

**Memorandum of Understanding No. 2018/0454 between
the Licensing Executives Society International, Inc.
and the European Patent Office
on Bilateral Co-operation**

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The Licensing Executives Society International, Inc. ("LES") and the European Patent Office ("EPO"), hereinafter referred to as "the Signatories",

RECOGNISING the opportunities and the importance of the collaboration related to outreach and educational programmes, as well as exchange of information in the areas of patents and related rights, technology transfer and commercialisation of intellectual property ("IP");

CONSIDERING the value and importance of Industrial Property (IP) in general and patents in particular for the development of the economy and the exchange of technology;

HAVE REACHED THE FOLLOWING UNDERSTANDING:

1. Identity and intent of the Signatories

1.1 The EPO is the executive organ of the European Patent Organisation, which is a non-for-profit public intergovernmental organisation, acting in accordance with the European Patent Convention (or "EPC"), the international treaty founding the European patent system (available at <http://www.epo.org/law-practice/legal-texts/epc.html>). EPC-related Protocols form an integral part of the EPC, in particular the Protocol on Privileges and Immunities of 5 October 1973 (or "PPI", as available at the same web address). The European Patent Organisation is an international organisation. It is *not* an NGO (Non-Governmental Organisation). As a consequence of the EPC and the PPI (Article 3), the European Patent Organisation, including its organs, has immunity from jurisdiction and execution within the scope of its official activities in the 38 states that are its members (list available at <http://www.epo.org/about-us/foundation/member-states.html>), and has neither registration numbers (main or secondary), nor VAT number. The EPO carries out the core task to grant European patents through search and examination of the European patent applications together with co-operation activities, as detailed in the EPC and implementing regulations.

1.2 LESI is a non-for-profit, non-stock corporation whose State of Incorporation is, in the United States of America, the State of Delaware. It is an umbrella organisation that consists of organisations of natural persons for one or more countries ("Member Societies"), each Member Society being known as "Licensing Executives Society" or "LES" with appropriate further geographic designation. At the time of signing this Memorandum of Understanding ("MoU"), LESI consists of 33 national and regional Member Societies worldwide.

The EPO is not a LES Member Society and its signing of the present MoU expresses no consent or intent to become a LES Member Society.

In accordance with LESI By-Laws, LESI purposes are:

- (a) To function as a non-for-profit professional and educational society encouraging high standards and ethics among persons engaged in business dealings with and related to IP, including domestic and

international licensing of IP rights and transfer of technology;

- (b) To assist the individual members of Member Societies in improving their skills and techniques through self-education, conduct of special studies and research, sponsorship of educational meetings, publication of articles, reports, statistics and other materials, and exchange of ideas related to the economic significance and importance of IP and to business dealings with and related to IP, including domestic and international licensing of IP rights and transfer of technology;
- (c) To inform the public, the business community and governmental bodies concerning the economic significance and importance of IP and of business dealings with and related to IP, including domestic and international licensing of IP rights and transfer of technology and the high professional standards of those engaged in such business;
- (d) To function as a research organisation and assist in furthering knowledge of IP and of business dealings with and related to IP, including domestic and international licensing of IP rights and transfer of technology with a view to effecting its optimum employment on a worldwide basis;
- (e) To assist its Member Societies in carrying out purposes similar to the foregoing and to co-ordinate their activities with those of other Member Societies;
- (f) To arbitrate or assist in the settlement of disputes, if any, among its Member Societies;
- (g) To promote new Member Societies in any country or countries not already covered by an existing Member Society.

1.3 None of the Signatories has the capacity to enter into legally binding commitments. With the signature of the present MoU, each of the Signatories seeks to co-operate with the other Signatory, within the limits of their respective competences and scopes of activities, in the areas of co-operation activities outlined below, in a way where both the present MoU (or, as a synonym, "this MoU") and its implementation and/or interpretation will be governed in all aspects by the principles of good will and good faith. The Signatories understand that, hereafter, the term "will" (as a verb) is used to synonymously mean "intend to" or "endeavour to" or "strive to" for the purposes of implementing and/or interpreting this MoU.

1.4 The Signatories intend to contribute to Europe's innovation capacity and enhance the efficiency and quality of the global IP system, by improving the expertise and skills of a wider community of users of the European patent system and global IP system, as well as to support innovation by promoting and participating in education and training projects in the areas of co-operation outlined below. The Signatories are willing to explore new modalities of co-operation and enhance joint efforts to respond to IP emerging issues towards long-term sustainable goals for the benefit of IP based innovation.

2. Areas of co-operation

2.1 Joint training programmes, meetings, seminars and events

- (a) The Signatories will co-operate so as to attract a more diverse range of participants in the events they will jointly organise. They will strive to increase participation by small- and medium-sized enterprises (SMEs), industry representatives, technology transfer experts, publicly-funded research organisations, IP advisors, IP offices and government policy makers. The Signatories will also strive to enhance the visibility of IP and its protection, transfer and commercialisation, foster networking among interested stakeholders, adapt the entry conditions so as to increase or enlarge the participation from emerging countries' representatives, and create favourable conditions, where applicable, for the protection, transfer and best use of technology.
- (b) Concerning the business of IP in general and IP protection, transfer and commercialisation in particular, the Signatories will share their respectively developed IP training materials and tools ("IP Training Materials") under the conditions that they will set out, so as to facilitate the use and distribution of such IP Materials during their respective training courses, meetings, and events.

- (c) The Signatories understand that, depending on the prior EPO's assessment and request on an *ad hoc* basis, LESI will participate in the development of training and education programmes relating to technology protection, transfer, and commercialisation, and in the editing of IP Training Materials developed by the EPO, including their update and improvement. The resulting IP Training Materials will afterwards not be limited in their use or reuse by the Signatories.
- (d) The Signatories will periodically exchange information between them about technology protection, transfer and commercialisation courses as well as the related events they respectively organise.
- (e) The Signatories will exchange information between them on all relevant meetings and training activities, either organised by LESI Member Societies in EPO member states and beyond, or organised by the EPO, so as to both enable the EPO to inform stakeholders interested in participating in LESI Member Society meetings, and provide LESI the opportunity to participate in such meetings and to propose speakers.
- (f) The Signatories understand that:
- LESI will share information with the EPO on LESI speakers of relevant national and international meetings, including -when permissible- the contact details, so as to further develop the knowledge of the network of professional contributors to training activities;
 - the EPO will -as far as possible- support LESI in finding high level speakers for international meetings relating to the areas of co-operation outlined in this MoU.
- (g) The Signatories understand that they may jointly organise or jointly sponsor meetings focused on technology protection, transfer and commercialisation and patent related issues.

2.2 Collaboration for the achievement of sustainable goals

(a) Policy and emerging IP issues:

The Signatories will exchange information regarding the business and economic development impact of emerging or contemplated policies and issues. The Signatories understand that, when appropriate, LESI will provide input to the EPO on these issues.

(b) Networking in the area of IP business:

The Signatories will set up a mechanism to exchange information on their respective networks in order to promote the development of IP in EPO member states and beyond, in general and on a project-by-project basis.

(c) Training of licensing professionals:

The Signatories will collaborate in identifying and promoting training programmes for the development of a network of trained certified professionals, particularly in the emerging and developing countries. The Signatories will jointly work with Certified Licensing Professionals, Inc. (CLP) and other similar organisations worldwide.

(d) Collaboration on joint publications:

The Signatories will collaborate on a periodic basis to publish a joint issue of *les Nouvelles* (the journal of LESI published quarterly and is designed to further the knowledge in licensing and protecting IP) or other such joint project regarding IP, its protection, transfer and commercialisation and related goals (e.g. SME case studies and training material). LESI's contribution will generally focus on the economic and business aspects. The Signatories understand that prior written arrangements will be necessary to identify, distribute and co-ordinate the respective tasks and contributions.

3. Work plans

The Signatories will jointly draw up specific work plans setting out specific actions, plan of implementation and aspects of their collaboration in the areas of co-operation outlined in point 2 of this MoU, detailing the joint activities planned for the calendar year in question with a forecast for the following calendar year.

(a) The Signatories understand that each work plan is expected to include as far as possible:

- (i) clear operational objectives for each of the foreseen co-operation activities;
- (ii) specific analysis/breakdown and definition of each of the foreseen co-operation activities;
- (iii) target group definition including the expertise level expected from participants and contributors;
- (iv) specifications regarding the methods for implementation, scope, administration, respective costs and expenditures, including their distribution, participation fees if applicable, estimates and proposed assignment of human, financial, information and communication technology ("ICT") and logistical resources for the implementation of the respective co-operation activities;
- (v) time schedule with delivery dates and places;
- (vi) specification of the lead responsibilities;
- (vii) specification of the accepted room for flexibility for *ad hoc* collaborations with added value;
- (viii) monitoring foreseen;
- (ix) evaluation criteria and methods enabling to obtain feedback on the impact of each of the co-operation activities;
- (x) any other information they deem necessary.

(b) The Signatories understand that each work plan is expected to implement and concretize the Signatories' intent in the co-operation areas set out in points 1 and 2 above.

4. Co-ordination and monitoring

- 4.1 Each Signatory appoints a co-ordinator or, as a synonym, a contact person, who will act as the primary interface for all communications between the Signatories and will co-ordinate any bilateral exchange and/or activity of planning, implementation, monitoring and evaluation of the work plans' items listed in point 3 above.
- 4.2 As such contact persons, LESI appoints its President (president@lesi.org); the EPO appoints Principal Director European and International Co-operation, or his representative, and the Principal Director Patent Information - European Patent Academy, or his representative, IP Programme - Innovation Support (innovationsupport@epo.org).
- 4.3 The Signatories will hold annual information and planning meetings for exchange and monitoring purposes. LESI and the EPO will mutually invite each other as an observer to their respective planning and/or management meetings as well as working group meetings on an *ad hoc* basis.

5. Financial conditions

The Signatories understand that the implementation of each co-operation activity under this MoU will remain subject to the availability of the resources necessary and itemised in the applicable work plan, in compliance with point 3 above. The term "resources" include -without being limited to- budgetary resources, ICT resources, human resources or staff time and any other necessary means or resources of use.

6. Final provisions

- (a) The Signatories understand that this MoU supersedes any previous verbal and/or written arrangements or conditions, if any, between them.
- (b) This MoU will take effect on the date of its last signature by the Signatories and will remain in effect for a period of 5 (five) years. The Signatories understand that, subject to a prior review and evaluation of the implementation results of this MoU and upon their mutual written consent, they may renew this MoU for a further period to be then determined.
- (c) The Signatories understand that they may modify this MoU by mutual written consent, in an addendum to this MoU or an exchange of letters, specifying the starting date of the amendment(s).
- (d) The Signatories understand that they may not use work plan(s) to amend this MoU. In the event of a discrepancy between provisions of the work plan(s) and provisions of the present MoU, the latter will prevail.
- (e) The Signatories understand that their respective staff members assigned to co-operation activities within the framework of this MoU will remain under their respective direction and authority and that no new or additional employment relationship will be created between their respective staff members and the other Signatory.
- (f) Nothing in or relating to this MoU may be deemed a waiver, express or implied, of any of the privileges and immunities of the European Patent Organisation, including its organs, pursuant to the international constituent acts of this organisation (the EPC referred to in point 1 above).
- (g) The Signatories understand that if a decision of the Administrative Council of the European Patent Organisation and/or its advisory bodies contains provisions whose impact on this MoU needs to be established, the EPO will assess this impact and propose, if necessary and after consulting LESI, modifications to this MoU. The Signatories understand that if no consensus is reached on such modifications within 3 (three) months, this MoU will then be automatically discontinued and point 6 (j) below will remain applicable.
- (h) Either Signatory may discontinue this MoU for convenience at any time by communicating at least a 2 (two) months' written notice to the other Signatory and applying point 6 (j) below.
- (i) Any difference or divergence of views of the Signatories concerning the implementation and/or interpretation of this MoU will be the subject of mutual consultations fostering a climate conducive to a mutually satisfactory understanding. In case no such understanding is reached at the end of a 3 (three) months' period of mutual consultations, either the EPO or LESI may record in writing an irreconcilable difference or divergence of views between the Signatories in the implementation and/or interpretation of this MoU, and consequently, discontinue its respective part of the MoU implementation.
- (j) The Signatories understand that, to enable a smooth discontinuation, they may, at the time they discontinue the MoU implementation, consent both in writing to complete some specific co-operation activities, as initially planned in the applicable work plan set out in point 3 above, before full discontinuation. Such limited continuation of co-operation activities and the details relating thereto may not be presumed or implied.

Signed in two originals in Miami, on 26 January 2019, in the English language.

For the European Patent Office

For the Licensing Executives Society International, Inc.

António Campinos
President of the European Patent Office

François Painchaud
President of the Licensing Executives Society
International, Inc.

