



# IP Principles for Funded Research Projects

Through technology transfer, Empa makes a significant contribution to Switzerland as a lasting strong business and research location. It enables its business partners to commercialise the research results generated at Empa. As a public institution, Empa protects its continuing freedom to research and publish in the long term while striving for the greatest possible overall economic benefit.

The following IP principles serve as the basis for discussions of the project partners to formulate the collaboration contract. Alternative provisions may be agreed upon in certain cases depending on particular project-specific circumstances.

<b>General project conditions</b>	<ul style="list-style-type: none"><li>■ A project jointly formulated with a business partner</li><li>■ Partial funding by public or private sources (e.g. CTI, foundations)</li><li>■ Significant contributions from all project partners</li><li>■ Regulations of the funding institution</li></ul>
<b>Right of publication</b>	<ul style="list-style-type: none"><li>■ Contractually agreed publication process (e.g. exchange/review of the manuscripts)</li><li>■ Delay of publication, if required for a patent application</li><li>■ Empa's right to publish project results subject to its obligation under a confidentiality agreement</li></ul>
<b>Confidentiality</b>	<ul style="list-style-type: none"><li>■ Duration of Empa's timed confidentiality obligations:<ul style="list-style-type: none"><li>▪ confidential information supplied by the business partner (Background): confidential up to 3 years after the end of the project</li><li>▪ Non-protected project results: confidential up to 6 months after the end of the project</li></ul></li></ul> <p>Exception: Scientific publications by Empa project team as part of their academic training (e.g., Bachelor, Master and Doctoral theses) are to be permitted. The project results necessary for such publications are exempt from the confidentiality obligation provided that this has been contractually agreed in advance.</p>
<b>Empa-Background IP</b>	<ul style="list-style-type: none"><li>■ Empa grants access to use its Background IP if required for exploiting the project results.</li><li>■ The right to use Empa-Background IP is non-exclusive.</li></ul>
<b>Ownership of project results</b>	<ul style="list-style-type: none"><li>■ Project results belong to the party that generated them.</li><li>■ Jointly achieved project results are jointly owned by the parties that generated them (co-ownership).</li></ul>
<b>Patenting of jointly generated project results</b>	<ul style="list-style-type: none"><li>■ If the business partner decides to file a patent application for a joint invention:<ul style="list-style-type: none"><li>▪ The patent application is filed in the name of all owners</li><li>▪ The business partner manages the patent application and bears the patent costs</li><li>▪ Empa provides support in the patent application process</li><li>▪ Empa is involved in the patenting process</li><li>▪ A subsequent transfer of Empa's co-ownership rights may be negotiated on a case-by-case basis</li></ul></li><li>■ If the business partner does not apply for a patent within 4 months after the end of the project, Empa has the right to file a patent application for the invention at its own costs in the name of all owners.</li></ul>

## Rights of use

- The *business partner's* commercial right to use *protected* project results:
  - Free of charge, non-exclusive and sub-licensable right of use in its business area in addition, if acceptable in light of Empa's freedom of research:
    - Option of exclusive, sub-licensable right of use in a jointly defined *area of application* (the terms and conditions can also be negotiated when the project results become available), or
    - Granting of an exclusive right of use in a jointly defined area of application (the terms and conditions must be negotiated before the start of the project)
- Principle: exclusive rights of use are subject to a fee as well as an obligation of use in accordance with a timetable to be agreed upon.
- *Empa's* commercial right of use of *protected* project results:
  - Sub-licensable right of use subject to the exception of the business partner's exclusive area of application, where applicable.
- The right of the individual project partners to freely use *non-protected* project results subject to compliance with the obligation of confidentiality and publication rules.

## Empa compensation

- Appropriate compensation will be specifically agreed upon for:
  - A business partner's exclusive right of use of protected research results
  - In exceptional cases: the commercial use of Empa Background IP if specifically agreed upon in the contract
- The following elements will be specifically taken into account in the determination of compensation:
  - Size and potential of the exclusive application area for the business partner and Empa
  - Development stage of the invention
  - Type and scope of intellectual property
  - Empa's level of contribution to the invention
  - Sector-specific aspects (e.g. product margins)
  - Market position and setup of the company (e.g. start up, SME, corporate group)
  - Particular details or circumstances of the project (e.g. partner contributions, Background)

## Participation models

- The Empa endeavours to offer suitable participation models that take into account the further development and market launch of products, in particular by start-ups and SMEs.
- The following models have proven successful in practice:
  - Revenue-related compensation:
    - Percentage of net revenues or per piece royalty (the reference value is to be defined jointly), payment obligation, possibly following a waiting period or after reaching a certain level of turnover
    - If the agreed obligation of use cannot be performed, an extension of exclusivity is possible in certain cases, subject as rule to payment of the minimum licence fees
  - Milestone payments, for example in the case of:
    - Market launch
    - Achievement of certain revenue figures
    - Publication of the patent application/first grant of a patent
- Advance acquisition of an exclusive right of use:  
Upon express request of the business partner, an advance acquisition of an exclusive right of use in a defined area of application can be negotiated at the conclusion of the contract. In such case, the compensation will, in addition, take into account Empa's uncovered costs.

## Empa contact

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