





To patent or not to patent

an outside counsels **personal** perspective



- What is IP and Tech Transfer
- The IP process and costs

The Invention Disclosure

- We all know how to initiate a patent application, but no-one knows how to end it
- IP is **excluding** others from commercial exploitation
- So it is **ALL** about the money, and that should be the driving force



Tech Transfer

- Transfer back to the society....
- Not about creating a revenue stream for the university...
- IP is a means for “securing” tech transfer in fields with high risk profiles



The IP process

- Patentability search
 - Drafting
 - Prosecution
 - National phase & Issue
 - Opposition/Litigation
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- You spend your money in the beginning
 - know the consequences of the mistakes....



Not to...

- **KPI** - high volume, but your budget will never fit
- The **political** patent application
- **Insufficient** data - the invention is not conceived yet
- No clear **commercial** focus
- **More** than one invention
- Potential license fee would never even cover the cost of creating the IP
 - Never agree to let IP costs be deducted before your royalties



Maybe or yes

- Invention already disclosed...
- Data is sparse but promising...
- Strong commercial interest...
- A real need and valid suggested solution...



the next generation

- are the inventors capable of generating the next generation patent application
- or do they lose interest



Case I

- A professor with a strong scientific track record, creator of 2 start-up companies and with over a dozen successful patents behind him files an invention disclosure describing a new research tool for identifying therapeutics
- Application could cover the receptor mechanism and therapeutics mediating a function through the receptor
- You identify a huge interest in potential therapeutics mediating via this receptor



Life Science

- Medical devices
 - Instruments
 - Software related
- Diagnostics
- Research tools / production methods
- Therapeutics
- Biologics



Case II

- A professor have published data relating to a the correlation of a biomarker and an important disease. It is spot in of his groups main scientific interest and they have access to patient material
- A US based diagnostic firm contacts the University with interest in the project



Case III

- A professor have filed his own drafted patent application relating to an everyday product. This new product is slightly improved by a new production method
- The technical field is highly covered with patents from big industry and they are not interested in taking a license



Please rub me

- Don't worry about whether industry are stealing your invention - pray that they do
- You are not able to commercialize it...



The simple check list

- Technical results that commercially interesting - are they licensable
- Is it patentable - seek counsel
- Transfer it to industry as quickly as possible
- Create more data to support proof of concept



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