KEY LEARNINGS 1-TT & TTOs

• Importance of Impact from public research - return on investment through technology transfer to industry.

• IP management key to facilitating TT.

• What IP and technology transfer is, and why protect IP

• Registrable v automatic IPR - Comparison and contrast

• Capturing novel IP - What problem does the invention solve and key advantages over prior art

• TTO policies re ownership of IP, conflict of interest, licence income share.. and procedures for researchers.

• IP protection and licensing of RPO IP managed by TTOs to ensure consistent transparent equitable approach
KEY LEARNING 2-PATENTING

- Patenting criteria—novelty, inventive step and industrial application
- Utility patents—technical effect. Novel/improved products/processes, new use of known compound, methods of use
- Disclosure (enabling) prior to patent filing may invalidate a patent
- Inventors contribution is not the same as authorship rights on publication, important to name all inventors
- Patent must disclose enough to make reproducible, and claims outline what the invention covers (boundary/scope)
- No such thing as worldwide patent
- Patenting prosecution lengthy (> 5 years), expensive and not automatic (and can be opposed and revoked after grant). Published after 18 month, national phase 30 month..
- Only patent granted can be infringed—enforce rights
- Sometimes a technology may be patentable but decision made not to file patent (cost, commercial relevance, processes hard to enforce, disclosure, prior art)
- Aim to licence IP as early as possible and licensees to take over payments
Key learnings 4-IDFs

- Importance of capturing novel IP, (IDFs) and engaging with the TTO
- Need sufficient information to understand technical effect, advantage over prior art and problem it is solving or market gap identified
- Detail re inventors and their contribution critical to name all inventors making true inventive contribution
- Detail re funding source and any commitment to other parties,
- Stage of development and continued funding
- Information an any discussions with industry to date
- Commitment/level of engagement of lead researcher is key
- Outcome-decision on whether to file a patent or not, (and if so what territories), understanding of the market, what further work is required/funding to secure to develop further/validate, and what companies to target for licensing if commercially relevant, better
- Case studies from Teagac TTO presented with various outcomes
KEY LEARNINGS 3 – OTHER IPR

• Copyright only for original materials (works of authorship) and not the content-incl software.

• Trademarks-Word, name, symbol or device to identify or distinguish a good or product from those manufactured or provided by others.

• Database rights, related to copyright, lasts 15 years
• PVR-New varieties -novel, uniform, stable and distinct-relates to reproducible material only eg seeds

• Trade secrets-not typical of universities , RPOs

• Commercialisation through 1. assignment of IP, 2. Licensing of IP, and 3 spin out formation
KEY LEARNINGS 5-ENGAGEMENTS

• MTAs And NDAs facilitate engagements with outside parties
• Collaborations/contract research and consultancy important engagements with industry
• Assignment /licensing of IP to industry, lead to financial benefits to RPO (royalty /licence income)
• Spin out formation-equity ownership by RPO
• All such agreements negotiated through TTO and signed only by authorised signatory
Final conclusions

• IP protection not black and white!
• Culture changes in researchers views needed, to develop innovation culture in a university/research institute
• Support from university, incl. incentivisations and policies important
• Timing critical issue when filing patents-often we learn more from previous cases
• Input from researchers critical in success stories
• Importance in registering background IP and agreeing IP ownership and access rights esp in collaborations/joint IP developments with industry
• IP can have spillover benefits other than licence income (reputation, collaborations, publicity, credibility, researcher satisfaction on involvement in technology transfer)