



## USING IP TO SUCCEED IN TECH TRANSFER

Transforming research carried out in institutions such as universities and hospitals into commercial products and services can be a long and complex journey, but the results can provide significant income for the institutions involved, as well as improving the lives and prosperity of the public.

IP often plays a central role in the success or failure of a project. It is crucially important to adopt the right strategies, both in terms of how an IP portfolio is built up and how it is used.

### **Making Your Portfolio Attractive for Investors and Licensees**

Potential investors and licensees will look carefully at your IP portfolio, so it is vital to make sure that it covers the key areas of technology and stands up to detailed scrutiny. Presentational aspects should be considered in addition to substantive issues. Patent applications for example can be written in ways which emphasise the commercial potential of the invention and/or the potential for wide patent protection. Patent prosecution strategies can be adapted to maximise the value of your portfolio at the time you wish to sell or license. For example, stronger applications, or selected inventions within applications, can be accelerated through to grant. Prosecution of broader, more speculative applications can be slowed down.

### **Managing Your Portfolio and Keeping Costs Under Control**

The cost of prosecuting and maintaining patent applications and patents can become expensive as a portfolio grows, particularly where protection is required in a large number of countries. Steps can be taken to keep these costs under control. For example, it is highly beneficial simply to make sure that your portfolio is reviewed regularly to identify applications, patents or jurisdictions that are no longer of interest. Strategic analyses can also be used to select only the jurisdictions that will have the most commercial impact. This may not simply be the jurisdictions that have the largest economies, but might include countries which tend to host distribution centres or large ports, or which have fast and efficient court systems.

Alternatives to patents, such as registered designs, can be considered for certain technologies.

### **Educating and Supporting Researchers**

Scientists and engineers need to know how their work can be protected and the basic legal principles that apply. They will probably be familiar with patents, but registered designs, copyright and trade marks, as well as the law governing trade secrets and confidentiality, may also be relevant.

It is important that inventors recognise that ideas need to be kept secret before a patent or registered design application is made. They need to know that even the most minor disclosures can be enough to preclude patent protection. Inventors should also have some knowledge of the range of technologies that can be protected, which will often include technologies that they might not think are eligible, such as computer software and mathematical algorithms (where a real world technical problem is being addressed).

From a day-to-day perspective, it is desirable to have a system in place that makes it easy for researchers to make the relevant people (e.g. technology transfer managers and/or patent attorneys) aware when ideas of potential commercial significance are made.

It is also desirable that when technical documents such as patent applications need to be prepared, this is done in collaboration with legal teams that have similar technical backgrounds to the inventors, preferably including people having research experience themselves and/or significant experience of working in the Tech Transfer sector. This ensures that inventions are understood properly and that the drafting process can proceed with minimal disruption for the inventors.

### **Choosing Which Inventions to Protect and How**

Inventors can be taught to identify potentially important ideas but it is still necessary to make decisions about which inventions to protect and how. Part of this decision process will depend on the commercial potential of the idea. However there are also technical and strategic considerations.

For example, it is often the case that an envisaged product involves several potentially novel technologies, but funding or time does not allow each invention to be covered in a separate patent application. In this scenario multiple inventions can sometimes be filed together with a view to postponing the decision of which to pursue further. In other situations it may be appropriate to select only a subset of the inventions for patent protection. Factors to consider in any such selection might include which inventions are likely to lead to patents that are most difficult to work around or which are otherwise strategically useful, and which inventions might lead to patents which are likely to be most resistant to attack.

Some inventions are crucially important but are not detectable in the product being sold. This may mean that it would be difficult to identify infringers and difficult to enforce a patent directed to such an invention. In this situation it might be more

commercially appropriate to keep the technology secret than to file a patent application. This however can be a significant challenge in an academic environment where pressure to publish is intense.

In other situations a patent will be very useful. Patents can dissuade potential competitors from working in the field of your invention and/or can provide valuable income from licensing. Patents can provide a useful and public documentation of the technology that your organisation owns, attracting and reassuring potential investors.

#### **Avoiding Ownership Problems (and Related Costs)**

Ownership of IP rights can be complex, particularly in the academic environment where inventors may be employed and/or funded by more than one institution and/or funding body. It is important to establish the facts early and, if appropriate, have parties sign relevant agreements (e.g. assignments or confirmatory assignments) while they are both willing and available to sign. These steps can greatly reduce the chance of errors in application documents, which can be costly to remedy if discovered at a late stage, and can avoid potentially damaging disagreements about ownership arising downstream.

We would be happy to provide further advice on any of the above, including giving talks or running workshops for inventors or technology transfer project managers.

18 September 2013

© J A Kemp

14 South Square  
Gray's Inn  
London WC1R 5JJ  
UK

+ 44 20 3077 8600  
[www.jakemp.com](http://www.jakemp.com)