

WIPO Enabling Intellectual Property Environment (EIE) Project

National Workshop 1 - IP Management & Technology Commercialization for Technology Managers of Hub & Spoke Institutions

organized by World Intellectual Property Organization (**WIPO**)
in cooperation with
Thailand's
National Science & Technology Development Agency (**NSTDA**),
Department of Intellectual Property (**DIP**)
and with assistance of the Japan Patent Office (**JPO**)

Bangkok, Thailand
12-16 June 2017

EIE National Workshop I - Thailand

Topic 5

Key Technology Transfer Office Functions

Technology Transfer system

License
Contract
Management

License Practice

Tech
Marketing

IP Management

Tech Evaluation
& Triage

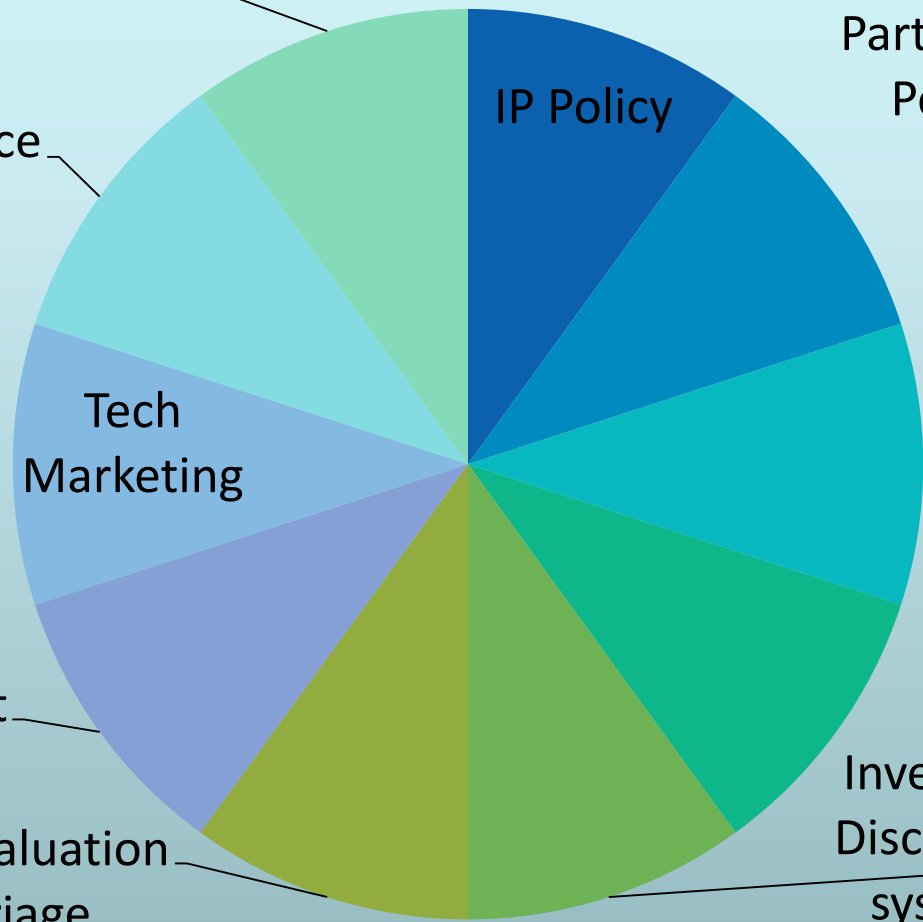
IP Policy

Industrial
Partnering
Policy

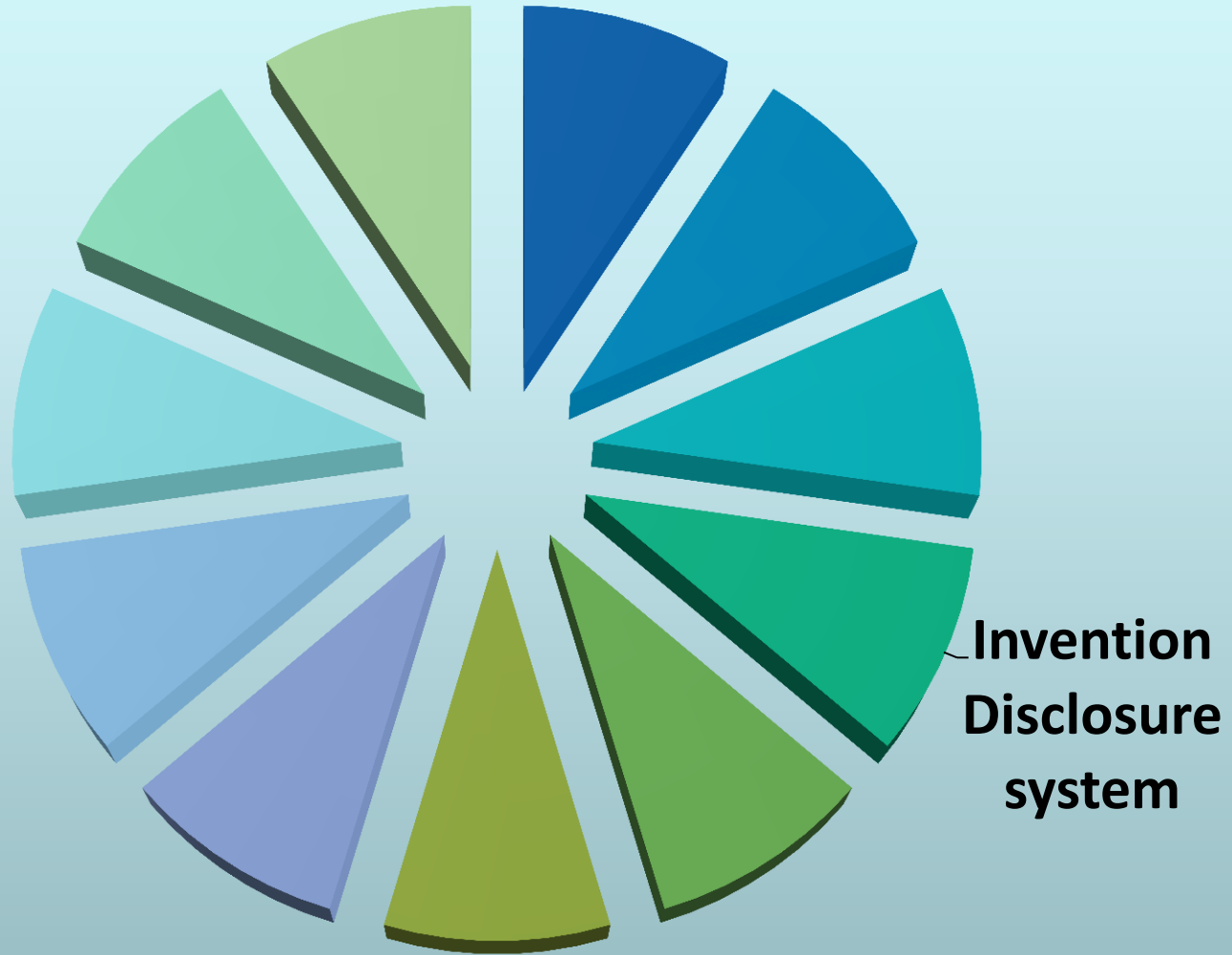
TTO governance,
organization,
operations

Invention
Disclosure
system

Outreach,
Inreach, PR,
TTO mkt



Technology Transfer



Invention Disclosure system

Where the TT process really begins

Structured form, and process

Adequate information capture

inventors, title, sponsorship, description,
etc.

Consider the burden on the inventor

On-line system

Systematic and error-free submission, safe-
keeping, and tracking

Effective archiving

Technology Transfer



Outreach, Inreach, PR & Marketing of TTO

Communicate value of TTO to senior leadership

Reaching out to faculty, staff, and students to increase awareness of IP/tech transfer

Increasing awareness of TT by potential industrial partners, govt partners, local government, alumni

Look for and promote good PR for TTO and university for tech transfer activities and successes

Invest in activities to promote the TTO and tech transfer process to stakeholders, constituents

Technology Transfer



**Tech Evaluation & Triage,
Pre-negotiation valuation**

Technology Evaluation, Triage, and pre-negotiation Valuation

Technology assessment & characterization

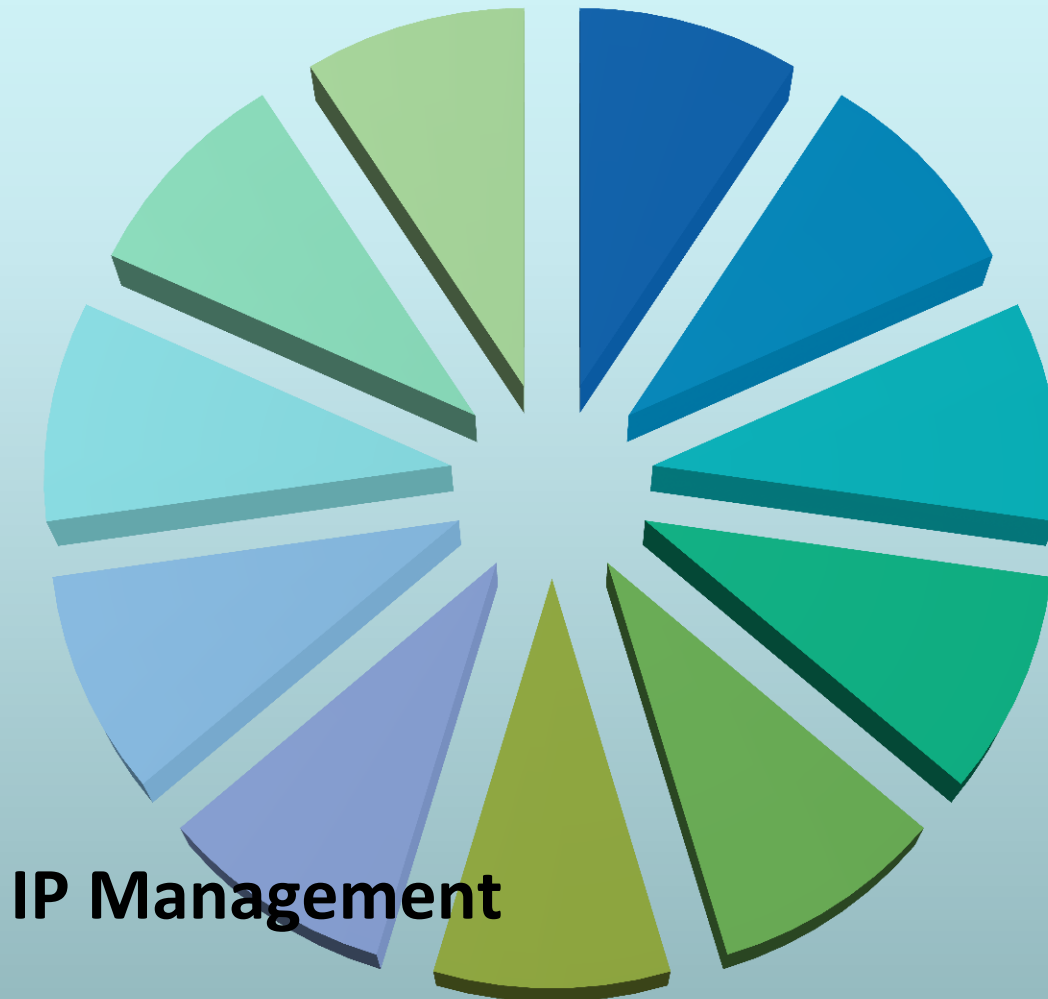
Market applications and potential
competitive advantages

Effective patentability (other IP/bioproperty)

The key decision: file or not to file?

Preliminary valuation as basis for negotiating
position

Technology Transfer



IP Management

NEVER lose IP rights by accident – only by choice!

Non-disclosure procedures

Property control position assessment

patentability, copyright, PBR, bioproperty, tradeseecret(?)

Prior art search and patentability decisions

Patent filing and prosecution

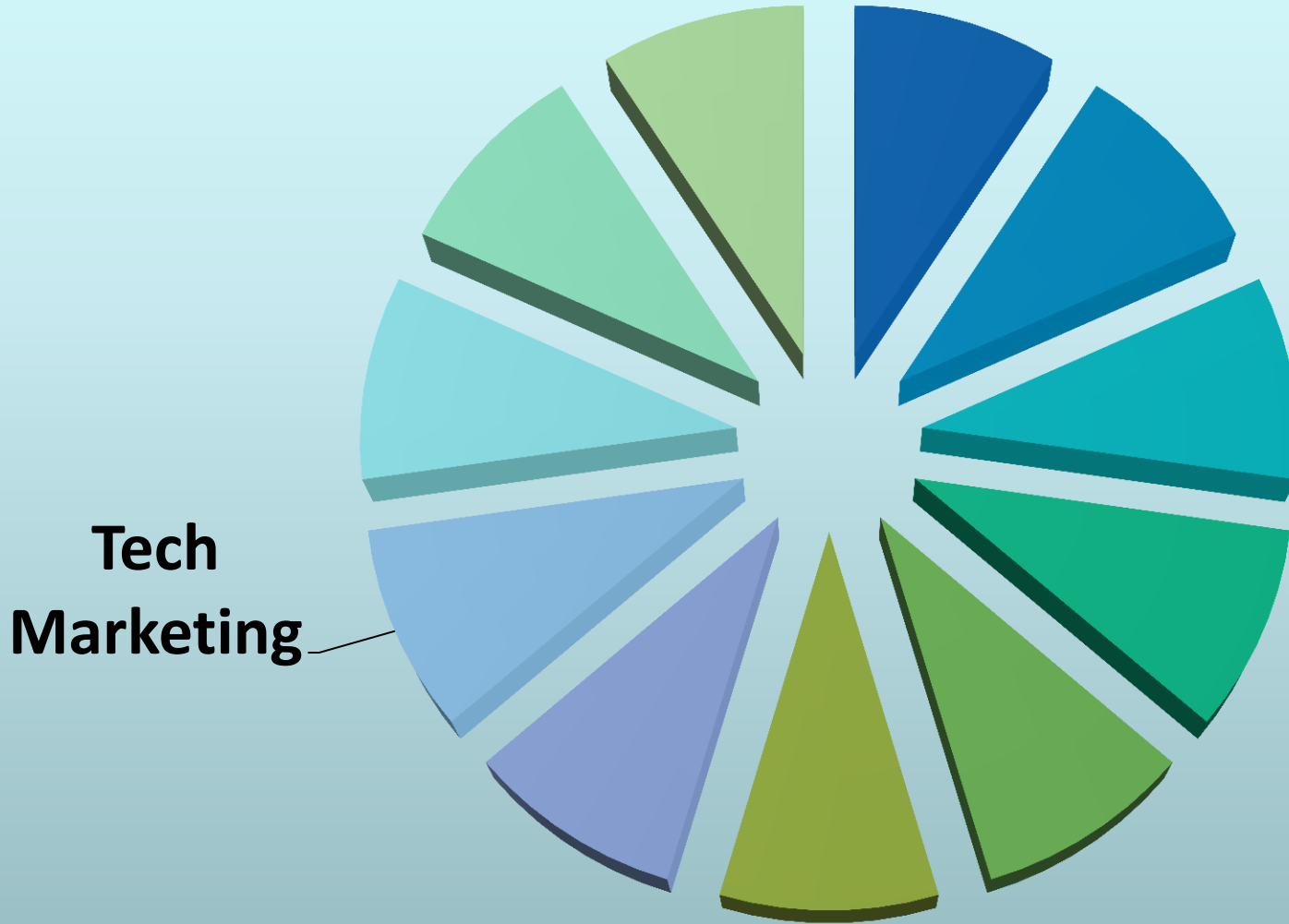
PCT and foreign filing decisions

Enforcement

Cost/benefit of filing decisions

Relationships with law firms

Technology Transfer



Technology Marketing

Finding commercial partners

Market application(s)

Research into companies in industry

Identification of potentially suitable partners

Marketing tools: passive & active

Contacts and follow-ups

Web-based tech marketing

Professional networking

Agents and brokers

Technology Marketing

Without marketing.....

technology is rarely transferred

Always be marketing your
technologies!

Technology Transfer

License
Practice



License Practice

Agreement templates

non-disclosure, material transfer, inter-institutional,
option, non-exclusive license, exclusive license,

License terms and conditions

Standard provisions

Non-negotiable terms

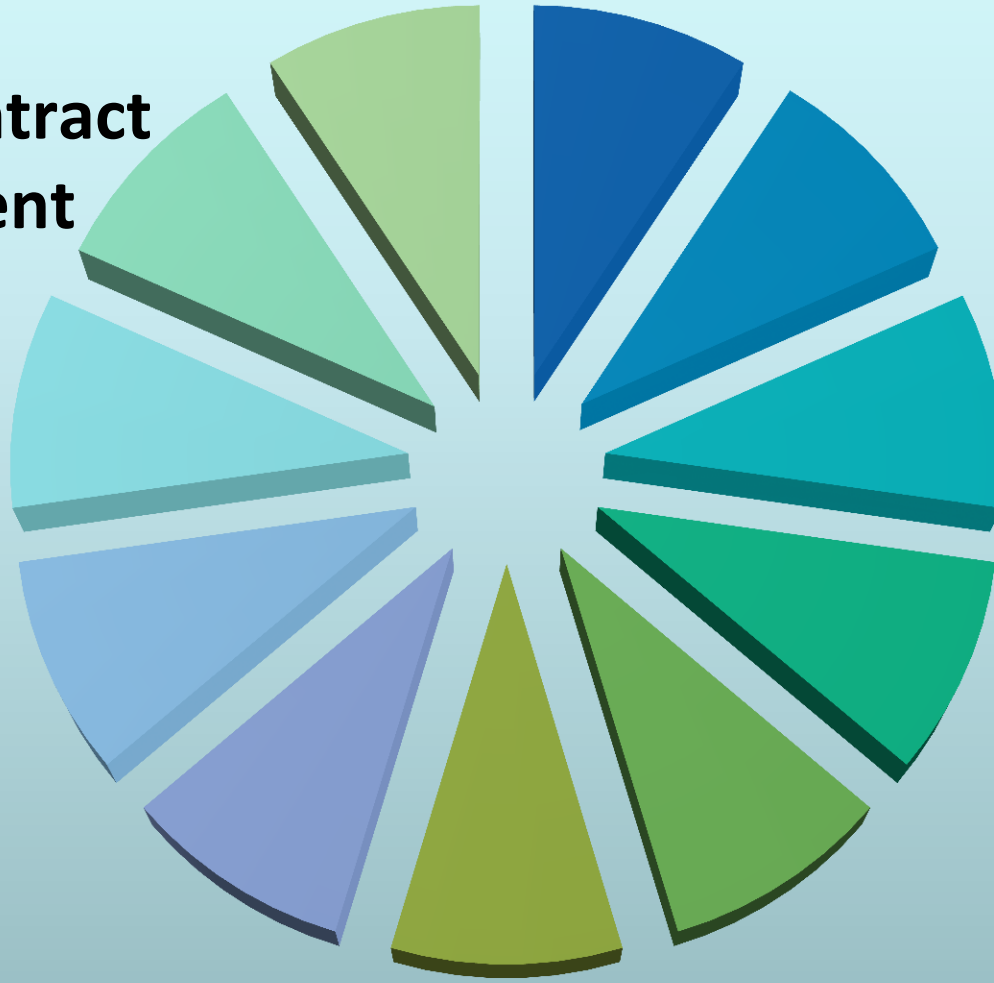
Financial mechanisms

Signature authority; get decision-maker commitment
before negotiations

Policy on exclusive licenses vs. non-exclusive

Technology Transfer

**License Contract
Management**



License Contract Management

Post-signing management

On-going monitoring of compliance

Managing problem contracts

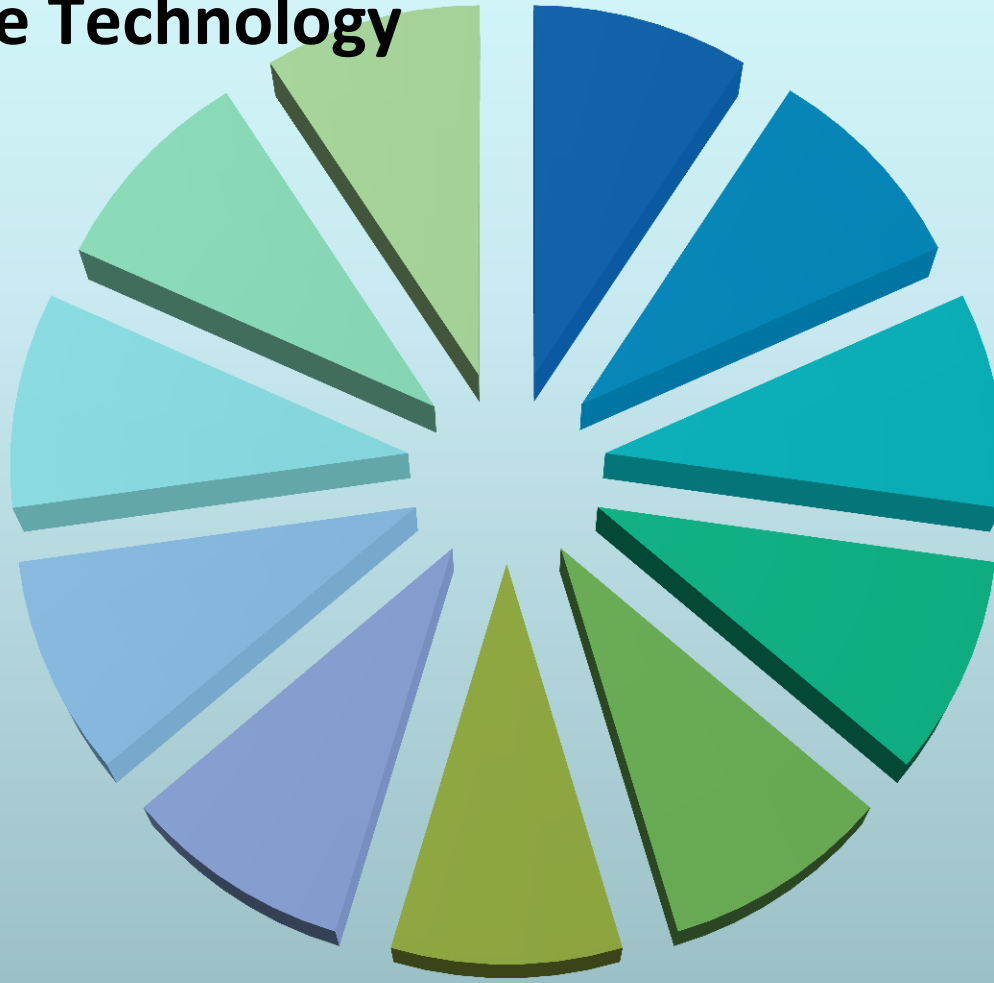
Accounts receivable

Income accounting and sharing distribution to recipients (inventors, university, etc)

What are we forgetting?

Technology Transfer

Viability Technology



Viable Technology

Novel, unique, and inventive (not obvious)

Commercially relevant, economically significant

Significant advantage over alternatives

Protectable with effective property right mechanisms

Technology Transfer: keys to success

A mindset that tech transfer is valuable

Support for tech transfer from top to bottom

Sufficient resources

Viable technologies

Effective policy framework and good IP management

Treat inventors well (like clients)

Understand for-profit sector needs

Marketing, marketing, marketing

Technology Transfer: keys to success

Well constructed contract templates; flexibility for adapting contracts to situation, licensee needs

Professional staff with right skill-set and attitude

More “good” deals, not few “great” deals

Sufficient back-office infrastructure (IP records, contract management, accounting)

Enlightened incentives for stakeholders

Timely and responsive, diligent follow-through, passion to get a mutually-satisfactory, sustainable deal done