

Dehns

Patent and Trade Mark Attorneys

Dehns Consulting



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Introduction:

Dehns Consulting

Here at Dehns, we've been doing a little R&D of our own and we've decided to do things a bit differently. Based on the collective knowledge that Dehns has built up over the last 100 years, Dehns Consulting is our dedicated IP consultancy service that provides expert insights to help leverage IP for a wide range of commercial goals.

Dehns is one of Europe's largest and most reputable firms of Patent and Trade Mark Attorneys. As well as being leading experts in core intellectual property matters, for example relating to obtaining valuable patent and trade mark protection, our team is renowned for being able to see the 'big picture' and apply their insights to broader commercial contexts.

Across our team, we have expertise in all types of technology, ranging from semiconductors to genetic engineering. We also have a wealth of experience in brands and trade marks. Having worked with clients ranging from individuals all the way through to global Fortune 500 companies, the Dehns Consulting team is familiar with advising clients of all sizes regarding key strategic decisions from an IP perspective.

Importantly, Dehns Consulting casts aside the legal jargon and will speak to you in real terms that are easy to understand. We provide practical, pragmatic and commercial advice that you can apply immediately to your business and your business objectives.

Discover how these services will be able to add genuine value to your business and give you the commercial advantage you need.

What is it?

Dehns Consulting is our unique offering of intellectual property (IP) consultancy services that aims to provide tailored strategic advice to help make critical business decisions.



We can help you

‘whether you are big...’

As a company grows, so too does the number of considerations that need to be taken into account. Perhaps you are looking to grow the business in a new direction and need help investigating the landscape before making a large investment. Alternatively, you may have spent years building up a large portfolio of IP rights and want to take a step back and assess whether there are areas of the portfolio that need strengthening through new filings, or that are no longer relevant to your business objectives and so can be cut back so that the budget can be re-invested wisely.

We can also help with analytical insights and valuations. Whether you are interested in gathering intelligence on competitors and their IP, or whether you would like to get an evaluation of your portfolio’s current value for a shareholder report, we can help you.

We understand that these types of projects can be large undertakings, and so diverting in-house resources to these activities is not always feasible. We can put together a team with the right experience and skills to carry these out for you.

‘... or small.’

Whether you are a Pre-Seed or Series A start-up or an established SME, it is critically important that small businesses have plans in place to safeguard their IP and to assess the potential impact of existing third party IP rights. It is never too early to put these plans in place, and the risks from not having given proper consideration to IP can be high. We can work with you to formulate your IP strategy and to make sure you have a good handle on IP issues relevant to your business.

We know that investors will almost inevitably want an overview of your current IP situation, what rights you have, and what your plans are for deriving value and protecting your innovations, both those that are already developed and those that are in the development pipeline.

We appreciate that the world of IP is complex, and is often seen as impenetrable to start-ups that are running with lean-yet-agile business models. At Dehns, we have worked with a huge number of start-ups, and have helped them grow and flourish, safe in the knowledge that one of their most important assets is fully protected.

Our Services: IP and Beyond

Making IP work for you

The following pages provide an overview of the services we offer and which are tailored to help businesses like yours to make decisions and to manage their IP effectively. However, even if your exact situation does not appear to be covered by the examples given, get in touch for a no-obligation discussion so we can explore how we can help you.



IP Strategy



An IP strategy is simply a plan to build and protect an IP portfolio and to leverage the maximum possible value from the IP assets within that portfolio. However, the most important aspect of the plan is to make sure that it is completely consistent with the company's business goals and objectives.

We always make sure that we take the time to get to know you and understand your business, your journey, and your commercial objectives. In this way, we can help you make the best and most informed IP-related decisions for you and your business.

Through our Dehns Consulting offer, we help businesses like yours every day with the creation, implementation and review of bespoke IP strategies which are right for each individual organisation and its specific goals.

We can help and support with key aspects of IP strategy, including:

- **Innovation Harvesting:** We look at your overall R&D activities to see what innovations might have been/are being created. We can also advise you regarding best practice techniques and processes you can use to ensure the IP you generate is properly identified going forward.
- **Innovation Capture:** We can help you to put processes in place for effectively detailing your innovations for further review, both in-house and with a member of our team, e.g. for later discussions around how to protect the IP.
- **Planning an IP Roadmap:** We work with you to divide your product ideas into core elements (e.g. the key functions, aesthetic details, and branding) and advise you regarding how best to protect each of these elements.
- **Brand/Trade mark audit:** We review your website(s), social media and marketing materials (e.g. brochures, catalogues etc.) alongside your existing trade mark portfolio, if appropriate, to identify any potential gaps in your protection, and advise on appropriate clearance searching/ filing strategies.
- **Strategy Review:** If you already have an IP portfolio, however large or small, we can undertake a thorough review of your current IP strategy in light of your commercial goals and then advise regarding potential enhancements to your strategy.

In essence, we take a holistic view of your overall R&D activities, then drill down into the details to identify and capture patentable ideas, before finally creating an optimal plan on what to do with each idea. In this way, we work with you to create an IP strategy that's right for your business and corporate objectives.

We also work with you to ensure that the other aspects of your IP are well protected, for example by ensuring your brand identity is adequately protected through trade marks, and exploring whether registered designs may be applicable to any aesthetic elements of your products. The IP strategy that we formulate with you will also cover aspects of your IP that are not to be protected through a registered right – for example those elements that it may be better to protect through trade secrets, unregistered design rights, and/or copyright (where applicable) instead.



Case Study

airMont AS

Background

airMont AS is a small Norwegian start-up that provides digital services directed to improving air quality. Dehns has worked with airMont since their inception, advising on matters relating to IP and innovation management.

Issue

airMont had been very busy brainstorming a large number of ideas for a potential product, and were aware that they were generating IP but needed help deciding what to do with the various ideas they had come up with. With a finite budget and limited timescales, it was important to them to have an IP Strategy in place to ensure resources were spent wisely.

What we did

Dehns IP Consultant Sam Cleary was asked to provide a workshop to airMont to work through their various ideas in order to meet their commercial goals. After hearing more about airMont, their commercial goals, and their target markets, the team worked through each of airMont's innovations in turn, and Sam helped to tease out the various underlying ideas into individual components and mapped these components to the commercial goals.

With an idea in mind of the major commercial milestones such as when airMont's first product is due to launch, when further funding may be sought, and when R&D phases are planned for, Sam plotted out an IP Roadmap that planned out when patent filings should be made and for which particular ideas. The IP Roadmap shows a timeline of when airMont have major decision points, both in terms of deadlines relating to the patent filings (such as decisions regarding international coverage) but also commercial milestones that may impact those decisions.

Outcome/result

A core patent family has been filed directed to key aspects of a minimum viable product and that will also be used to cover potential future products, which will also benefit from further patent filings that are planned for the coming years. The IP Roadmap is designed to take commercial milestones into account, such that wherever possible, decisions relating to airMont's IP portfolio are timed to occur after significant events that influence that decision.

Dehns has also advised airMont in relation to the acquisition of third party IP to help support their commercial objectives, which has expanded the portfolio to include some key related technologies, helping airMont to achieve their commercial goal of providing a range of digital services relating to air quality.

Due to the blend of IP and commercial expertise Dehns can provide, airMont are able to make sure that their IP budget is spent in an informed way, with each filing being carefully planned out such that ideas still being developed are kept confidential and ensuring that the business is in the best place commercially to make decisions in the future.

Portfolio Review

This key aspect of our IP consultancy service involves examining your entire IP portfolio in detail and providing recommendations regarding how to manage that portfolio going forward in accordance with your own commercial circumstances.

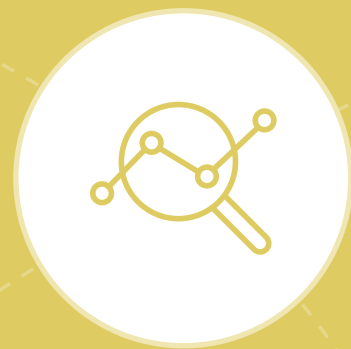
For example, if you are about to enter a new capital raising round, a portfolio review will enable you to see if there are any weaknesses in your portfolio which might put a potential investor off. With our experience of the fund-raising process, our team can identify any weaknesses beforehand and provide guidance to rectify and strengthen the portfolio, thereby making your company a more attractive investment.

We can help and support with key aspects of managing your IP portfolio, including:

- **Product mapping:** Matching the current IP portfolio to products/product range to give a better idea of where strengths and weaknesses are.
- **Roadmaps:** Planning out a timeline for the portfolio and any upcoming commercial events (for example, priority deadlines, national phase deadlines, product launches, product trials, etc.) to identify where key IP decisions need to be made and what those decisions should be.
- **Budget planning:** Helping to make budgetary decisions, for example by culling obsolete IP to recycle funds toward newer IP.



Analytics & Investigation



Dehns Consulting has access to a large number of local and global IP data sources, including sophisticated tools developed in-house, which can help provide the information you need to make informed, effective and ultimately successful business decisions based on data rather than on gut instinct alone.

We do this by firstly understanding your business objectives, your IP and your immediate concerns, and then using our data sources to find the relevant information needed to address your concerns. Then, through analysis of the data and any further investigations, we create a bespoke report providing you with the information you need to enable your organisation to make the most well-informed decision possible.

The results of the investigations may help you decide on target markets, to steer marketing plans, to identify potential licensees for your IP, or for many other applications.

Examples of how we use our expertise in this field include:

- **Landscaping:** We are highly skilled and experienced at using various techniques to gain a high-level overview of the IP 'landscape', e.g. to look for trends and to identify where there might be some 'white space' in the market.
- **Competitor investigations:** We work to establish what your competitors are doing and what their IP strategy is: what technology are they filing patent applications for, where are they filing those applications, how successful is a competitor at getting patents granted, etc.
- **Data-driven insights:** We use data to uncover filing trends, identify key players in the market and their activities, and draw meaningful conclusions backed by that data.
- **Trade Mark Screening and Clearance/Freedom to Use Searching:** We offer trade mark screening solutions designed to assess a trade mark's viability and eliminate potential conflicts as quickly and easily as possible. We also offer a wide range of more in-depth search solutions/packages, giving access to the comprehensive information needed to assess the availability of a particular trade mark/brand name trade mark for use and registration.
- **Creative Name Generation and Brand Analysis:** We have access to tools that automate the process of brainstorming new names, whilst simultaneously analysing their suitability and availability for use, enabling you to make informed decisions about the potential usability of a proposed trade mark/brand name, quickly and efficiently.

Case Study

FTO advice – patent landscaping

Background

This client is a rapidly growing UK based pharmaceutical and medical device manufacturer. They specialise in bringing to market a range of quality, cost effective products that meet the challenges of modern day healthcare delivery.

Issue

The client was looking to launch a generic drug into the market. The main challenge faced by the client was that the patent landscape is often very difficult to assess. They needed expert advice on their freedom to operate so they contacted Dehns.

What we did

Following a detailed discussion on the exact requirements, Dehns commissioned a search to obtain a picture of the relevant patent landscape. The search yielded a large number of results, which would give the initial impression that there would be no freedom to operate with regard to the desired product due to the prevalence of existing patents already in this field. However, the Dehns team analysed the results to determine whether any of them would be a serious concern. Through our patent expertise, combined with scientific understanding of the relevant products, Dehns was able to determine the scope of protection afforded by the various patents and to assess the potential scope of protection that would be likely to result from key pending applications.

Outcome/result

Through this detailed analysis, expertise and understanding, Dehns was able to identify a niche in which the client would be able to operate without any key freedom to operate concerns. We were also able to advise on strategies that the client should avoid. Thus, Dehns was able to provide the client with a valuable report that could pave the way for the launch of their generic drug.



Investment & Capital Raising

Whether you still have a high burn rate or you are financially stable, one of the most important issues for start-ups is funding. When it's time to approach potential investors asking for investment, you will certainly need to have your IP portfolio in prime condition, as this is one of the first things they will want to look at, especially if technology is the main part of your business.

We can make sure that your IP portfolio is in the best possible shape for close examination and scrutiny by the investor or their advisors (which may include patent attorneys!).

Having worked on both sides of the fence, advising both investors and start-ups down the years, we know what investors are looking for in an IP portfolio and can help make sure your portfolio is investment ready.

We can also help with formal investment pitches and can support you when preparing the relevant sections in grant and funding applications. It is common for funding applications to fail because start-ups don't spend enough time on the IP section, or enough time getting their IP portfolio in order beforehand, and we can help try to mitigate the risk of this happening.

We can help with:

- **Portfolio Review:** We will work through the portfolio to ensure it's 'investment ready' (e.g. that robust patent or trade mark applications have been filed in the right place at the right time, and that proper precautions have been taken to ensure the investor will be comfortable to invest in you. If we identify any problem areas, we can help to resolve these where possible to improve your prospects.
- **Pitch Clinic:** Helping with pitches for capital raises (e.g. when applying for grants or approaching investors) to make sure the IP side is optimally covered to give you the best chance of securing the investment/funding, and to make sure you know the right answers for the questions that will likely be asked of you.



Case Study

Funding application support

Background

Dehns has been working with this particular University Technology Transfer Office for almost 10 years.

Issue

The TTO had submitted an application for funding for one of their projects but it was initially rejected because they had overlooked the importance of their intellectual property. The IP section of their funding application was deemed inadequate so they asked for our help.

What we did

Dehns offered valuable support by taking on the entire intellectual property section of the project to help demonstrate to the funding body that the client had taken the issues seriously.

We worked out a searching strategy to include patentability and appropriate territorial searches for freedom to operate. These were very different searches which required us to use our understanding of the technology and possible competing techniques.

Although we were working to a tight timescale and a set budget, once we had the results of the searches we were able to analyse them fully and prepare a report that was in a format they could use directly in their grant application. Our attorneys made sure the final report gave substantive and comprehensive advice but also considered the end user by making sure it was written for consideration by non-legal professionals.

Outcome/result

Dehns produced a report that was ready to be dropped into the client's final application, thereby taking the pressure off them and enabling them to concentrate on other sections. The client completely trusted us to take on this section of their funding document, and all in a short time frame.

"...the final report gave substantive and comprehensive advice..."



Information Control

While much focus is often given to ‘harder’ forms of IP protection such as patents, trade marks, and registered designs, an often overlooked area of IP lies in trade secrets and know-how. These ‘softer’ forms of IP can be just as valuable (and in some cases, more valuable) than registered rights. However, it is important not to be complacent about these forms of IP simply because there is no registration involved – the control of information can be key to protecting the IP at the heart of your business.

Information Control relates to the important issues around confidentiality: who knows what about your innovation; what you should and shouldn’t disclose; when and how you should disclose any information should you need to do so; etc.

Failure to control information in the correct way could have a major impact on your ability to legally obtain protection for your innovation, product, design or trade mark, opening up your exposure to copycats and knock-offs.

Our advice here relates to:

- Advising on trade secrets and proper marking of information, and information 'silo-ing'
- Non-disclosure Agreements (NDAs)



Case Study

Keeping things a trade secret

Background

A small UK-based start-up focussed on providing cloud-based analytics services contacted Dehns IP Consultant Sam Cleary about an idea that they had been working on in relation to a software product that used AI algorithms to improve their customer's sales and marketing processes.

Issue

The software product designed by the start-up had a lot of potential to disrupt the market as it was able to harness AI to analyse a number of large data sets in a very short amount of time and to provide recommendations regarding how marketing resources should be spent to obtain a maximum return-on-investment.

The client recognised that IP was at the heart of their business, but did not know how best to protect the idea and originally came to Dehns seeking help with filing a patent. The client's key concern was preventing copycat products from appearing in the market.

"Dehns advised that keeping the details of the algorithm as a trade secret was a more effective way of preventing copycats"

What we did

After Sam spent some time reviewing the overall structure of the system and the algorithms being used, he determined that while the idea had strong potential as a business plan, seeking patent protection would likely lead to a refusal on the grounds that the idea sought to solve a commercial business problem, rather than a technical one, where the AI algorithms being used were known from wider academia but had been optimised in a way particularly well-suited to analysing financial forecasts and customer behavioural data.

Sam advised that even if a patent were obtained, it would be difficult to detect infringement and ultimately enforce due to the algorithms being executed on a remote, cloud-based server.

In view of the high likelihood of refusal of any patent application and the amount of know-how behind the choice and optimisation of the AI algorithms providing a sufficiently high barrier to entry for competitors, Dehns advised that keeping the details of the algorithm as a trade secret was a more effective way of preventing copycats, particularly as any patent application detailing the algorithms would publish, regardless of whether grant could ultimately be secured.

Dehns advised the client regarding internal processes that should be put in place to ensure that key elements of the system would be recognised as trade secrets.

Outcome/result

Internal processes are now implemented within the client's business to specifically identify innovations regardless of whether patent protection will be sought. Once identified, a procedure outlined by Dehns is followed in order to properly identify and mark commercially sensitive work products as trade secrets, and to silo access to authorised personnel only.

Valuation



Knowing the value of your IP assets can help you understand your business better which will therefore help on a whole range of strategic business decisions and options. This includes:

Raising finance

- Whilst mainstream lenders haven't traditionally appreciated the value of IP, there are many other sources of finance that do, particularly equity funders of all shapes and sizes.
- The UK IPO's 'Banking on IP' report confirmed that business angels are always interested in the role of IP in freedom to operate and barriers to entry, as are venture capital companies.
- Specialist forms of lending like venture debt, pension-led funding and asset-based finance also take key intangible assets into account.
- Having a realistic idea of IP value provides an excellent 'conversation starter' for negotiation, especially for high growth companies who may be reinvesting profits and thereby understating their true worth.

Portfolio assessment

- Effective international IP protection strategies usually don't come cheap.
- Understandably, boards and shareholders have a strong interest in ensuring that IP rights represent value for money, but to assess this, they need to be able to make decisions based on future potential not just current performance.
- Valuation helps to show that properly protected IP is a value-producing asset, not a sunk cost.
- In addition, benchmarking value across different elements of a portfolio enables better-informed decisions to be made about prioritisation, where this is necessary.

Planning an exit

- Companies are generally acquired in order to gain control over their intangible assets, not their fixed ones.
- Also, where a company is acquired, international reporting standards require the buyer to take a view on what identifiable non-physical assets that business owns, and how much value should be placed on them.
- In both cases, value is very much on the minds of both seller and buyer.
- An impartial indication of the value that might reasonably be placed on these assets can prove to be a valuable negotiating tool.

We work with IP Valuation specialist companies who create a bespoke report for you and your business. Dehns can then discuss the report and its implications with you, and then guide and support you through any action you may want to take on the back of the report.

Case Study

IP portfolio valuation for internal purposes

Background

After many years of working with Dehns, a medium-sized Norwegian technology company requested a valuation of the entire IP portfolio to present to shareholders and to help inform decisions being made by the board.

Issue

After a decade of working alongside Dehns to build an impressive patent portfolio, it was decided that it was time to take stock of the financial value reflected by the client's IP. As the years had passed, some elements of the portfolio related to product lines that had been dropped, while other patents had stood the test of time and were still core to products many years after the initial patent filing.

In order to help gauge what the client had achieved with their IP spend, the board had requested a review of the portfolio to determine the value of the patents and to help guide decision-making and budgets in the near future.

"...the client was provided with a robust valuation for the entire IP portfolio..."

What we did

Dehns Partner Adrian Samuels and IP Consultant Sam Cleary agreed that in light of the patent portfolio having been developed by Dehns, it would be best if the valuation itself came from an independent third party. Using Dehns' extensive network of trusted partners with relevant expertise, Adrian and Sam worked closely with an expert in patent valuation that they knew would provide reliable valuation advice.

While the numerical valuation itself was carried out by an external consultant independent of Dehns, Adrian and Sam were a key part of the valuation process, helping the valuation expert to understand the large patent portfolio and how each of the patent families mapped to the client's various product lines.

Outcome/result

The client and Dehns were able to put together a team that each brought relevant expertise to help with the valuation project. The client was able to supply commercial information relating to sales history and forecast as well as details relating to the company's finances, while Dehns were able to provide insights into the relative value of each of the patent families and which technology groups they each belonged to.

Due to Dehns' network of experts and the unparalleled insights into the client's portfolio that the team had from working closely with the client for many years, the client was provided with a robust valuation for the entire IP portfolio that also gave an indication of the relative values of each of the patent families so that informed portfolio management decisions can be made.

Due Diligence

In terms of IP, due diligence activities generally involve an in-depth review of the IP owned, and/or used, by a company. It can therefore be a significant determining factor in whether to purchase or invest in a company, particularly one which has a significant number of IP assets at its disposal.

Dehns has considerable experience in carrying out due diligence exercises as part of potential investments or corporate transactions and can work with other professional advisors in devising comprehensive yet cost-effective strategies.

Examples of occasions when Dehns has been asked to undertake a due diligence exercise include:

- **Potential investors looking to invest in a start-up**
- **A start-up looking to impress an investor**
- **Merger and acquisition (M&A)**
- **Initial Public Offering (IPO)**
- **Licensing Agreement**



Case Study

Due Diligence prior to M&A transaction

Background

EQT is a leading alternative investments firm with approximately EUR 40 billion worth of assets under management across 20 active global funds. EQT funds have 141 portfolio companies with 159,000 employees, generating c. EUR 27 billion in total revenues.

In 2016, Dehns partner Matt Hall was contacted by Oslo law firm Thommessen on behalf of EQT when EQT was looking to acquire Norway based company AutoStore AS, who have developed a unique automated warehouse storage and retrieval system with, at the time, more than 130 installations in 22 countries.

Issue

EQT required Dehns to carry out due diligence on AutoStore's portfolio and address any issues surrounding the strength of the IP portfolio and Freedom to Operate over third party IP rights, as well as advising on a dispute involving UK online grocery retailer, Ocado. This was particularly challenging because of the sheer volume of work required for assessment of AutoStore's 27 patent families that it had at the time, as well as numerous patent families owned by Ocado and other third parties that required review in connection with FTO. It was crucial that Dehns made sure EQT fully understood the IP portfolio and any problems in relation to AutoStore's IP position.

What we did

Working alongside the Dehns engineering team and with Dehns partner Adam Taylor, Matt was able to mobilise multiple attorneys and trainees in order to arrange for Dehns to absorb a vast amount of work in a short space of time, so that EQT had all of the answers they needed to go ahead with the acquisition process within their required timeframe. Dehns worked closely with EQT and Thommessen throughout the whole process so that they had a full appreciation of the strengths and weaknesses of AutoStore's IP position, as well as potential future issues. The advice from Dehns was used to enhance EQT's assessment of the value of AutoStore based on the strength of their IP portfolio, which is vital for transactions of this nature.

Outcome/result

EQT was successful in acquiring AutoStore with a deal that fully satisfied both parties. AutoStore was impressed with the work carried out by Dehns in connection with the EQT transaction and they have continued to consult Matt in relation to on-going IP matters to augment the work done by AutoStore's Norwegian patent attorneys.

From the time of the acquisition in 2017 to June 2019, AutoStore experienced exponential growth, with quadrupled revenues, a 4.5 EBITDA increase and a doubling of the employee base. This growth was in part due to Autostore broadening its market through new R&D patentable innovations – assisted, of course, by Dehns.

In June 2019, just two and a half years after completing the acquisition, EQT sold Autostore for a significant amount (c.3-4 times) more than it paid in 2017.

Autostore continues to go from strength to strength: it now has more than 500 installations in over 30 countries, and its patent portfolio, under the continued guidance of Matt Hall, has now grown to over 150 patent families.



Case Study

Helping an SME win investment

Background

Dehns first started working with this renewable chemicals company in 2006. The company was founded in 2003 to develop and commercialise advanced microbial technology for the production of renewable chemicals and biofuels. Dehns Partner and patent attorney Philip Webber drafted and filed their first patent applications.

Issue

Several years later a potential investor was conducting due diligence in the company and wanted to review the IP held within the company to ascertain the strength and scope of the various patents and pending applications. The investor arranged a telephone conference with the company's founder and CEO, which was attended by the investor, the investor's patent attorney and Dehns attorney Philip Webber.

What we did

The investor's patent attorney performed in depth due diligence of the company's patent portfolio. At the meeting, Philip was able to defend the portfolio and reassured the investor's patent attorney and the investor that all of the issues raised were fully covered, and that the patents offered the best possible protection to the various technologies owned by the company.

Outcome/result

In this case, the investor was persuaded by the company's patents and technology, and subsequently over US\$40 million in total equity investment over a number of rounds from this and co-investors was provided.

"...the investor was persuaded by the strength of the patents..."

Licensing & Collaboration

In many collaborations or relationships, particularly those based on technology, the treatment and management of any IP is absolutely critical to success. Our detailed, practical knowledge of how IP works allows us to give invaluable support in the negotiation of licences and other agreements.

From an initial Non-Disclosure Agreement (NDA) through to Memoranda of Understanding (MoU), joint development agreements, licences and assignments, we can assist and advise at every step to ensure that your best interests are protected, not only when everything goes as planned, but also when the unexpected arises.

For smaller clients and start-ups, this often means dealing with the 'standard' agreements provided by larger companies, which may not always be appropriate to the circumstances, so we can help with your understanding of these and, where required, can suggest amendments so an agreement is more relevant to you and your business. In all circumstances, we will always advise you with your best interests and your commercial objectives as the primary drivers.

Key services include:

- **Helping with licence agreements or collaboration agreements**
- **Helping to find partners and licensees** (e.g. through landscaping techniques)
- **Assisting with obtaining licences from third parties**



Case Study

Advising a UK SME on a licence agreement with a US company

Background

Ketonex offers the custom design and synthesis of high performance engineering thermoplastics for additive layer manufacturing (ALM) techniques. All their products are based on the polyetherketone platform, and Ketonex provides services such as: polymer design, synthesis and characterisation, polymer processing, composites design and manufacture, and the applications and commercialisation of related technologies.

Dehns has worked with Ketonex for seven years when we first filed a patent application on their behalf back in 2009. Dehns has also helped Ketonex with four patent families based on high performance thermoplastics.

Issue

Ketonex had been approached by a US company who wanted to use the Ketonex technology that had been patented (though Dehns) in the US. The US company had drafted a terms of agreement for a licence to use the technology, and which had been sent to Ketonex.

Ketonex approached us to review the document and provide advice.

What we did

Once we received the draft licence agreement, it was reviewed by Dehns Senior Associate Sara de Bresser, who noticed that there were several issues relating to financial compensation, royalties and payments which were outside Dehns' core capabilities, so she instructed a solicitor's firm to deal with that aspect.

On the technical IP side, Sara advised on the scope of the technology, the geographic scope of where could and couldn't be covered by the Agreement, in addition to various activities that were covered under the US patent that would impact the Licence Agreement.

An unforeseen issue that Sara uncovered during this process was that Ketonex already had a prior agreement in place with another US company which allowed them exclusive use of certain aspects of the technology behind the process to create polymers.

As a result of this pre-existing agreement, Sara advised on the potential conflicts and issues that potentially offering two organisations exclusive rights would generate.

Having advised the client on these matters, including the addition of the financial elements of the agreement, Sara drafted and issued a revised version of the licence agreement.

Outcome/result

The draft was submitted by Ketonex to the US company in June 2016, and, having been accepted, the Licence Agreement is now in effect between the two companies.

Case Study

Developing a licencing strategy

Background

Camurus AB is a Swedish research-based pharmaceutical and biotechnology company specialising in the commercialisation of innovative specialty medicines for treating serious and chronic diseases, where there are clear medical needs and potential to significantly improve treatment.

Dehns Partner, Chris Goddard, began working with Camurus as a Dehns trainee in 2001. He has been Camurus' primary contact at Dehns since 2003 and their principal patent counsel for more than a decade. In nearly 20 years working together, Dehns has drafted and filed in excess of 400 granted and pending patents and patent applications internationally for Camurus.

Issue

Camurus focuses on developing technology for pharmaceutical administration systems. They develop projects in-house or in partnership with external organisations who wish to utilise Camurus technology to deliver their own active agents. Partnerships over the last 10 years have included agreements with Novartis Pharma, Rhythm pharmaceuticals and Braeburn pharmaceuticals. In each case, Camurus technology has been licensed or co-developed with the partner to deliver either an off-patent active agent or the partner's proprietary pharmaceutical compound.

Camurus' business model relies on multiple licensing agreements with multiple other parties, often with the same patents covering the core Camurus technology in several separate agreements.

As a result, they need to make sure that their intellectual property is protected to uphold the value of the agreement and that both the IP and the agreements are structured in a way that allows for multiple licensing with minimal conflict.

What we did

Dehns Partner, Chris Goddard, worked closely with Camurus to make sure they had an established portfolio that would support each licensing deal. This involved developing a licensing and patent prosecution strategy that would help them maintain control of their technology in all agreements while providing their partners with the protection and control they required from a joint development.

Camurus worked with Dehns and with their business legal advisors to reach a sequence of deals that could satisfy both Camurus and their partners. This is a particularly important challenge for an organisation which relies on being able to license its technology to more than one company.

Outcome/result

Dehns played a vital role in working with Camurus to establish the strategy and portfolio to support their licensing deals without sacrificing control of the company's key technological assets. The innovative work of Camurus scientists has benefited patients by improving compliance and ease of use in key therapeutic areas, with one joint development product now on sale as an EMA-approved treatment for opioid dependence and further products in the pipeline.

Workshops & Packages

**“We really enjoyed the workshop
and are very much looking forward
to hearing your thoughts.”**

(Client following a recent workshop, 2020)



One day workshop

Dehns Consulting offers a one-day workshop package in which we will work with you to gain an understanding of your current IP and to help you plan for the future. The content of the workshop can be tailored according to need, but topics generally covered include:

- Discussion of your products and services and business goals to identify your innovations and brands and generation of your IP Roadmap
- Interactive session to discuss current ideas in the pipeline to identify and capture more IP
- Preliminary consideration of 'Freedom to Operate' and 'Freedom to Use' risks
- Collaborative planning of an IP strategy for the future
- You will be presented with a report after the workshop that summarises our findings and is suitable for presenting to potential investors

IP 101

Dehns Consultancy also offers a half-day 'IP 101' package, which serves as an introduction to IP for managers, the R&D team, and/or the marketing team, as well as other members of your team that may benefit from learning more about IP. This educational talk provides a jargon-free, high-level introduction to important IP concepts of which all stakeholders should be aware. The workshop includes interactive elements to help participants get to grips with the various IP elements that they should be thinking about when going about their day jobs.

Topics covered include:

- **What is IP?**
- **Patents, Trade Marks, Designs, and Copyright**
- **Trade Secrets and Know-how**
- **IP Strategy considerations**
- **Invention harvesting and capture techniques**

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About Dehns

Dehns is a leading European firm of specialist patent and trade mark attorneys with more than 220 people working across six main offices (London, Munich, Oxford, Brighton, Manchester and Bristol).

Currently in our centenary year, and top tier ranked by all leading IP and legal directories, Dehns provides a comprehensive range of IP services including: patentability assessments, drafting, filing and prosecution, licencing agreements, advice and support on Oppositions and Appeals, Freedom to Operate opinions and IP portfolio strategy advice.

We have an outstanding team of 114 patent professionals. 83 of these specialise in a comprehensive range of engineering fields, including: physical sciences, photonics, nanotechnology, medical devices, mass spectrometry, electronics, AI and software.

We also have a team of 31 patent professionals who specialise in the biotechnology, life science, pharmaceutical, chemistry and biochemistry sectors – over 40% of this team have a PhD, highlighting our detailed technical expertise and knowledge in a wide range of fields.

To highlight the strength of our patent business, Dehns has filed the most number of patent applications of any UK firm in each of the last five years and has filed the most European Patent Applications of any European firm in two out of the last four years (2016 and 2019).

Dehns also has a highly successful, top tier ranked trade mark practice, consisting of 13 qualified Trade Mark Attorneys, providing a full range of trade mark services and advice to organisations in numerous sectors.

As evidenced by our consistent top-tier rankings over the years, and the longevity of many of our clients (some have been with us for over 50 years), Dehns continues to provide the very best quality advice and service delivery, while at the same time being very conscious of clients' budgetary and time constraints.

Please contact us to discuss how Dehns can help and support you through any IP matters, regardless of where you are in your business and IP lifecycle.



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