



## IP Principles for Research Projects

Through knowledge and technology transfer Empa makes a significant contribution to maintaining Switzerland as a strong business and research location. Empa enables its partners to commercialise research results generated at Empa. As a public institution, Empa safeguards its freedom of research and publication in the long term while at the same time striving to achieve the greatest possible benefit for the economy as a whole.

The following IP principles shall serve as a basis for discussions between the project partners to establish the collaboration agreement. Alternative provisions may be agreed in certain cases depending on the specific circumstances of the project.

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| <b>General project conditions</b>                     | <ul style="list-style-type: none"> <li>■ A project formulated together with a business partner</li> <li>■ Partial funding by public or private sources (e.g. Innosuisse, foundations) or business partners</li> <li>■ Significant contributions from all project partners</li> <li>■ Subject to regulations of the funding organization where applicable</li> </ul>  |
| <b>Right of publication</b>                           | <ul style="list-style-type: none"> <li>■ Defined publication process (e.g. exchange/review of manuscripts)</li> <li>■ Delay of publication, if required for a patent application</li> <li>■ Empa's right to publish project results, subject to its confidentiality obligations</li> </ul>   |
| <b>Confidentiality</b>                                | <ul style="list-style-type: none"> <li>■ Duration of Empa's confidentiality obligations:             <ul style="list-style-type: none"> <li>▪ confidential information supplied by the partners: confidential up to 3 years after the end of the project</li> <li>▪ project results: confidential up to 3 months after the end of the project</li> </ul> </li> <li>■ Exception: Scientific publications by Empa project team members 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 agreed in advance.</li> </ul>                                       |
| <b>Empa Background IP</b>                             | <ul style="list-style-type: none"> <li>■ Empa grants access to its Background IP if required for exploiting the project results.</li> <li>■ The right to use such Background IP is subject to separate agreement.</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 is involved and provides support in the patent process</li> <li>▪ A subsequent transfer of Empa's co-ownership may be negotiated on a case-by-case basis</li> </ul> </li> <li>■ If the business partner does not apply for a patent within 3 months after the end of the project, Empa has the right to file a patent application for the joint invention at its own costs.</li> </ul> |

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| <b>Rights of use</b>       | <ul style="list-style-type: none"> <li>■ The <i>business partner's</i> right of use of <i>protected</i> project results: <ul style="list-style-type: none"> <li>■ Free of charge, non-exclusive and sublicensable right of use in defined <i>area of application</i>. In addition, if acceptable in view of Empa's freedom of research:</li> <li>■ Option for an exclusive, sub-licensable right of use in a defined area of application (the terms and conditions can be negotiated when the project results are available),</li> <li>■ or, upon request, grant of an exclusive right of use in a defined area of application in advance (the terms and conditions must be negotiated before project start)</li> <li>■ Principle: exclusive rights of use are subject to a fee as well as an obligation of use.</li> </ul> </li> <li>■ <i>Empa's</i> right of use of <i>protected</i> project results: <ul style="list-style-type: none"> <li>■ Sublicensable right of use outside the business partner's exclusive area of application.</li> </ul> </li> <li>■ Right of all project partners to freely use <i>non-protected</i> project results subject to compliance with confidentiality obligations and publication rules.</li> </ul> |
| <b>Empa compensation</b>   | <ul style="list-style-type: none"> <li>■ Appropriate compensation will be agreed for: <ul style="list-style-type: none"> <li>■ A business partner's exclusive right of use of protected project results</li> <li>■ The commercial use of Empa Background IP if expressly agreed in the contract</li> </ul> </li> <li>■ The following elements will be taken into account for determination of the compensation: <ul style="list-style-type: none"> <li>■ Size and market potential of the exclusive application area</li> <li>■ Development stage of the invention</li> <li>■ Type and scope of intellectual property protection</li> <li>■ Empa's level of contribution to the invention</li> <li>■ Market-specific aspects (e.g. product margins)</li> <li>■ Market position and setup of the company (e.g. start up, SME, corporate group)</li> <li>■ Particular details or circumstances of the project (e.g. partner contributions, background)</li> </ul> </li> </ul>  |
| <b>Compensation models</b> | <ul style="list-style-type: none"> <li>■ Empa endeavours to establish fair and reasonable compensation models.</li> <li>■ The following models have worked well in practice: <ul style="list-style-type: none"> <li>■ Revenue-related compensation: <ul style="list-style-type: none"> <li>■ Percentage of net revenues or per-piece royalty, possibly following a waiting period or after reaching a certain level of turnover</li> <li>■ If the agreed-upon obligation of use cannot be met, continuing exclusivity is possible in certain cases, usually subject to payment of a reasonable fee</li> </ul> </li> <li>■ Milestone payments, for example upon: <ul style="list-style-type: none"> <li>■ Market launch</li> <li>■ Achievement of certain revenue figures</li> <li>■ Publication of the patent application/first grant of a patent</li> </ul> </li> </ul> </li> <li>■ Grant of an exclusive right of use in a defined area of application in advance:<br/>When determining the compensation, Empa's uncovered costs shall additionally be taken into account.</li> </ul>  |
| <b>Empa contact</b>        | Please contact the Empa Technology Transfer Office if you have any questions:<br>Email: <a href="mailto:marlen.mueller@empa.ch">marlen.mueller@empa.ch</a> ; Telephone: +41 58 765 41 97<br><a href="https://www.empa.ch/web/empa/research-cooperation">https://www.empa.ch/web/empa/research-cooperation</a>  |