IP Management at Universities

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1. Getting started

University-Industry

Intellectual Property

Innovation

Transfer

Innovation

Knowledge

1. Getting started

Intellectual Property (IP)

'IP refers to creations of the mind'

WIPO WORLD INTELLECTUAL PROPERTY ORGANIZATION

IP rights: Heterogeneous group of rights whose common aspect: compensation of creative, inventive or economic efforts made.

Industrial property? Intellectual property?... In order to secure uniformity at the international level: Intellectual Property can be used as a unitary concept.

1. Getting started

Technology Transfer (TT)

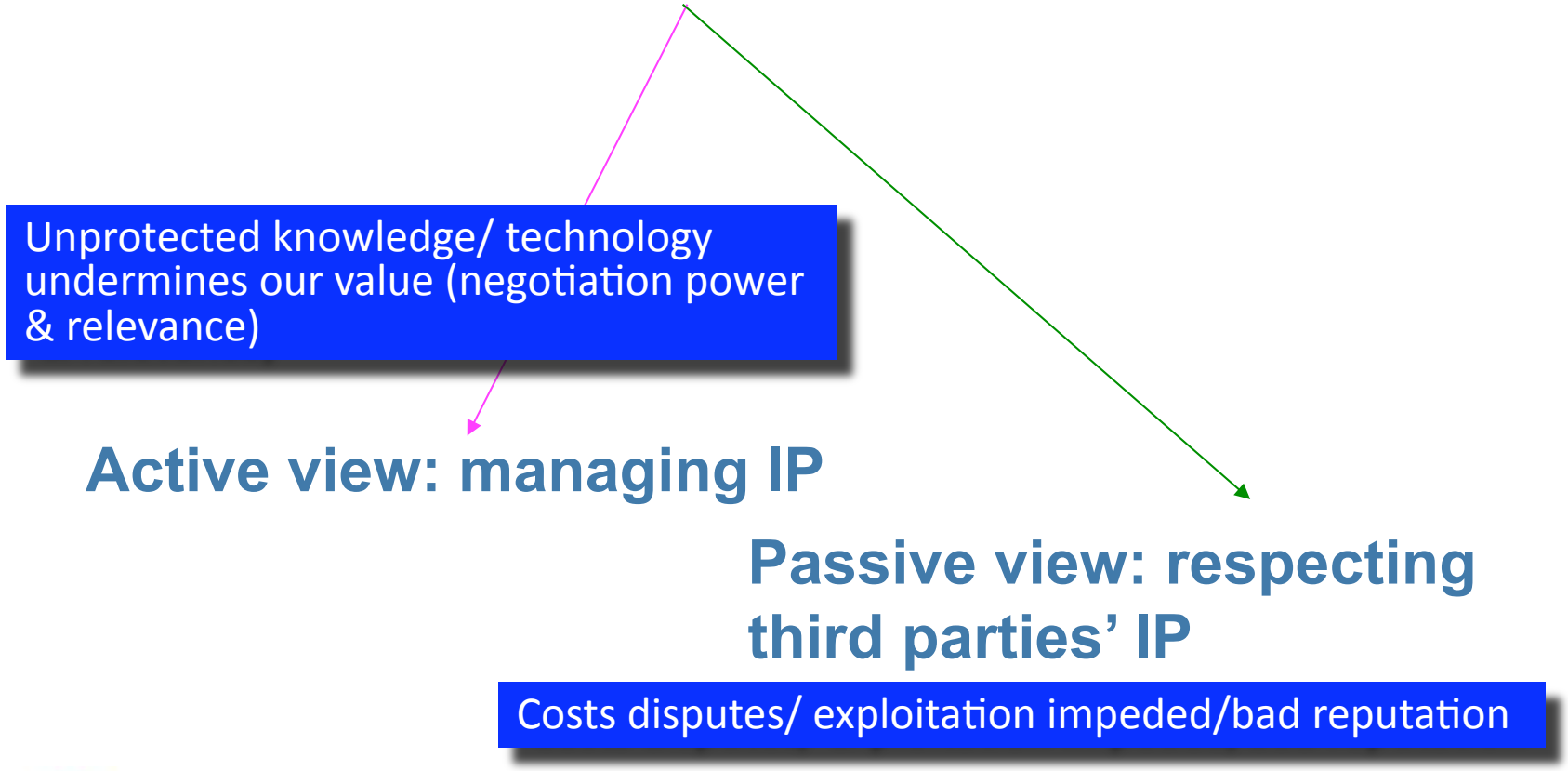
Primarily concerned with 'identifying, protecting, exploiting and defending IP' – **IP management** ('Metrics for KT from PROs in Europe', Report from the COM Expert Group on KT Metrics 2009, and 'Turning Science into Business', OECD study 2003)

Knowledge Transfer (KT)

'KT involves the processes for **capturing, collecting and sharing** explicit and tacit **knowledge**, **including skills and competence**. It includes both commercial and non-commercial activities such as **research collaborations, consultancy, licensing, spin-off creation, researcher mobility, publication**, etc. (COM Communication COM(2007)182- Improving knowledge transfer between research institutions and industry across Europe: embracing open innovation – Implementing the Lisbon agenda)

1. Getting started

Entities that work with/generate knowledge should think about and take care of IP issues



1. Getting started

Scenario

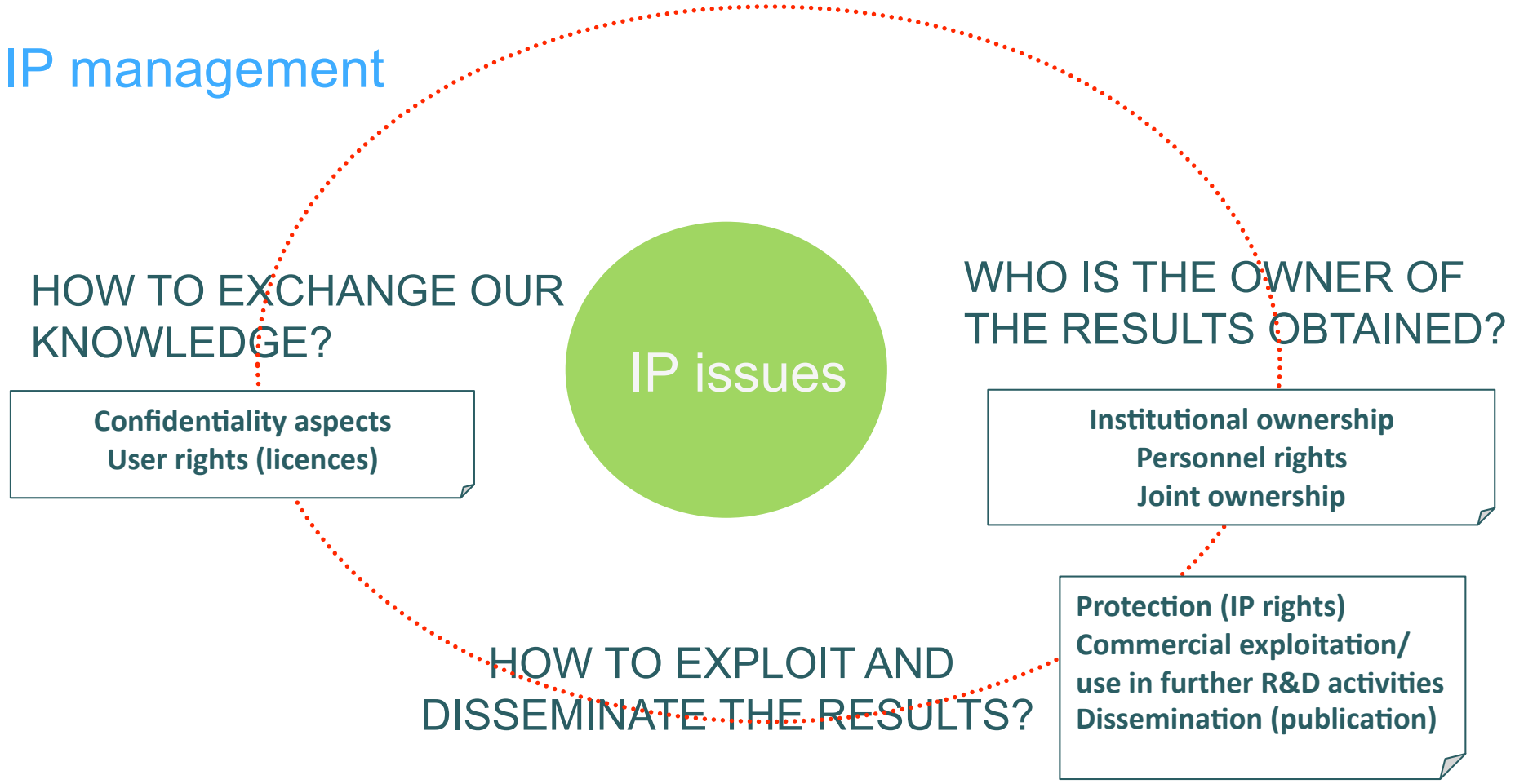
A University research department is working on the creation of certain **technology**.

The research group is sure that it will really be **a 'hit'** to be widely **exploited** with multiple applications.

One of the researchers of the group is thinking about **publishing** an article in a prestigious journal...

Where to start?

1. Getting started



2. To bear in mind…

Turning research results into tangible output is increasing. However,

1. Problems with innovation?

Publication *vs* Exploitation

'Protecting first, publishing later'

Scientific merits by publication.
Scientific merits by obtaining industrially applicable/patentable results.

2. Pushing universities too far?

Lack of specialised IP staff/structured policies

a) Reinventing the wheel?
b) Lack of proper KT strategies.

2. To bear in mind…

COMMISSION RECOMMENDATION of 10 April 2008 on IP management in KT activities and Code of Practice for universities and other public research organisations

11 recommendations for EU Member States

Code of Practice for universities and other PROs in KT activities, based on 3 sets of principles:

- Implementing IP policy
- KT policy complementary to IP policy
- Principles for collaborative and contract research

2. To bear in mind…

Member States should:

1. Ensure that PROs define **KT as a strategic mission**;
2. Encourage PROs to follow policies in line with the Code of Practice;
3. Support KT capacity and **raise awareness and skills of students**;
4. Promote dissemination of knowledge;
5. Cooperate to **harmonise IP ownership regimes in PROs**;
6. Introduce/adapt national guidelines using the Recommendation;
7. Take steps to ensure the widest implementation of the Code of Practice;
8. Ensure equitable treatment (EU/non-EU participants) in international research projects;
9. Designate a **national contact point (NCP) to address transnational issues**;
10. Make use of the best practices set out in the Annex II to the Recommendation;
11. Inform the Commission of the measures taken on the basis of the Recommendation.

2. To bear in mind…

For universities:

1. Principles for an internal IP policy

1. **IP policy should be part of the mission**; establishment of a **single contact point**;
2. The **IP policy should be clear** for both staff and students;
3. Identification, exploitation and, where appropriate, protection of IP should be promoted;
4. Incentive staff;
5. **Creation of coherent IP portfolios** and **pooling IP resources** between PROs;
6. **Raise awareness and skills on IP and KT among students and staff**;
7. Promote **wide dissemination of results**; while accepting to delay it for protection reasons, this should be kept to a minimum.

2. To bear in mind…

For universities:

2. Principles for a KT policy

1. In **maximising socioeconomic impact of results**, **all types** of possible **exploitation mechanisms** and exploitation partners should be considered;
2. Though proactive IP/KT policy may generate additional income, this should not be considered the prime objective;
3. **Access to professional KT services**;
4. **Develop a licensing policy**; carefully assess exclusive licensing (particularly to non-European third parties); ensure adequate compensation (financial or otherwise) in licences for exploitation purposes;
5. **Clear principles for sharing returns** between institution/ department/ inventors;
6. **Monitor IP protection and KT activities**; publicise achievements to the industry in order to promote exploitation.

2. To bear in mind…

For universities:

3. Principles regarding collaborative and contract research

1. The rules on collaborative and contract research activities should be compatible with the mission of each party, and i.a. **maximise commercial and socioeconomic impact of the research**;
2. **IP-related issues should be clarified as soon as possible**;
3. **Ownership of *foreground*** should stay with the party generating it, though other agreements may be possible; ownership of *background*: unaffected;
4. **Access rights** (licences between the project parties) should be clarified as soon as possible.

Cfr. transnational projects under the EU Framework Programmes

3. Getting it right

In order to implement those principles, what can we improve?

1. Our IP protocols and procedures – clarifying rights and obligations of institution/staff/students;

2. Our understanding of the IP rights system;

3. Our TT/KT practice.

3. Getting it right

1. Internal IP protocols & procedures

Inventions and creations at UA

Researchers do not decide on their own...

- ✓ Art. 20 Spanish Patent Law
- ✓ No specific rule for Universities under Copyright law - Regime for employees' creations (art. 51 LPI)
- ✓ Specific rules for scholars (RD 63/2006), students (RD 1791/2010)
- ✓ UA Norms on Intellectual & Industrial Property 2008

General principles:

Institutional ownership

- ✓ UA's personnel
- ✓ External - assignment
- ✓ Collaborative agreements determining UA's ownership

Recognition of inventorship and authorship

Participation in benefits (60% authors, 40% UA)

... but rights are acknowledged!

3. Getting it right

2. Understanding of the IP rights system

Aware of the basics?...

		Subject-matter	IP rights	
IP	(Industrial Property)	Inventions	Patents	Trade Secrets
			Utility Models	
			Plant Varieties	
		Distinctive signs	Trade Marks	Geographical Indications, Designations of Origin
			Trade Names	
		'Aesthetic' creations	Industrial designs	
		Design of chips	Topographies of semiconductor products	
	(Intellectual Property)	Literary, artistic and scientific works	Copyright and neighbouring rights	

Note: Certain differences in classification may exist due to differing national laws

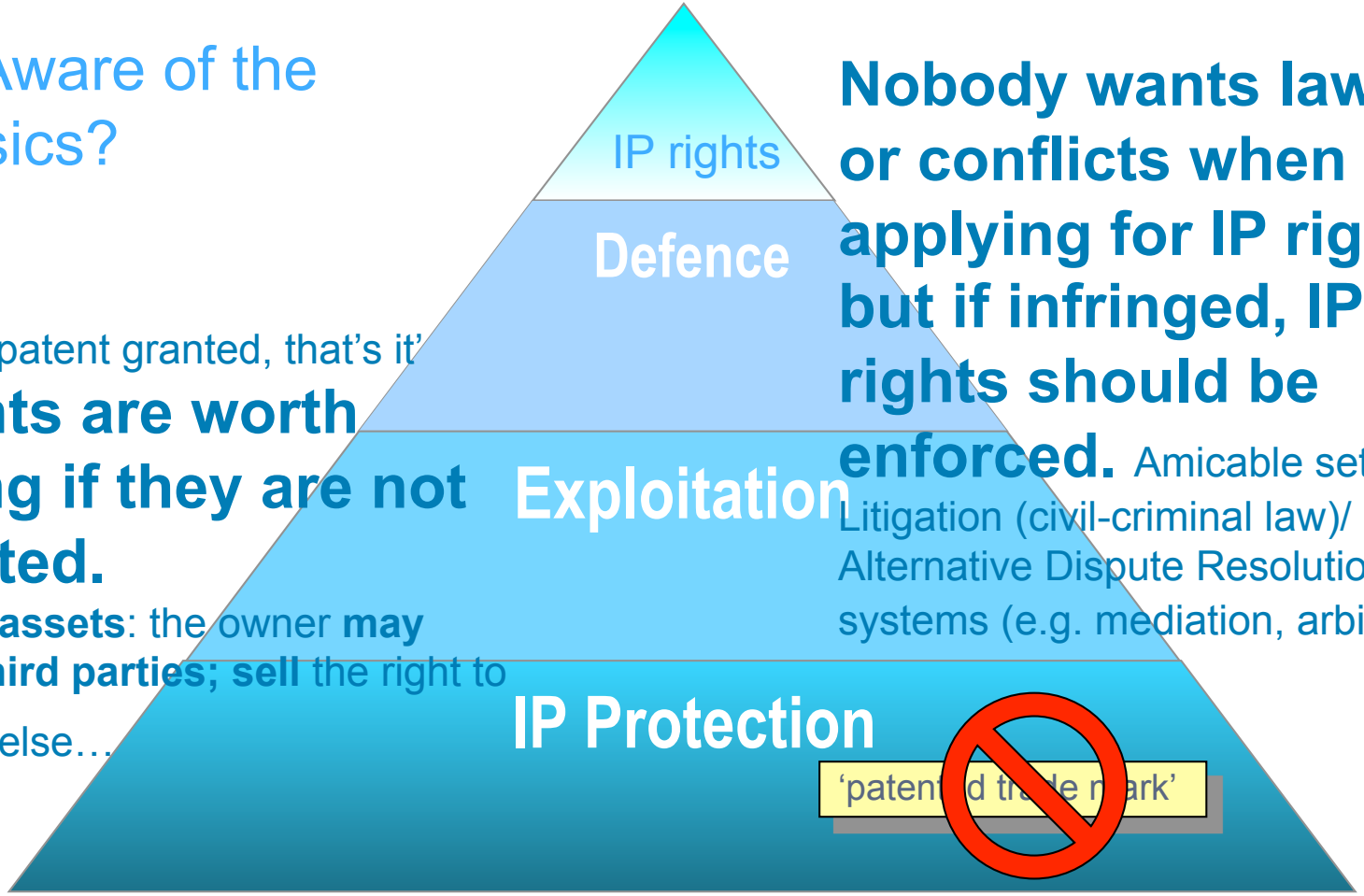
3. Getting it right

…Aware of the basics?

‘I had my patent granted, that’s it’

IP rights are worth nothing if they are not exploited.

Tradable assets: the owner **may license third parties; sell** the right to someone else…



Nobody wants lawsuits or conflicts when applying for IP rights, but if infringed, IP rights should be enforced. Amicable settlements; Litigation (civil-criminal law)/ Alternative Dispute Resolution systems (e.g. mediation, arbitration)

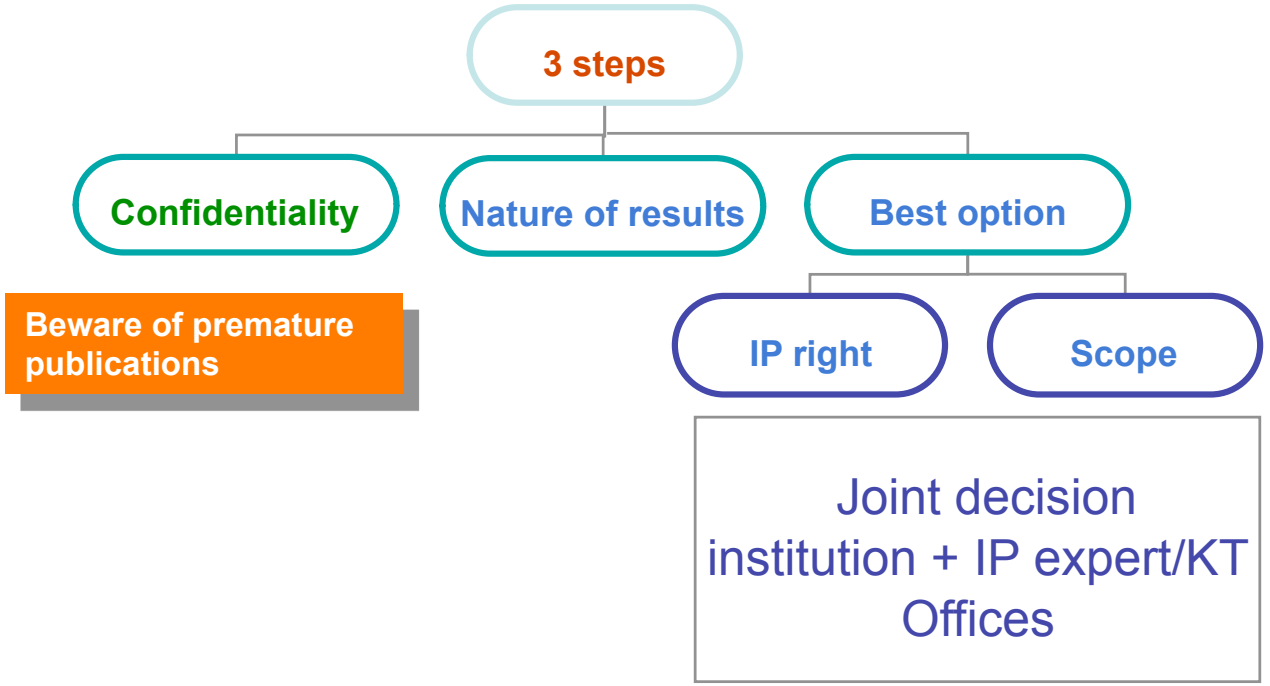
3. Getting it right

3. TT/KT practice

From the lab to the market - IP Protection + Exploitation

Protection, exploitation & dissemination of R&D results are part of the same strategy.

Consistent planning and timing are key!



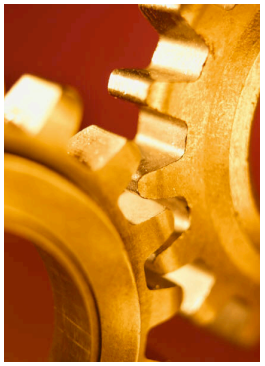
3. Getting it right

From the lab to the market – IP Exploitation

✓**Do you have a license agreement model?**

- ... What about preparation & negotiation?
- Expertise & training are key

Challenge: Underestimation of importance of expert assistance/skills.

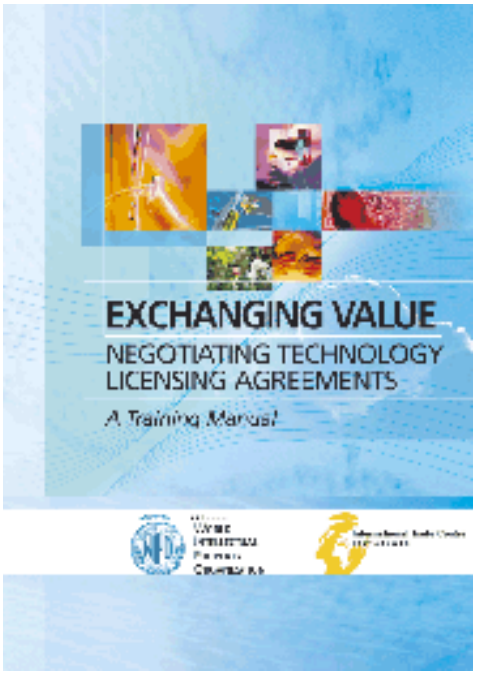


Good faith *('win-win agreements')*

Know your partner (*due diligence*)

Skills *('we don't have the agreement that we deserve but that we negotiate')*

3. Getting it right



Very helpful to start with technology licensing

Written in an easy-to-read style.

Practical manual to enhance knowledge and skills on all the major issues to be addressed while negotiating licensing agreements.

It also has annexes with additional materials, such as a number of case studies and other helpful information.

A pdf version is available on WIPO's website:
http://www.wipo.int/sme/en/documents/guides/technology_licensing.html

4. Checklist for consistent decision-making

✓ Clear and workable internal rules;

✓ Creation/maintenance of IP supporting services;

✓ Researchers and students should be familiar with supporting services (in particular, IP/KT Office) of the institution;

✓ In R&D activities, IP related questions deserve attention from the very beginning – they concern practical issues (share of information / knowledge – ownership of results – exploitation and dissemination of the results);

✓ Institution, staff and students have their rights, which need to be reconciled ☺

5. Some useful resources

WIPO - WIPO University Initiative (http://www.wipo.int/uipc/en/)
SME resources (www.wipo.int/sme/en)

OECD (www.oecd.org) [Innovation]

European Commission- Invest in Research
(http://ec.europa.eu/invest-in-research/policy/ipr_en.htm#3)

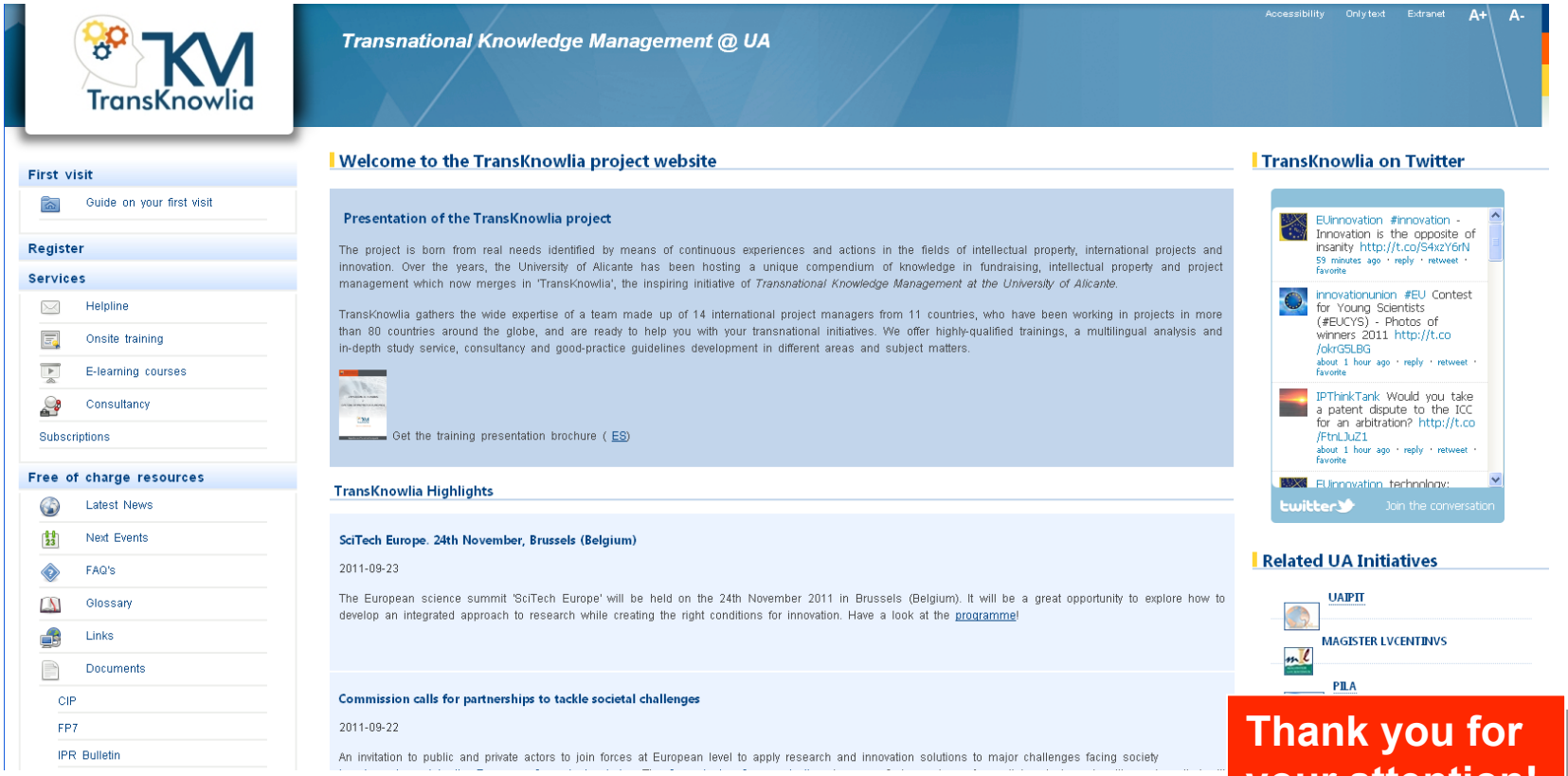
ProTon Europe (www.protoneurope.org)

TransKnowlia (www.transknowlia.org)

5. Some useful resources

TransKnowlia – *Transnational Knowledge Management @ UA*

www.transknowlia.org



Thank you for your attention!

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