

Guidebook of IP/Technology Transfer

Track 1

Entry-level Tech Transfer Professional

Topic 1.5.9

**Managing “Platform Technologies”
that Enable Different Applications and Markets**

Managing Platform Technologies

- What is a “platform technology”?
- What makes it unique
- Managing the IP of the platform
- Licensing

A Platform Technology

An invention that has fundamental
attributes that enable various uses;
useful for multiple applications

A Platform Technology

An invention of fundamental attributes that enable various uses; multiple applications

For example:

- A new biodegradable and antimicrobial material formulation useful in food packaging, medical
- A unique method of mixing fluids equally applicable to paints and cake batter
- An adjuvant chemistry that improves the efficacy of agricultural chemicals and skin-care products

Platform Technology: More examples

- A molecular biology technique that can modify microbial, plant, and animal cells
- An IoT monitoring & management device that has distinctly different applications in industrial factories, hospitals, and homes
- A new molecule discovery that has insect repellency, insecticidal, antimicrobial, and antiviral properties
- A method for improved plant breeding that can be used on many crop species

Platform Technologies

What makes them unique?

- Since they have multiple applications, they can be licensed in multiple ways
- They are inherently more complicated to manage and license, but also have a higher probability of success
- They offer the potential for multiple, exclusive licenses

Platform Technologies

Managing the IP of the platform:

- The IP must support multiple uses
- Sufficiently broad claims must be sought in the patent prosecution
- During prosecution of patent applications, divisionals, continuations, and continuations-in-part are often part of the strategy to cover all applications
- A single technology can have different Trademarks in different industries (i.e., different “streams of commerce”

Platform Technologies

Licensing

- Field-of-Use exclusive licenses are often an excellent strategy
- Be careful that definitions of Field-of-Use in different exclusive licenses to the same platform IP, have absolutely NO possibility of overlap

Platform Technologies

Other issues

- Infringement enforcement can be tricky
- An infringement in one Field-of-Use but not another is problematic because....
 - enforcing IP in one Field-of-Use can jeopardize the IP in the other
- Putting the IP at risk by enforcing in one Field-of-Use can have negative impact on the exclusive licensee in the other Field-of-Use
 - this is a potential lawsuit for the TTO

Platform Technologies

Although challenging and somewhat complicated for IP and license management....

Platform Technologies.....

Are a great opportunity for the Technology Transfer Professional to achieve significant impact

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Thank You