

Training seminar



MANAGEMENT OF INTELLECTUAL PROPERTY RIGHTS

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PART 3

IPR: STRATEGIES, UTILIZATION AND ENFORCEMENT

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IP STRATEGIES

WHAT DO RESEARCHERS & STUDENTS NEED TO KNOW ABOUT IP

- ***How patents fit into the scientific literature as they can be used for scientific, legal and commercial purposes***
- ***How to read and interpret patents and other IP tools***
- ***Patents provide students with very current and authoritative information***
- ***Patents link scientific theory and practice-incorporate the “real world” applications***
- ***Patents can be used to illustrate the current history of science***

IP STRATEGIES

ENHANCE VALUE TO UNIVERSITY DISCOVERIES

- ***Disclose to IPO before publishing !!!***
- ***Keep detailed lab notebooks***
- ***Focus on need/end use***
- ***Include the patent database in your literature searches***
- ***Limit discussion with outside parties until a patent application is filed***
- ***Be familiar with patent literature***
- ***Understand competing technologies***
- ***Work closely with IP Office***

IP STRATEGIES

UNIVERSITY POLICY & MANAGEMENT ISSUES FOR CONSIDERATION

- 1. Commitment to commercialization (clear statement setting out the importance of IP management)***
- 2. Currency and review (updated and reviewed)***
- 3. Definition of IP (set out which types of IP are covered by the policy)***
- 4. Ownership of IP developed by staff, students, visiting researchers, technicians etc (who will own IP) and sharing the benefits***
- 5. Notification of inventions (Invention Disclosure)***
- 6. Confidentiality and withholding of publication***
- 7. Time limit for decision***
- 8. Laboratory notebooks***
- 9. Dispute resolution (mechanism for resolving disputes) and conflicts of interest***
- 10. Education and awareness***

IP STRATEGIES FOR UNIVERSITIES

- 1. Create awareness in your organisation for the importance of IP strategy***
- 2. Preserve confidentiality of new technology until professional advice has been sought***
- 3. Prepare a strategy, which aligns with your objectives***
- 4. IP strategy should lead business strategy***
- 5. Integrate IP process into the entire organisation***
- 6. Enhance the value of your organisation by using IP-driven Innovation***
- 7. Keep records on your inventions***
- 8. Systematically review your IP portfolio to maintain protection on current technology and drop protection on obsolete technology***
- 9. Gather market intelligence and analyse your competitors to avoid infringement and to challenge, if appropriate***
- 10. Use patents, trade secrets and publication to create value in your organisation***
- 11. Capture all your current and potential IP***
- 12. Defend your position in case of infringement***

POLICIES AND PRACTICES FOR A WINNING IP PORTFOLIO

- 1. Keep records***
- 2. Disclose inventions***
- 3. Technology watch***
- 4. Secure assignments of rights***
- 5. File promptly***

STEPS TO DEVELOP IP STRATEGY

(Source: WIPO)

- Check [trademark](#) databases to avoid using an existing trademark and protect trademarks before launching a new product or service with a new [brand name](#). It is important to consider export markets when doing so and avoid using brand names that may have an undesirable meaning in a foreign language.
- Identify [patentable](#) subject matter and make sure it is patented early enough to avoid losing the invention to competitors.
- Make sure that patentable inventions are not shared with others or published before filing a patent application. In order to meet the patentability criteria inventions must be considered “new”. Early disclosure of an invention (e.g. through publication) will compromise the chances of the invention being considered new, and therefore patentable.
- Make sure that [trade secrets](#) are kept within the enterprise and prepare, where appropriate, [confidentiality agreements](#) (see [IPR help desk](#)) when negotiating and sharing information with business partners in order to protect trade secrets.
- For export-oriented firms, make sure IP is protected in all potential export markets. In the case of patents, it is important to bear in mind that an enterprise generally has 12 months from the date of filing of a national application to file the same patent application in other countries.
- Use your IP portfolio as leverage when seeking sources to [finance your business](#) (e.g. include IP assets, particularly [patents](#), [utility models](#) and [industrial designs](#), in your [business plan](#) as it may help to convince investors of the market opportunities open to your enterprise).

STEPS TO DEVELOP IP STRATEGY (cont)

(Source: WIPO)

- Use patent information available in patent databases to develop your business strategies.
- When conducting joint research with other enterprises or research institutes, make sure that there is sufficient clarity on who will own potential IP generated from the research project.
- Monitor the market and make sure that your IP assets are not being infringed. If violation of your IP rights is detected it may be advisable to contact a lawyer (see also "What Should Your SME do to Resolve Disputes Related to Intellectual Property?").
- If you are unsure about how to best protect your company's intangible assets, conducting an IP audit may be a good first step in order to identify all your company's valuable information and to develop an IP strategy. On occasions, companies are unaware of the wealth of assets they possess in the form of information, creative ideas and know-how and may, therefore, not take adequate steps to protect them.

ENFORCEMENT OF IPR

➤ *Over the last decade, the counterfeiting and piracy phenomenon has risen to very dangerous dimensions and has become one of the most devastating problems facing world business.*

➤ *Counterfeiters have become extremely skilled entrepreneurs operating on a global scale. They make expert use of current technology and trade and succeed in producing every imaginable type of fake. Where previously only luxury goods, fashion and music and film products fell victim, nowadays, counterfeiting affects foodstuffs, cosmetics, hygiene products, medicine and spare parts of cars, toys and various types of technical and electronic equipment.*

➤ *Within the EU there are already a number of legal instruments in place, such as the [Enforcement Directive](#), but in order to make them more effective the EU is seeking stronger administrative cooperation between authorities at all levels in the fight against piracy and counterfeiting. (Consultation closed March 31, 2011).*

➤ *On September 2008 the Council adopted a Resolution on a comprehensive EU anti-counterfeiting and anti-piracy plan. This Resolution endorsed the need to step up the fight against fake goods and called for the creation of a [European Observatory on Counterfeiting and Piracy](#).*

http://ec.europa.eu/internal_market/iprenforcement/observatory/index_en.htm