

PD CEN/TS 16555-4:2014



BSI Standards Publication

Innovation management

Part 4: Intellectual property management

bsi.

...making excellence a habit.™

National foreword

This Published Document is the UK implementation of CEN/TS 16555-4:2014.

The UK participation in its preparation was entrusted to Technical Committee IMS/1, Innovation management.

A list of organizations represented on this committee can be obtained on request to its secretary.

This publication does not purport to include all the necessary provisions of a contract. Users are responsible for its correct application.

© The British Standards Institution 2015.

Published by BSI Standards Limited 2015

ISBN 978 0 580 86326 4

ICS 03.100.40; 03.100.50; 03.140

Compliance with a British Standard cannot confer immunity from legal obligations.

This Published Document was published under the authority of the Standards Policy and Strategy Committee on 31 January 2015.

Amendments/corrigenda issued since publication

| Date | Text affected |
|-------------|----------------------|
|-------------|----------------------|

ICS 03.100.40; 03.100.50; 03.140

English Version

Innovation management - Part 4: Intellectual property management

Management de l'innovation - Partie 4 : Management de la propriété intellectuelle

Innovationsmanagement - Teil 4: Management des geistigen Eigentums

This Technical Specification (CEN/TS) was approved by CEN on 27 October 2014 for provisional application.

The period of validity of this CEN/TS is limited initially to three years. After two years the members of CEN will be requested to submit their comments, particularly on the question whether the CEN/TS can be converted into a European Standard.

CEN members are required to announce the existence of this CEN/TS in the same way as for an EN and to make the CEN/TS available promptly at national level in an appropriate form. It is permissible to keep conflicting national standards in force (in parallel to the CEN/TS) until the final decision about the possible conversion of the CEN/TS into an EN is reached.

CEN members are the national standards bodies of Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, Former Yugoslav Republic of Macedonia, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Norway, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey and United Kingdom.



EUROPEAN COMMITTEE FOR STANDARDIZATION
COMITÉ EUROPÉEN DE NORMALISATION
EUROPÄISCHES KOMITEE FÜR NORMUNG

CEN-CENELEC Management Centre: Avenue Marnix 17, B-1000 Brussels

| Contents | Page |
|--|-------------|
| Foreword | 3 |
| Introduction | 4 |
| 1 Scope | 5 |
| 2 Normative references | 5 |
| 3 Terms and definitions | 5 |
| 4 Concept and purpose of intellectual property management | 6 |
| 5 The intellectual property strategy | 8 |
| 5.1 The role of top management..... | 8 |
| 5.2 Interactions with various functions | 9 |
| 5.3 Competences and skills requirements..... | 10 |
| 5.4 Budget and cost control | 11 |
| 5.5 Communication..... | 11 |
| 6 Implementation of the IP strategy | 12 |
| 6.1 Traceability | 12 |
| 6.2 IP decision making | 12 |
| 6.3 Strategic intelligence and risk management | 13 |
| 6.4 IPR portfolio development, management and exploitation | 14 |
| 6.4.1 Structuring IPR portfolio..... | 14 |
| 6.4.2 Analysis of the potential IPR | 14 |
| 6.4.3 Intellectual property exploitation | 15 |
| 6.4.4 Acquisition, sale, concession and licensing (-in and -out) of third parties IP rights | 16 |
| Annex A (informative) Authenticated documentation to record IP | 17 |
| Annex B (informative) Innovation and invention disclosure | 18 |
| Annex C (normative) Methods and criteria for the assessment of IP rights | 19 |
| C.1 Objectives and principles | 19 |
| C.2 Strategic criteria..... | 20 |
| C.3 Qualitative criteria..... | 22 |
| C.4 Quantitative criteria | 23 |
| Annex D (informative) IP and standardization | 26 |
| D.1 General..... | 26 |
| D.2 Various strategies of the organization relayed by intellectual property..... | 27 |
| Annex E (informative) Intellectual property management in a collaborative environment | 28 |
| E.1 Introduction | 28 |
| E.2 Definition | 28 |
| E.3 Scope of collaborative contexts..... | 29 |
| E.4 Different types of collaboration in the innovation process..... | 29 |
| E.5 Legal..... | 30 |
| E.6 Collaboration to create; impact of financing sources on IP ownership, assignment | 31 |
| E.7 General best practices to comply with..... | 31 |
| Bibliography | 33 |

Foreword

This document (CEN/TS 16555-4:2014) has been prepared by Technical Committee CEN/TC 389 “Innovation Management”, the secretariat of which is held by AENOR.

Attention is drawn to the possibility that some of the elements of this document may be the subject of patent rights. CEN [and/or CENELEC] shall not be held responsible for identifying any or all such patent rights.

This document is not intended for the purpose of certification.

The CEN/TS 16555 series consists of the following parts with the general title *Innovation management*:

- *Part 1: Innovation Management System;*
- *Part 2: Strategic intelligence management;*
- *Part 3: Innovation thinking;*
- *Part 4: Intellectual property management;*
- *Part 5: Collaboration management;*
- *Part 6: Creativity management;*
- *Part 7: Innovation management assessment.*

Part 7 is in preparation.

According to the CEN-CENELEC Internal Regulations, the national standards organizations of the following countries are bound to announce this Technical Specification: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, Former Yugoslav Republic of Macedonia, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Norway, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey and the United Kingdom.

Introduction

This Technical Specification CEN/TS 16555-4 is linked to CEN/TS 16555-1:2013 (especially to CEN/TS 16555-1:2013, 11.4).

The effective management of intellectual property, developed as a lever and a tool to support the process of innovation, is a necessary prerequisite for organizations' development, growth and protection of their competitiveness. Intellectual property management thus supports, gives rise to and enhances outcomes of the innovation process.

Intellectual property management includes observation and analysis of third parties' intellectual property, for instance, for the purpose of achieving freedom to operate for an organization's products.

In order to adequately address intellectual property management, the organization should consider the following:

- intellectual property strategy, as an integral part of the organization's business strategy;
- intellectual property strategy, as an integral part of innovation management strategy;
- the safeguarding of the potential intellectual property throughout the entire organization;
- methods used to manage and use intellectual property as a support of business strategy, for example traceability, protection);
- applicable legislation in the territories or regions under consideration;
- costs of obtaining and maintaining intellectual property and possible enforcement costs which could ensue;
- differences in the contribution of various public authorities to acquiring IP rights and promoting practices throughout the world;
- methods of protecting 'know-how', where appropriate.

In this Technical Specification, the terms intellectual property and intellectual property rights are precisely defined, and are given a broad and general definition in Clause 3.

1 Scope

This Technical Specification provides guidance to assist an organization to identify, capture, and safeguard intellectual property, in order to:

- provide organizations with an overview of the fundamental principles of intellectual property management, in the context of the innovation process;
- promote best practices in intellectual property matters that result in efficiently acquiring intellectual property, while increasing the organizations' ability to effectively address intellectual property owned by third parties.

This Technical Specification is applicable to all types of organization, including the public sector. Special consideration has been given to the needs of SMEs.

2 Normative references

Not applicable.

3 Terms and definitions

For the purposes of this document, the following terms and definitions apply.

3.1

background

pre-existing IP that a party brings to a collaborative joint venture

3.2

foreground

intellectual property and/or intellectual property rights that are collectively generated by the one or more of parties within a collaborative joint venture

3.3

freedom to operate

state wherein a product or service is not exposed to IP other than own IPR or licensed-in IPR

3.4

intellectual property (IP)

part of intellectual assets owned by a person or organization as a result of creations of the mind or the intellect

Note 1 to entry: Intellectual property can be either registered (i.e. statutory) or unregistered (i.e. non statutory or owned by default without any specific registration action).

3.5

intellectual property rights (IPR)

legally protected intellectual property which can be registered and unregistered

3.6

side ground

IP that may be generated by a party during the period of the collaborative joint venture, but specifically excluded from the scope of the joint venture