

# **Guidebook of IP/Technology Transfer**

# **Track 1**

## **Entry-level Tech Transfer Professional**

### **Topic 1.5.6**

#### **The IP “suite”:**

**Patents, other IP, Bioproperty**

**What’s possible? Feasible? Cost-effective?**

# Designing a Feasible and Cost Effective

## IP Suite & the Property Control Position

- List all IP and bioproperty types POSSIBLE for an invention
- From that list, make a subset property types that can feasibly protect the invention
  - the feasible Property Control Position (PCP)
- Reflect on the licensing potential of the invention:
  - does it have significant economic potential?
  - where is the opportunity (which countries?)
- If the invention has significant, global potential
  - it is a candidate for costlier PCP
- The potential opportunity may not warrant multiple and/or costly PCP types

# Designing a Cost Effective

## IP Suite & the Property Control Position

### Patents

- Expensive but powerful legal instrument for property control
- Scope of claims is absolutely essential to patent worth
- They are a primary deterrent, but ultimately may need to be enforced in court (costly)
- They are often the most effective means of protecting an invention;
- Issued and enforceable in specific countries
- Evidence of infringement can be difficult to obtain
- The PCT is a cost-effective means of establishing a multi-country IP asset

# Designing a Cost Effective

## IP Suite & the Property Control Position

### Trade Secrets

- No registration or prosecution – no fees;  
inexpensive to create
- Require careful management to maintain
- Often not feasible to manage sustainably (licensing and commercialization can be challenging)
- The primary weakness:  
can't stop anyone who legally discovers it  
(or something essentially equivalent or similar)
- Can last indefinitely (as long as the secrecy maintained)
- Often a good complement with patents

# Designing a Cost Effective

## IP Suite & the Property Control Position

### Trademarks

- Can be created and used without registration
- Registration and prosecution required to enforce
- Typically much cheaper to obtain than patents
- Real value in the marketplace requires brand promotion and maintenance – can be significant expense
- Can last indefinitely (as long as the secrecy maintained)
- Often complements patent and/or trade secret
- Very long lifetime

# Designing a Cost Effective

## IP Suite & the Property Control Position

### Copyrights

- Can be created and used without registration
- Registration and prosecution required to enforce
- Free to create, inexpensive to register
- Can last many decades
- Only protects the reproduction of the material, not the ideas contained in the material
- Useful to protect manuals, diagrams, blueprints, plans, reports, musical scores, paintings and drawings, etc.

# **Designing a Cost Effective**

## **IP Suite & the Property Control Position**

### **Plant Breeder's Rights (PBR)**

- Applicable only to cultivated/human-created plants
- Many forms have limitations on rights of the owner  
(many countries have laws that allow breeding and research by others)
- Provide a patent-like right to the owner of the PBR
- Some countries (e.g., U.S.) grant patents on plant varieties and plant traits (E.U. and U.S.)



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**Thank you**