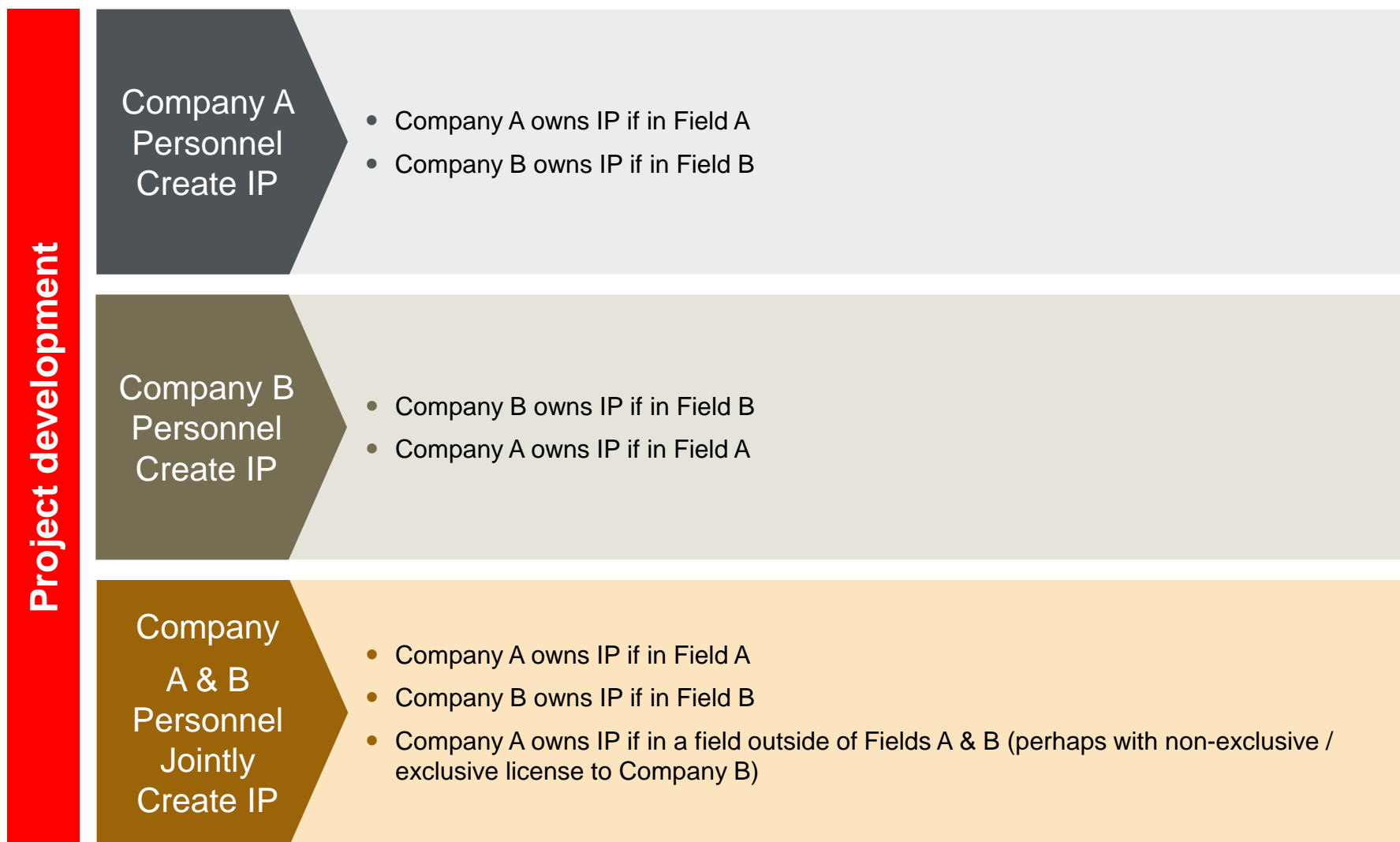
Company B
Personnel
Create IP

- Company B owns IP if in Field B
- Company A owns IP if in Field A

Company
A & B
Personnel
Jointly
Create IP

- Company A owns IP if in Field A
- Company B owns IP if in Field B

By Field, No Joint Ownership, With “Catch All”



Contract Services, “Bigger” Owns IP, Non-Excl License



Contract Services, “Bigger” Owns IP, Excl License

Project development

Company A
Personnel
Create IP

- Company A owns IP
- Exclusive license to Company B in their Field

Company B
Personnel
Create IP

- Company A owns IP
- Exclusive license to Company B in their Field

Company
A & B
Personnel
Jointly
Create IP

- Company A owns IP
- Exclusive license to Company B in their Field

By Field with Sole/License/Joint Ownership

Project development

Company A
Personnel
Create IP

- Company A owns IP if in Field A
- Company B owns IP if in Field B

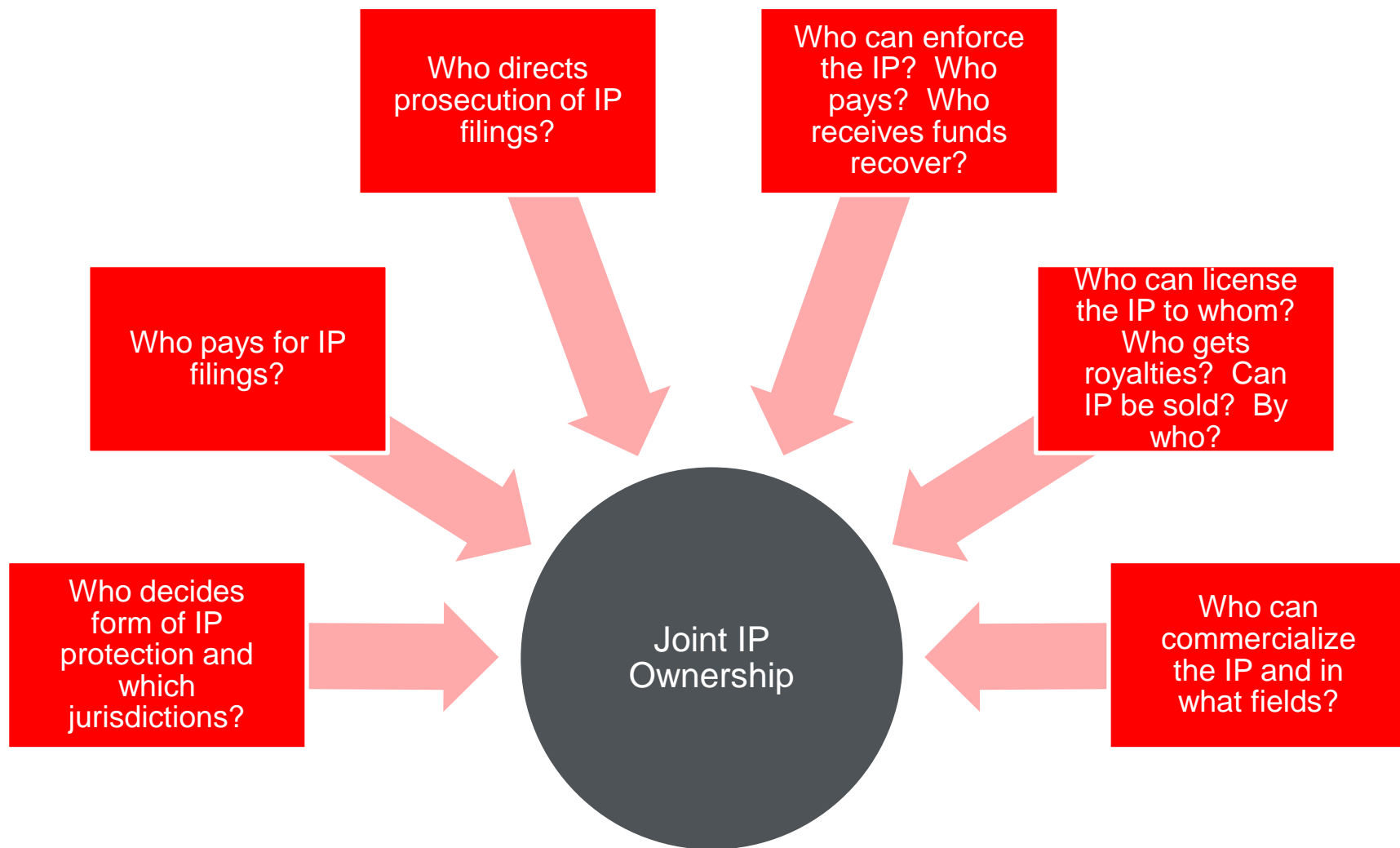
Company B
Personnel
Create IP

- Company B owns IP if in Field B
- Company A Owns IP if in Field A

Company
A & B
Personnel
Jointly
Create IP

- **Option 1**: Company A owns (if “Bigger”, could include revenue sharing into deal)
- **Option 2**: Company A owns IP if in Field A, Company B owns IP if in Field B, Company A owns IP if in a field outside of Fields A & B (with or without non-exclusive/exclusive license to Company B; could include revenue sharing into deal)
- **Option 3**: Joint Ownership

Other Issues to Address with Joint IP Ownership





If you have any questions regarding today's presentation or would like to discuss any of the topics that have been presented, please feel free to stay behind or leave your business card behind and we will be sure to follow-up with you.

Thank you.

Contact

Anthony de Fazekas

Partner

+1 416.216.2452

anthony.defazekas@nortonrosefulbright.com

Stephen Whitney

Partner

+1 416.216.2435

stephen.whitney@nortonrosefulbright.com

Join the conversation



Tweet using #NLawMotion and connect with @NLawGlobal



Connect with us on LinkedIn
[linkedin.com/company/nortonrosefulbright](https://www.linkedin.com/company/nortonrosefulbright)

Resource material

Are you #riskready?

*motion*2016
discussing what matters

 **NORTON ROSE FULBRIGHT**