

## Identifying and assessing research results



TECHNOLOGY TRANSFER AND COMMERCIALISATION Hall "Ruen", 27th of September 2011

European Day of the Entrepreneur (EDE) Sofia, 26-27 September, 2011

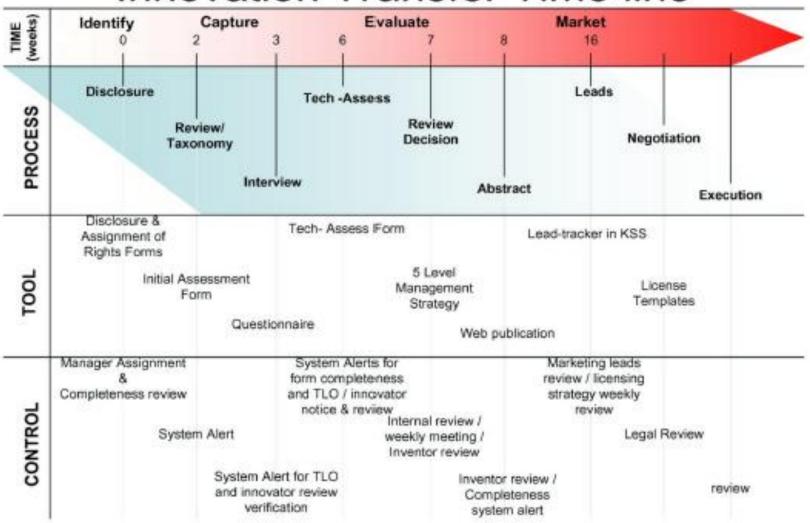


### **Outline**



- Steps in technology transfer
- Technology Transfer Processes
- Documentation as part of the TT processes
- Identification of promising research results
- Key aspects in the evaluation of research results/ technology
- Decision making aids (methods, processes and procedures)

### Innovation Transfer Time line





## **Stages and outcomes**



### **Stages**

- Identification
- Capture
- Evaluation
- Market

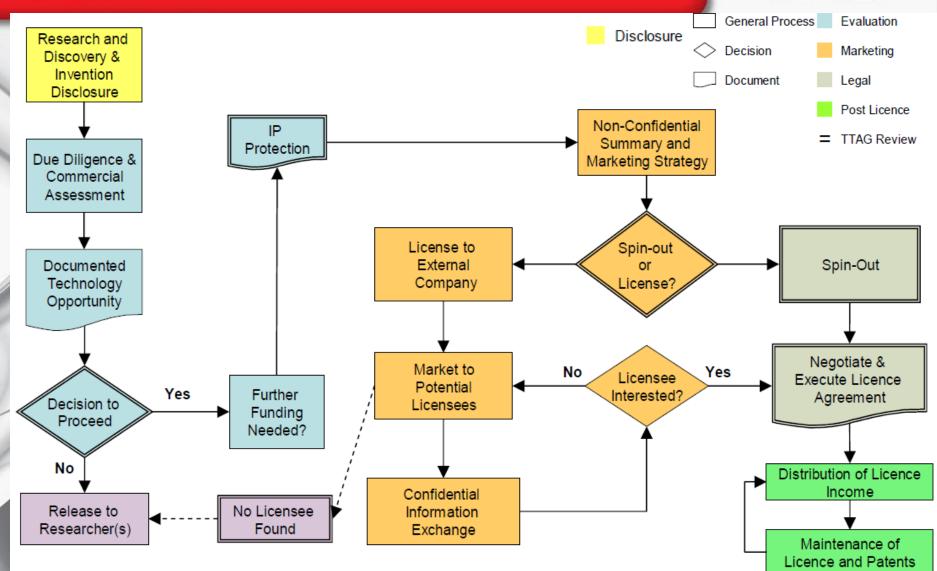
#### **Outcomes**

- •Invention Protection
- Commercialization
- Successful Innovation
  - Royalties
  - Equity shares



## TT process







### **Documentation**



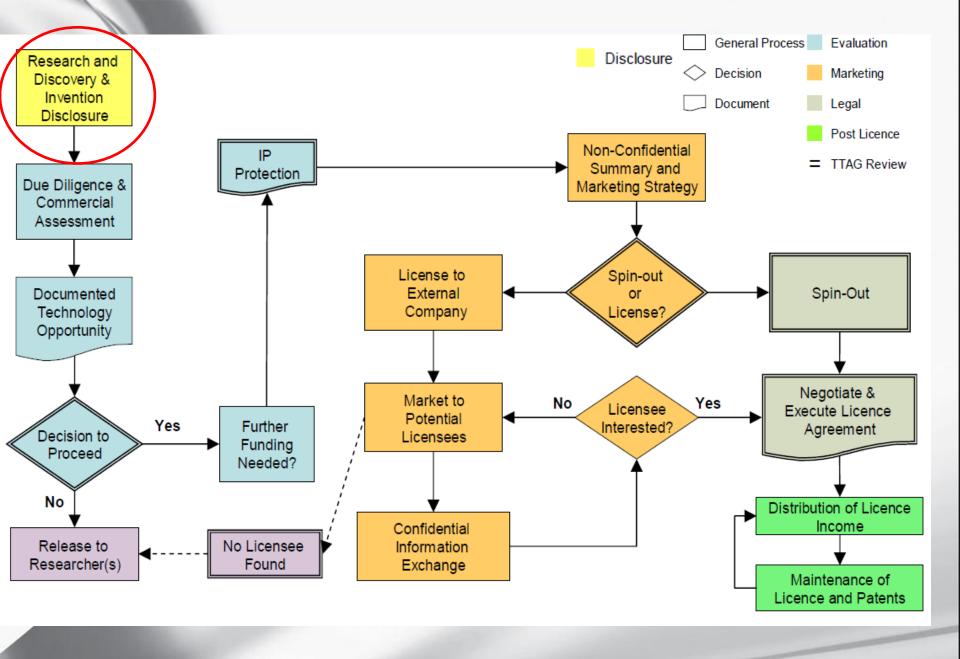
The following documents are normally required to support the Innovation process.

- Disclosure
- Assignment of Rights
- Initial Assessment of the Technology Opportunity
- Application for IP Protection:
  - •Provisional Patent Application
  - Patent Application
  - •Trademark Application
  - •Copyright Application
  - •Registered designs (design rights)
  - Database rights
- Tech- Assessment to assess route to market
- License Templates/ Spinout business plan



## **Identifying...**







## **Starting point: Invention Disclosure Form**



- Serves as a precursor for formalising the confidential description of an invention
- A basis for determining patentability
- The technical information required to draft a patent
- Useful to establish rights to an inventions that can be protected by other means (e.g. copyright) other than patents
- The completed form should be treated as confidential information
- The Invention Record Should Be Signed And Dated By All Named Researchers.



## **Invention Disclosure Form**



- What do you think your invention is?
- How and why does it work?
- How does your invention improve on the present situation and what is new about it?
- Are there any other uses of the invention?
- Do you know of any published literature relevant to your invention? Have you done any searching for published literature, and if so where?
- Has the invention been tested in the laboratory or has it been used? If so please give results.
- In which markets do you think this invention or design will find most success?
- List three key commercial benefits of the invention/ design.
- Name any commercial contact who my be interested in this invention.
- Attach any relevant sketches.

### cambridge enterprise

commercialising University science

#### Invention Disclosure Form

Please read the notes, complete this form and send to:

Disclosures, Cambridge Enterprise Limited, University of Cambridge, Hauser Forum, 3 Charles Babbage Road Cambridge, CB3 0GT.

Telephone switchboard: +44 (0)1223 (7)60339, Fax: +44 (0)1223 (7)63753. Email: disclosures@enterprise.cam.ac.uk web: www.enterprise.cam.ac.uk

OPTING IN / OPTING OUT	Yes	No	Don't Know
Please indicate whether you wish Cambridge Enterprise to			
support commercialisation of your invention. You may			
wish to familiarise yourself with the University's IP policy:			
http://www.enterprise.cam.ac.uk/inandlicensing.php?subsub=21			

#### 1. INVENTORS

Please list all inventors, A co-inventor is an individual without whose intellectual and creative input the invention could not have been made in its present form. They must have conceived or contributed an essential element of the invention either independently or jointly with others, during the evolution of the invention or its reduction to practice.

Please list all inventors and nominate one person as the principal contact

Inventor(s)	Position	Department	Phone/Fax	Email

#### 2. INVENTION

- a. A brief, descriptive title to aid in identifying the invention; say, six words maximum, please!
- In describing the invention, please explain:
- The problem it solves
- How it works and the commercial applications
- Advantages and improvements over existing methods, devices or materials
- c. The date is when the inventor(s) devised the essential concepts of the invention but without necessarily having proved that it would work or having built a prototype.
- a In most countries a patent application must be filed before an oral or printed publication is made available to the public. Publication means the first time the graph with a confidentiality, would have been able legally to gain access you described. tations, any talk to external research groups, or in nive Name (s) of the inventor(s means lectures, seminars, conference presenta general conversation with people outside the activities were covered by a documented oblig

- b. Please attach a brief description of the invention what pesign relate rands date put bintove practice or No. from the following options. Idea, Proven concept or Working pro-
- c. What date did you make the invention?

- ✓ A description of the invention of the
- ✓ Publication dates and data published (existing or projected) if applicable

#### Inventions (continued...) d. Disclosures: Are there any public disclosures planned? If so, in what form, when and where? Have any details of any of the work been disclosed publicly? In a journal (online or in print) To a conference or seminar, as an abstract, poster, etc. In any other publicly disclosed communication In a PhD

#### 3. PRIOR ART SEARCH AND MARKETING

- a. Please list research publications similar to your work. If you have done a patent search (e.g. using www.espacenet.com) please list the key words you have used and the patents found.
- b. Please list companies you have contacted, those you think are active in the area, or who want to develop a new product line. If possible please give contact information (we'll consult you before
- a. If you've done a search to find out about 'prior art' and competing technologies, please list key words and attach your findings.
- Please list companies you think would be interested in commercialising the invention, and why.

#### 4. SPONSORSHIP OF THE RESEARCH

- a. Give the applicable contract or grant (RG) number(s), project title(s) and the principal investigator on the project(s) in the table below if the invention was made in connection with research funding. We need to ensure that we fulfil our obligations under research grants and contracts.
- a. Was the invention developed using any research grants/contract funds? Please answer Yes or No.

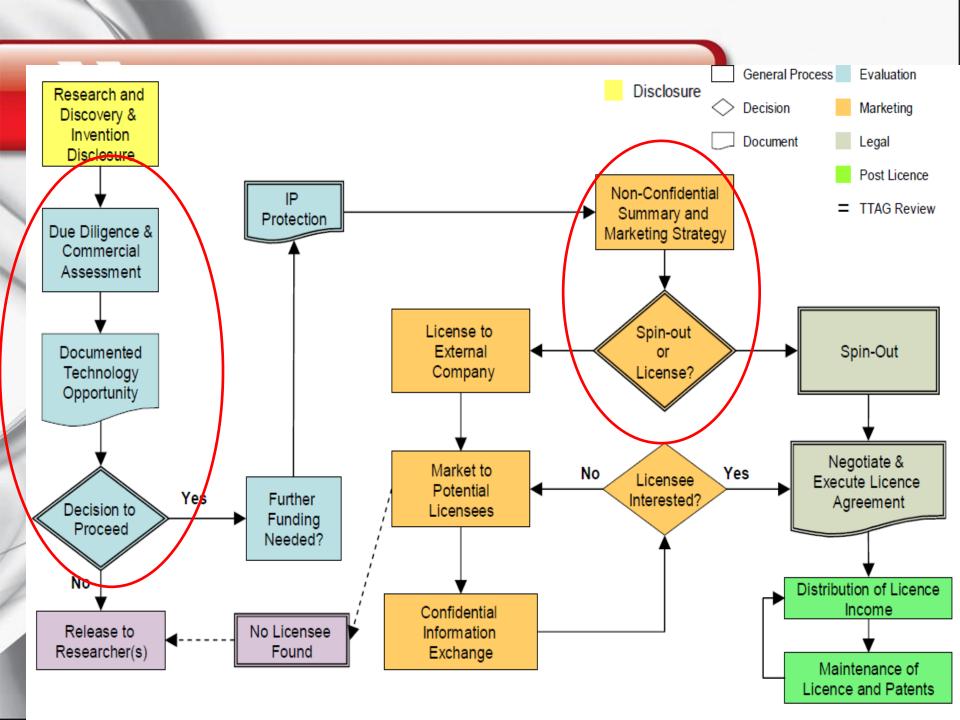
	Contract/RG no	Sponsor(s)	Project title	Principal inv	estigator	Date grant started
	1					
	7					
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## **Evaluating...**







## Assessment of Technology Opportunity



## To assess optimum management strategy for commercialisation

Go <u>OR</u> Proceed with caution <u>OR</u> STOP

- Investigation of patentability
- Probing marketability

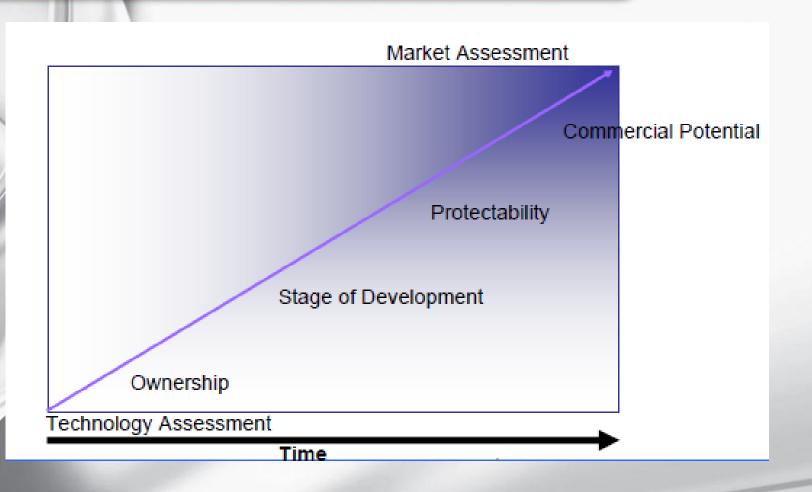


During the assessment (evaluation), disclosing outside the institution is safe if a Confidential Disclosure Agreement (CDA) or NDA is used



## **Evaluation Sequence**







# **Technology/ Invention Assessment**



### **6 Pillars approach**

- 1. Ownership
- 2. Feasibility and Scope of Protection (IPR)
- 3. Strength of Technology
- 4. Commercial Potential and Value
- 5. Stage of Development
- 6. Commitment of Inventors

All pillars matter.

If one pillar is weak or missing,
chances of success are much lower





## 1. Ownership



- Assignment
- Have rights to this technology been pre-assigned to a third party?
- Joint Inventorship
- Number of co-owner institutions
- Funding (Source of funding)
- e.g., corporate, state, etc.
- Other Agreements
- Material Transfer Agreements, Memorandums of Understanding, etc.
- Inventorship
- Number of inventors/authors



## **IP** ownership



### Ownership depends on many issues:

- Who is paying the costs (research funding)?
- Who proposed the project?
- Who is designing/managing the project?
- Is the project critical to the Industry partner?
- On what Background IP or resources does the project rely?
- Can the project be kept separate from other PRO researcher's activities?
- What is the effect on future research by PRO?



# Formulas depend on country/institution



### **Greece – generally for "dependent inventions":**

40% to employer (University/ PRO) 60% to employee (researcher)

#### **University of Minho - Portugal**

University owns IP. Benefit sharing:

- 45% researcher(s)
- 45% University

15% Department

15% Faculty

15% Central Services

10% risk capital



## **US Formulas**



- US Formulas for the allocation of OTT revenues from license royalties:
  - -Most common formula: Equal sharing among the university (33%), the department (33%), and the employee inventor (33%).
  - -<u>Another common formula</u>: 50%-50% sharing between the university and the inventor.
  - -Average net revenue distributions: University (35%), department (25%), and faculty inventor (40%).



## **IP** ownership



### Types of research funding

- Open Research wholly funded by public funds or grants. Results are generally published, publication can be delayed to allow patent filing.
- Contract research PRO is paid 100% of all costs (market rate + profits), acting as service provider. IP is fully owned by the contracting party.
- Collaborative research both parties provide resources for the project and both parties have an interest in its outcome. IP is agreed on a case by case basis.



## **IP** ownership



#### **Different ownership positions:**

- Industry owns the IP and PRO has no right to publish results
- Industry owns the IP and PRO can use results for academic purposes
- PRO owns the IP and Industry has exclusive rights
- PRO owns the IP and Industry has exclusive licence in a certain area (application, market)
- PRO owns the IP and Industry has nonexclusive rights



# 2. Feasibility and scope of protection



- Timing
- Publications exist or are planned
- Strength
- Ability to work around patent
- Enforcement
- Infringement detection
- Security
- Ability to exclude others from practicing
- Challenge
- Aggressive area of US or Worldwide Patent/Copyright activity
- Reach
- Worldwide protection

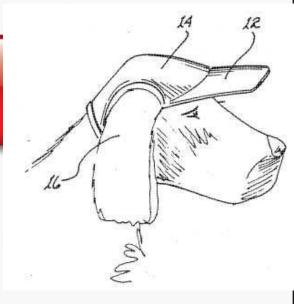


## **Factors effecting the Protection Decision**

For patenting decisions
use patenting decision guide
(patent decision trees)



- The availability of funding
- The existence of other projects
- The other pillars!



Ur		ates Patent [19]	[11] [45]	Patent ! Date of	Number: Patent:	5,031,388 Jul. 16, 1991
[54]	DOG HAT A	PPARATUS AND METHOD		,909 3/1901 ,738 5/1901		54/80
[76]		April Ode, 1510 Catherine Dr., Lake Havasu City, Ariz. 86403	750	505 1/1904		54/80
[21]	Appl. No.: 4	69,718	-			iom 54/80
[22]	Filed: J	an. 24, 1990			Robert P. Swi	
[63]		d U.S. Application Data	Attorney, [57]	Agent, or Fi	rm—Harry N	f. Weiss
[63]	doned.	01 Sel. 140. 211,046, Juli. 24, 1906, abaii-	A hat ap	paratus to p	rotect a four	-legged animal from
[51] [52] [58]	U.S. Cl		head cov animal's passage	heat and dir- vering section eyes from sof the anima	ect sunlight. on, a visor se sunlight, aper d's ears there	The hat comprises a ction to protect the rtures to permit the through, and a chin n portion of the head
[56]	U.S. PA	86 Corley 54/80	of the ani and the material	mal. Prefera head coveri for absorbing te a cool hat	bly, the anima	al hat is used for dogs a liquid absorbable e, cold water in order or the animal.



## Patenting decision guide



		Have you told other people about the idea without first insisting on confidentiality?	→ Yes		You may still be able to exploit the idea or patent improvements, but in future use a non-disclosure agreement.
Mathematical methods, scientific theories, aesthetic creations, games and computer programs are not patentable.	<b>←→</b> Unsure	Is your new idea one that is inherently unpatentable?	→ Yes	FORGET	Although computer programs as such are excluded, they may be patentable in combination with a product or process.
		VNo			
Check prevailing practices with other companies operating in those areas	<b>←→</b> Unsure	Will the invention be sold largely in areas where patents are ignored?	→ Yes		In some regions of the world, and in some market sectors, patents tend to be ignored.
to the second se		₩No			
Check prior art through product searches and studies of technical and patent literature.	←→ Unsure	Does your invention contain some novel element or combination of elements?	→ No	ABOUT	A basic do-it-yourself patent search is a good start but professional expertise is usually desirable for in-depth searches.
		√Yes			
Check the expected size and growth of market. Consider possible share and scope for the competitors to improve.	<b>←→</b> Unsure	Will demand for the idea be enough to justify the patent costs?	→ No		Initial patenting costs are relatively low but they increase later - especially when disputed or if world wide cover is needed.
		√Yes			
Check the cost of proving the concept before committing undue expenditure.	<b>←→</b> Unsure	Is the concept itself fully proven?	→ No		It is not possible to obtain a patent for something that is unproven or unworkable.
## ##		<b>V</b> Yes			
Consider what practical steps would be involved in detecting unauthorised usage.	<b>←→</b> Unsure	Will it be difficult to find out whether another company was using your invention?	→ Yes	PATENTING	Consider other possible means of protecting the idea.
		√No			
Consider all possible means such as secrecy, embedded codes, etc.	←→ Unsure	Can you protect the idea more effectively by other means?	→ Yes		After publication anyone can read about your invention and can think about improvements or ways around the patent.
	6.1	VNo			
	FILE /	A PATENT APPLICATION BEFORE MAKING PUBLIC DISCLOSURE	ANY		Professional help is usually needed to ensure that applications covers key issues.



### When to avoid patenting



- Idea is not an invention
- Doesn't qualify as eligible subject matter Publication created bar to patenting
- Idea is not fully developed
- Enablement issues
  Patent issuance unlikely
- Patent position is not commercially useful Narrow coverage
- Dominated by other patents
- No viable commercial market
   No promising application
- Small market for products
- No interested commercial investors

Return on investment not sufficient Difficulties in making products



## **Premature Disclosure**



The **<u>public</u>** release of information relating to an invention before a patent has been filed.

- abstracts
- poster sessions
- seminars
- shelved theses

Premature disclosure usually disqualifies an invention from being patented



## Confidentiality



- An invention and associated information must remain confidential prior to any IP protection.
- The University usually encourages publication, provided that the implications for possible commercial exploitation and existing confidentiality obligations are considered first.
- If you wish to publish or make any public disclosure concerning a possible invention you should first seek advice on the most appropriate form of action.
- USE "CDA" and "NDA".



# NDA(Confidentiality Agreement)



Exchange of information <u>before</u> a collaboration or License:

### Subject and definition of information

- What is exchanged and considered as confidential information.
- Who is provider, who is recipient.

#### **Dealing with confidential information**

- Define / limit the purpose of use (e.g. "to evaluate ...").
- Define to whom confidential info maybe forwarded.
- For unpublished patents: Limit partner's freedom (e.g. "partner not to file patents during ...").

### Retention of rights / Return of information Warranty / Liability

- No warranty of correctness/ suitability for any purpose.
- Only accept information that you really want / need.
- Do not accept a defined contractual penalty).



# Non-disclosure agreements



Date: 201[]

Parties:

[NAME OF INDIVIDUAL RECEIVING INFORMATION] of [address of individual] OR [NAME OF COMPANY RECEIVING INFORMATION], a company registered in [England] under company number [number on Register of Companies] whose registered office is at [address of office on the Register of Companies] (the Recipient) and

[NAME OF INDIVIDUAL DISCLOSING INFORMATION] of [address of individual] OR [NAME OF COMPANY DISCLOSING INFORMATION], a company registered in [England] under company number [number on Register of Companies] whose registered office is at [address of office on the Register of Companies] (the Discloser)

- The Discloser intends to disclose information (the Confidential Information) to the Recipient for the purpose of [insert details e.g. discussing the possibility of the Recipient and the Discloser entering into a joint venture] (the Purpose).
- The Recipient undertakes not to use the Confidential Information for any purpose except the Purpose, without first obtaining the written agreement of the Discloser.
- 3. The Recipient undertakes to keep the Confidential Information secure and not to disclose it to any third party [except to its employees [and professional advisers] who need to know the same for the Purpose, who know they owe a duty of confidence to the Discloser and who are bound by obligations equivalent to those in clause 2 above and this clause 3.
- 4. The undertakings in clauses 2 and 3 above apply to all of the information disclosed by the Discloser to the Recipient, regardless of the way or form in which it is disclosed or recorded but they do not apply to:

- any information which is or in future comes into the public domain (unless as a result of the breach of this Agreement); or
- any information which is already known to the Recipient and which was not subject to any obligation of confidence before it was disclosed to the Recipient by the Discloser.
- Nothing in this Agreement will prevent the Recipient from making any disclosure of the Confidential Information required by law or by any competent authority.
- The Recipient will, on request from the Discloser, return all copies and records of the Confidential Information to the Discloser and will not retain any copies or records of the Confidential Information.
- Neither this Agreement nor the supply of any information grants the Recipient any licence, interest or right in respect of any intellectual property rights of the Discloser except the right to copy the Confidential Information solely for the Purpose.
- 8. The undertakings in clauses 2 and 3 will continue in force [indefinitely][for [insert number] years from the date of this Agreement].
- This Agreement is governed by, and is to be construed in accordance with, English law. The English Courts will have non-exclusive jurisdiction to deal with any dispute which has arisen or may arise out of, or in connection with, this Agreement.

Signatures page ...



# Material transfer agreement (MTA)



Recommended for any transfer of biological or chemical material. Material is usually provided for free (in some cases costs covered)

#### Clear definition / description of:

- Original material.
- Allowed use / research purpose.

#### Restrictions

What / Who / Where / How long.

#### Statement about:

- Ownership and NO transfer of any rights
- Related confidential information,
- unmodified derivatives, modifications.
- Filing of inventions by recipient.
- Publications by recipient.
- Warranty, liability and handling of material.

UC Davis Material Transfer Agreement for UC Davis Pluripotent JM8 Mouse Embryonic Stem Cell Line for Not-for-Profit Organizations and Research Institutions

The Regents of the University of California, as represented by its Davis campus ("UC DAVIS") asks that the RECIPIENT agrees to the following before the RECIPIENT receives the Pluripotent JM6 Mouse Embryonic Stem Cell Line ("MATERIALS").

- . The above MATERIAL is the property of UC DAVIS and is made available as a service to the research community.
- 2. THIS MATERIAL IS NOT FOR USE IN HUMAN SUBJECTS
- 3. The MATERIAL will be used for teaching or not-for-profit research purposes only.
- 4. The MATERIAL will not be further distributed to others without the written consent of U.C. DAVIS. However, the RECIPIENT may insariler modifications containing the MATERIAL to net-body organizations and research institutions under a material transfer agreement that has terms that are at least as protective of the rights of U.C. DAVIS as the terms of this Agreement. The RECIPIENT DAVIS or U.C. DAVIS as Destined to the state of the RECIPIENT and the RECIPIENT DAVIS or U.C. DAVIS SCIENTIST agree to make the MATERIAL available, under a separate material transfer agreement to other scientists for teaching or not-for-porting reach-proposed.
- The RECIPIENT agrees to acknowledge the source of the MATERIAL in any publications reporting use of it.
- 6. Any MATERIAL delivered pursuant to this Agreement is understood to be experimental in mature and may have hazardous propriese. Lib ONIVIS MAYES NO PERPESIBLYATIONS IN TRAINING AND AND PROPESS OR IMPLIED WARRANTIES OF MERCHANTAGETY OF REPORTS OR IMPLIED WARRANTIES OF MERCHANTAGETY OF REPORTS FOR A PARTICULAR PURPOSE, OR THAT THE USE OF THE MATERIAL WILL NOT INFRINDE ANY PATENT, COPYRIGHT, TRADEMARK, OR OTHER PROPERTARY RIGHTS. Unless pricibited by law, RECIPIENT assumes all isolity for claims for damages against it by third parties which may affect from the use, sorging or disposal of the MATERIAL.
- The RECIPIENT agrees to use the MATERIAL in compliance with all applicable statutes and regulations.
- 8. This Agreement may be executed in any number of counterparts, including facalimite or scanned PDF documents. Each such counterpart, facalimite or scanned PDF document shall be deemed an original instrument, and all of such counterparts, together, shall constitute one and the same executed Agreement.

WE ARE NOT ABLE TO CHANGE THE TERMS OF THIS AGREEMENT.



# 3. Strength of the technology



- Uniqueness of the invention
- Emerging alternatives
- Novelty of the invention
- Breadth/ Edge of technology
- Applicability of technology (integration)
- Legislative issues
- Standards
- Environmental Impact

You may need impartial experts to address these issues



# 4. Commercial Potential and Value



- Ability to identify market need
- Potential market size
- Availability of market contacts
- Feedback from industry contacts
- Market Location
- Market Place Competition
- Ability to compete in the market place
- Time to Market
- Regulations
- Significance
- Licensing Barriers
- Timeliness... etc....etc

But do not exaggerate with analysis...!



## **Market Characteristics**



- Market Size
- Stage of Development of the market?

Growth?

Mature / Static

Saturated and in Decline?

Market Segments - how much of this market you can realistically hope to conquer

Competitors

Substitute Products

- Market Trends
- Market Drivers

**P**olitical

**E**conomic

Social

**T**echnological

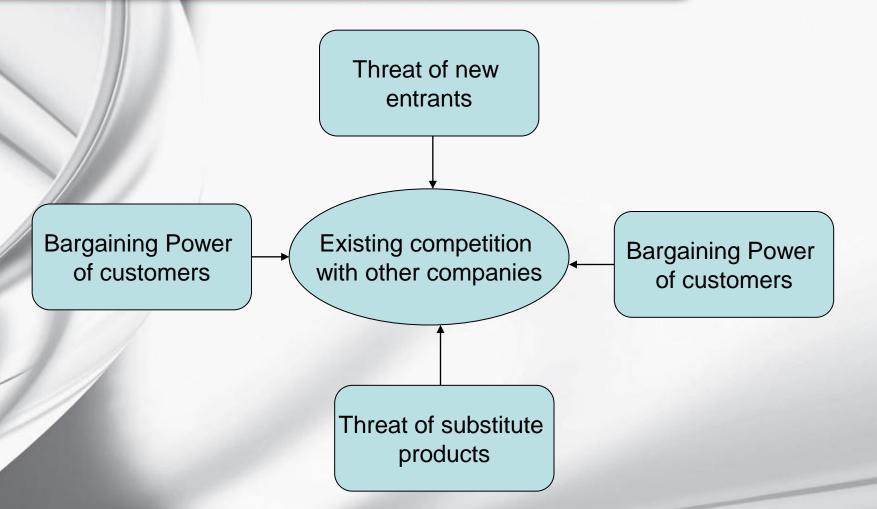
Legal

**E**nvironmental



## **Business Model – Porter's 5 Forces**







## **Positioning in the market**



**SWOT** analysis

**S**trengths

Weaknesses

Opportunities

**Threats** 

Comparative "weight" or impact? Mitigation?

4Ps analysis

**Product** 

Place

Price

Promotion

Do your market research! Primary and secondary sources



## Market research



- Secondary, open access to everybody
  - Trade associations
  - Published studies
  - Government sources
  - Consultant firms, multi-client studies
  - Cost: medium
- Primary, studies based on
  - Questionnaire (conjoint analysis),
  - Telephone survey
  - Customer interviews
  - Field work
  - Focus groups
  - Cost: high



## 5. Stage of development



- Understanding
- Ability to understand the IP
- Reduction
- Simulation/Experimentation has been done
- Trial History (Medical/ Health Sciences)
- certain information required by the regulatory processes has been compiled.
- Prototypes
- The technology demonstration has occurred
- Production
- Amount of scale up needed
- Financial
- Investment needed for development
- Investment needed for use

Interrelated with the next pillar(Inventors!)



# **6. Commitment/ Experience of inventors**



- Lead Inventor Profile
- Scientific reputation of Group.
- Existence of a Project "Champion"
- Level of support available.
- Existing commercial Links

The importance of this issue is often underestimated



### **Due dilligence**



- The Assessment Process includes a due diligence process to establish whether the invention can be protected..
- Many Universities have developed Disclosure Forms that will also permit full Due Diligence to commence <a href="http://www.isis-innovation.com/researchers/IP-1.pdf">http://www.isis-innovation.com/researchers/IP-1.pdf</a>

 Some have Disclosure and Due Diligence in a single booklet which covers all aspects of the University IP Policy www.brookes.ac.uk/res/policies/ip policy.pdf

The purpose of this form is to record and provide information in assist the University to accommend the lagest than any appealed their price claims to infliction growper years and commend the lagest than a provided their provided that the provide			
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Two thing title or brief description of the Intellectual property  Your full name and title  Please list at the Individuals who you consider to have made an identificable active or the Intellectual property. Vice not a rich of the Individuals who controlled to the code are as it inventions of the intellectual property.  Each Christ controlled to 18 seasons comprise from IP1. Prease provide deaths below IP1 to Individuals with controlled to the code are affected in the IP1 to Individuals with a IP1 to	Please	ertent public disclosure of your i e use Confidential Disclosure .	invention please consider all discussions about the invention
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# **Structured Tools & Methodologies**



### Methodologies developed by various TT offices

E.g. The Texas TechAssess™ Scorecard: An assessment tool used to organize and communicate the various business aspects that affect the ability to successfully transfer technology.

 Do not blindly apply – be critical – adapt to your needs and to the extend that it is useful

#### **Numerical evaluation sheets**

- Help in avoiding missing something we should consider. (useful check lists)
- BUT do not rely just on a number to take a decision!
   49% out? 50% in?
- Use spreadsheet analysis to inform not replace decision making.



## To summarise...



Good Technology and Market Assessment Decisions are:

Not the result of meditation or gambling!



#### BUT:

- Structured and Balanced (6 pillars)
- Based on informed decision and experience
- Consider multiple view-points

