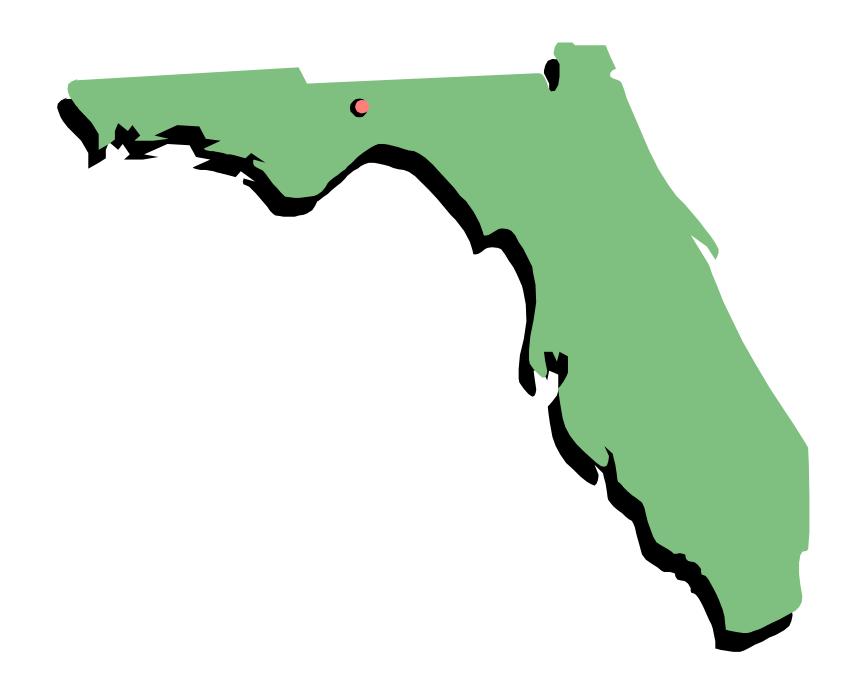
Scouting for IP-Based Technology Opportunities

John Fraser, President
Burnside Development and Associates LLC
WIPO EIE Kuala Lumpur
April 18, 2018
20 minutes

John Fraser

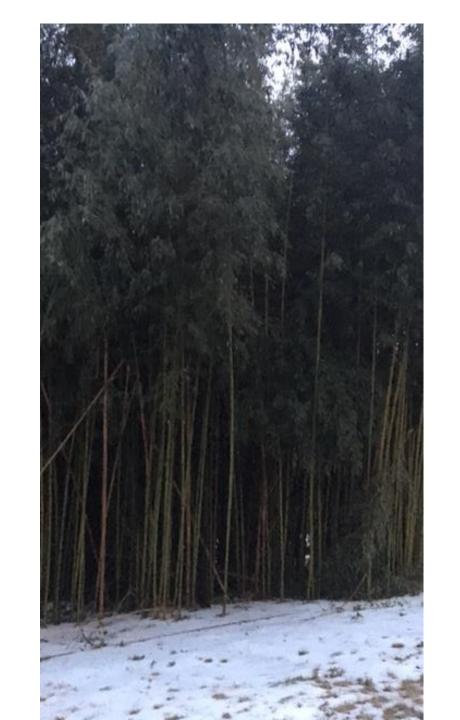
- President of Burnside Development, a technology transfer consulting firm. Clients in Chile, China, Serbia, USA, WIPO-Geneva.
- E-in-R, NIST a major national lab in Washington DC.
- President, Chair of the Board of AUTM in 2006-2007.
- Founder/Head of 4 Academic Technology Transfer Offices: 2 notfor-profit; 2 for-profit. 2 in US. 2 in Canada.
- Shareholder/Founder of 3 start-up firms.
- Former Assistant Vice President of Research, Florida State
 University, Tallahassee, Florida and Executive Director of the Office
 of Commercialization (2014-1996).
- VP of a seed stage venture Capital firm in Toronto, Canada











If you are the Scout for your corporation, you will need

- A clear written mandate and budgetary allocation to cover expenses
- A clear written target profile of what the company is looking for
- A clear release of time to perform this function or a written mandate under your current responsibilities
- A clear statement of decision-making process and personnel when you need advice or have a business opportunity to present for consideration
- A clear indication of what format is needed to be reviewed by senior management for a decision

Mechanisms for University-Corporation Interaction

- How do you find the faculty member who might be able to help you?
 - Go and ask a former teacher / professor
 - Technology Transfer Office University/Industry Liaison Office
 - Get started and make small incremental steps

• Mechanism:

- Visit together to talk
- Visit to company to talk/meet
- Consulting
- Research collaboration
- Research results on campus that might be developed into a new product for you.
- Jointly hunt money together.

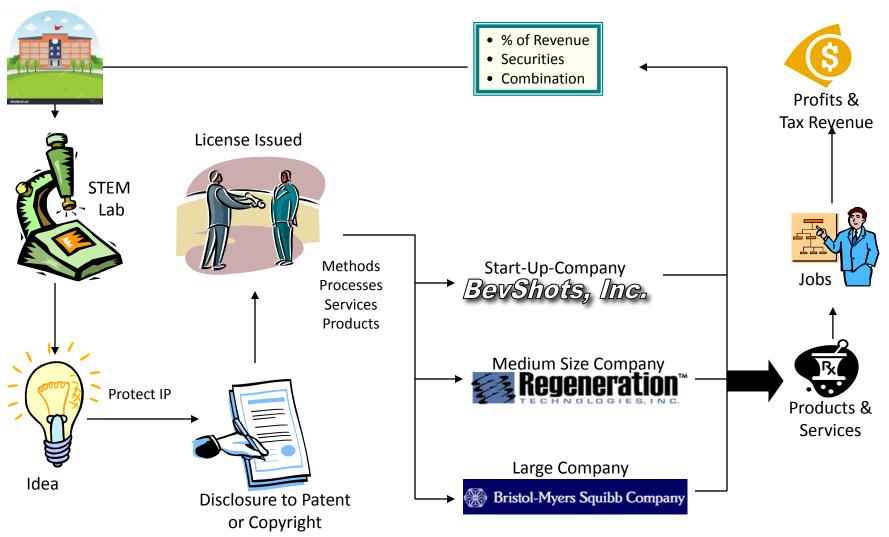
Importance of IP - Benefits

- IP Intellectual Property is Intellectual Potential.
- IP allows you to differentiate your product from a competitor, but only if you are willing to go to court and stop infringers to your IP.
- Acquisition of IP by License or Ownership (assignment) allows you to benefit from the work of others and acquire specific rights to exploit the IP in the marketplace.
- A patent right acquired by License is a right to exclude others from operating in the space defined by the Claims in the patent.

Importance of IP - 2

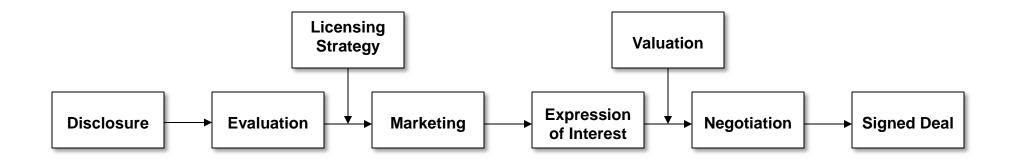
- IP allows you to take a product development and market risk and CAPTURE the return for yourself by excluding others.
- IP allows you to license someone else to co-market a developed product in a market you are not able to enter at the time of License and it allows you and them to carefully define what they can and cannot do in that market and what your compensation is.
- IP Licenses use standard language, which is included in the material on the presentation computer hard drive.

Lab To Market – A Chain of Value



By permission – the Florida Research Consortium 2008

The Technology Transfer Process



Real Benefits on a U-I Relationship

- Leverage of specialized public KNOWLEDGE/Capabilities over time
- Responding to government challenges
- New product or service potential opportunities
- Possible identification of new staff
- Building a broader network of knowledgeable people
- RISKS vs BENEFITS

THANK YOU

Q & A

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