

Guidebook of IP/Technology Transfer

Track 1

Entry-level Tech Transfer Professional

Topic 1.7.4

Developing an IP Strategy for Tech Transfer

Developing an IP strategy for Tech Transfer

The Approach

1. Assess the invention for inventiveness
2. Is the inventiveness market relevant?
3. Can a compelling Value Proposition be developed?
4. Is it patentable?
5. Is potential patentability meaningful and enforceable?
6. Does the inventiveness, market relevance, Value Proposition, and potential patent position justify a PCT application?

Developing an IP strategy for Tech Transfer

The Approach

1. Develop a list of all types of IP that are POSSIBLE
2. From the list of “Possible”, select those that are FEASIBLE
3. From the list of “Feasible”, consider those that are COST EFFECTIVE.
4. Using the list of “Cost Effective” IP/bioproperty, consider the potential market/commercialization/licensing value
5. Balance pursuit of IP/bioproperty on Cost Effective list with budgetary concerns and commercialization value

Developing an IP strategy for Tech Transfer

Do Not Forget: BIOPROPERTY

- Bioproperty (i.e., tangible biological material)
- May be an essential part of your IP strategy
- Remember:
 - IP + Bioproperty = the “Property Control Position”
- For many life-science inventions,
 - the Property Control Position strategy
 - will include bioproperty

Developing an IP strategy for Tech Transfer

Assessing the Invention

- Is it patentable (inventive)?
- Is the potential patent claim coverage meaningful (in commercialization)?
- Is the potential patent claim coverage enforceable?
- Is there potential for more than one patent?
- Is bioproperty involved?

Developing an IP strategy for Tech Transfer

Assessing the Invention

- Does the potential commercialization value (market relevance, Value Proposition) justify patent filing?
- Does the potential commercialization value and patentability justify filing patents outside the home-country?
- Is a Patent Cooperation Treaty (PCT) patent application justified by the potential value of the inventive invention?

Developing an IP strategy for Tech Transfer

Are other forms of IP possible?

- Trade Secret
- Copyright
- Utility Model/Petty Patent, etc.
- Trademark
- Plant Breeder's Rights
- Bioproperty (bailment-type property rights)

Developing an IP strategy for Tech Transfer

Implementing a Strategy

- Initially, begin by creating as many IP/bioproperty options as possible
- Wherever costs are involved (e.g., patent prep and filing), consider the commercialization potential
- Invest time and money according to:
 1. inventiveness, market relevance, value proposition, IP quality potential
 2. IP budget

Developing an IP strategy for Tech Transfer

Implementing a Strategy

- Use timing to your advantage
 1. File a patent in home country
 2. Market the IP/technology to find a licensee that pays a license fee that allows TTO to cover IP costs.
 3. File a PCT
 4. Market the IP/technology to find international licensees that will pay license fees that allow TTO to pay national-phase patent filings

Developing an IP strategy for Tech Transfer

Implementing a Strategy

- For most inventions, use a “linchpin” IP strategy
- “Linchpin” = the key component that keeps the entire mechanism in place
- In IP strategy, “linchpin” is the key patent, covering the essential aspect of an invention
- For inventions with potentially very significant commercialization value, consider a “picket fence” strategy
- IP “picket fence” is multiple patents and other IP covering a single invention/technology

Developing an IP strategy for Tech Transfer

IP Strategy for Platform/Field-of-Use Technologies

- Platform technologies have multiple applications and multiple “fields-of-use”, and multiple exclusive, field-of-use licensees
- The TTO/TTP must manage the Property Control Position to simultaneously protect the IP in all fields-of-use
- Platform technologies typically require multiple patents covering different applications of the invention

Developing an IP strategy for Tech Transfer

Implementing a Strategy

- Maintain patent pending coverage as long as possible
- When negotiating with exclusive licensees, try to capture ability to cover all past/present/future patent expenses (and other IP costs)
- If no licensee, when key cost-event occurs (i.e., patent filing, patent action) decide to keep or abandon, based on:
 - commercialization potential,
 - latest tech data
 - results from marketing, etc.

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Thank you