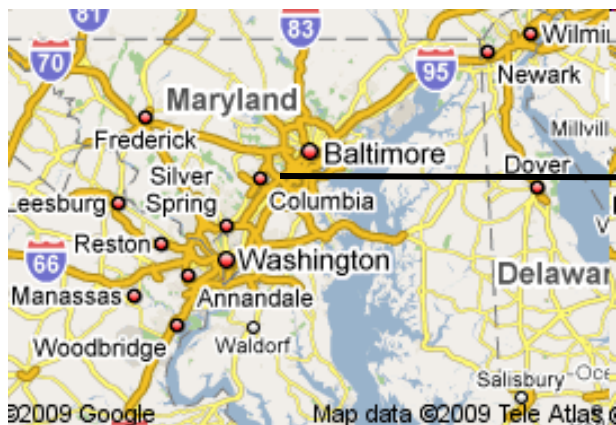


# Scouting for IP-Based Technology in Universities

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**ET Cube International**

WIPO EIE Workshop II  
Colombo, Sri Lanka  
Sept. 17-21, 2018



# Motivation

Industry/Start-ups can benefit from new ideas from University

# OUTLINE

Identifying Opportunities for collaborative work

Key Issues

Conclusions

# What makes the University-Industry Relationship successful?

Linear Technology Push by University is not necessarily the best way for innovation in industry

More symbiotic relationship in working on the problems of interest to both University and industry/market

# How do we start a relationship with Universities?

1. Student Design Projects
2. Co-Op Students
3. Part-time students from your company?
4. Adjunct faculty
5. Master's projects/thesis
6. Doctoral thesis topics

# How do we start a relationship with Universities?

## 7. Testing and Laboratory Analysis facilities

# Modes of Interaction for Commercialization

Collaborative  
Research

**Exploratory – industry  
directed research? IP?**

Sponsored  
Research?  
Contract Research?

**Deliverables are not well defined? Or  
Well defined?  
IP?**

Consulting

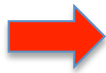
**Business deal - Strong deliverables  
IP ?**

Licensing

**Business deal: IP defined, Clear Term  
Sheet**

# Key Issues for IP Acquisition

## Key Issues

- 
1. Non-confidential info, IP Documentation
  2. Development and licensing/acquisition agreements
  3. Open Source software issues
  4. Representations and Warranties related to Ownership of IP and pending disputes
  5. Representations and Warranties related to IP Infringement
  6. Websites and Social Media content related to IP
  7. Scope of Indemnification on IP Issues
  8. Disclosure and IP Transfer schedules




# IP Documentation

1. Patent Application
2. Technical design and data
3. Pending Publications

# Key Issues for Acquisition

## Key Issues

1. IP Documentation
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# Development Agreements


What is the arrangement for further work on the topic?

University alone or University/licensee or licensee alone?

Conditions for licensing of further University IP? First right?

# Key Issues for Acquisition

## Key Issues






1. IP Documentation
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# Open Source Software Rights

Open Source software rights may not be transferable??

# Key Issues for Acquisition

## Key Issues

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# IP Donations

Why donate IP to Universities?

Companies get tax benefits by patent donation?

# Managing IP Costs

May be more economical to license from Universities than company investment in R&D

Long term relations with Universities can also be useful for R&D collaborations and high-quality employee hiring



# IP Donation by Companies

Company	What was donated	Received by	Year
Dupont	257 Patents	DEDO	2007
Dupont	Patents for a new papermaking technology	University of Maine	2001
Dupont	\$64 Million worth of patents	Penn State U. of Iowa VPI	1999
Boeing	Patents for Medical applications	U. Penn	2001
Proctor and Gamble	196 patents	Vanderbilt	2000
Shell	> \$83.5 Million	U. Texas	

# Donation by Free-Licensing

Company	What was licensed	Received by
Syngenta	technology to produce vitamin A enriched rice	Golden Rice Patent Pool
Boehringer Ingelheim	Granted free-licenses of patents covering a HIV drug for a period of 5 years to Aspen Pharmacare	Aspen (SA Company)
Novartis, Roche	Do not file or enforce patents in least developed countries	

# Summary

**Universities are a good source of IP for companies**

Manage risk through proper understanding and negotiation of terms

Room to develop innovative interactions with University?

# THANK YOU!

# The importance of Intellectual Property (IP): Scouting for IP-based technology acquisition

Key Issues:

(Ref: ([www.forbes.com](http://www.forbes.com)) 2016/03/17/ Harroch, Lipkin and Smith