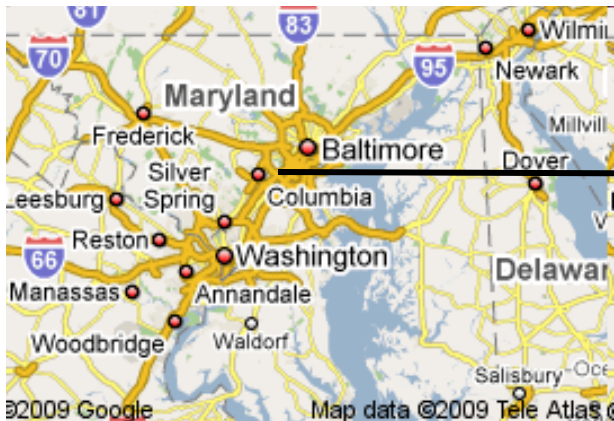


Scouting for IP-Based Technology

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Advanced Fluidics LLC &
ET Cube International

WIPO EIE Workshop
Kuala Lumpur, Malaysia
April 16-20, 2018



Motivation

Technology Scouting

University researchers come up with many good ideas and invention disclosures....

Industry/Start-ups can benefit from new ideas from University

OUTLINE

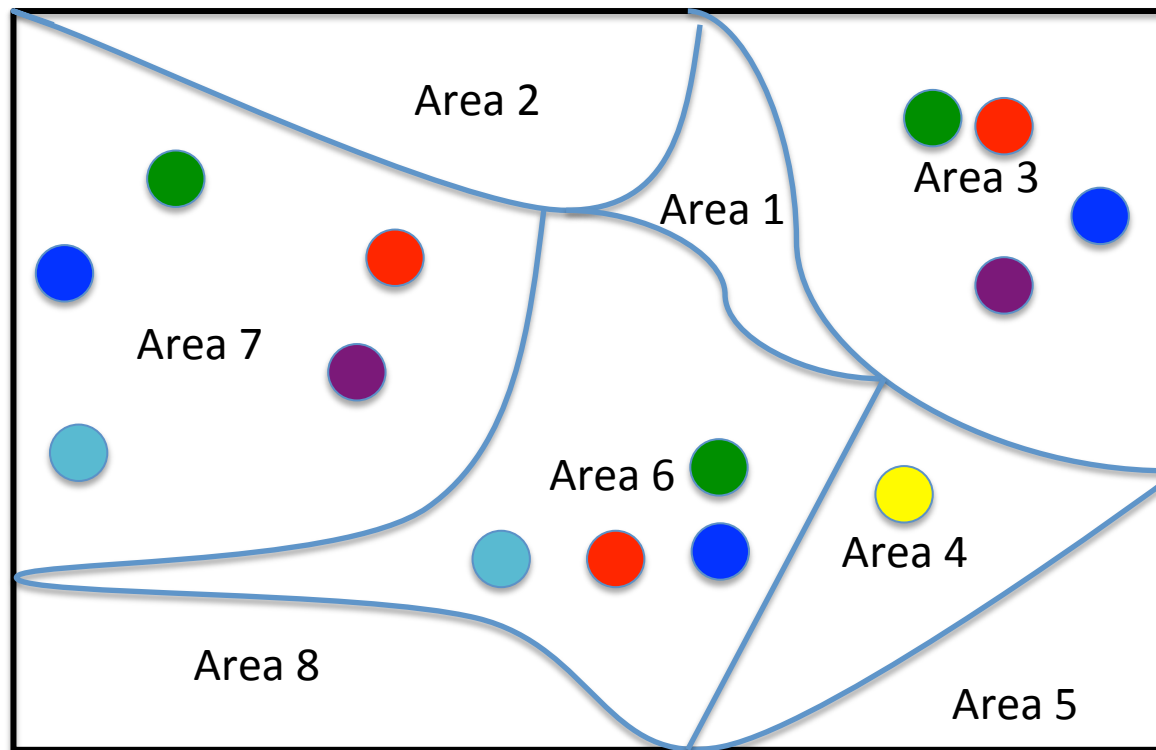
Identifying Opportunities for collaborative work

Key Issues

Conclusions

“PatentScapes” or “TechScapes” to Identify Opportunities for Start-ups

Technology sectors



Companies



Area 2
Area 5
Area 8

**Start-up
Spaces
With
University
IP??**

Managing IP Costs

May be more economical to license from Universities than company investment in R&D

Long term relations with Universities can also be useful for R&D collaborations and high-quality employee hiring

Managing Risks

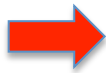
What are the risks involved in IP management?

Premature disclosures

Exclusive/non-exclusive license deals

Key Issues for IP Acquisition

Key Issues


- 
1. Non-confidential info, IP Documentation
 2. Development and licensing/acquisition agreements
 3. Open Source software issues
 4. Representations and Warranties related to Ownership of IP and pending disputes
 5. Representations and Warranties related to IP Infringement
 6. Websites and Social Media content related to IP
 7. Scope of Indemnification on IP Issues
 8. Disclosure and IP Transfer schedules

IP Documentation

1. Patent Application
2. Technical design and data
3. Pending Publications

Key Issues for Acquisition

Key Issues

1. IP Documentation
-  2. Development and licensing/acquisition agreements
3. Open Source software issues
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Development Agreements


What is the arrangement for further work on the topic?

University alone or University/licensee or licensee alone?

Conditions for licensing of further University IP? First right?

Key Issues for Acquisition

Key Issues






1. IP Documentation
2. Development and licensing/acquisition agreements
-  3. Open Source software issues
4. Representations and Warranties related to Ownership of IP and pending disputes
5. Representations and Warranties related to IP Infringement
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Open Source Software Rights

Open Source software rights may not be transferable??

Key Issues for Acquisition

Key Issues

1. IP Documentation
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IP Donations

Why donate IP to Universities?

Companies get tax benefits by patent donation?

IP Donation by Companies

Company	What was donated	Received by	Year
Dupont	257 Patents	DEDO	2007
Dupont	Patents for a new papermaking technology	University of Maine	2001
Dupont	\$64 Million worth of patents	Penn State U. of Iowa VPI	1999
Boeing	Patents for Medical applications	U. Penn	2001
Proctor and Gamble	196 patents	Vanderbilt	2000
Shell	> \$83.5 Million	U. Texas	

Donation by Free-Licensing

Company	What was licensed	Received by
Syngenta	technology to produce vitamin A enriched rice	Golden Rice Patent Pool
Boehringer Ingelheim	Granted free-licenses of patents covering a HIV drug for a period of 5 years to Aspen Pharmacare	Aspen (SA Company)
Novartis, Roche	Do not file or enforce patents in least developed countries	

Summary

Universities are a good source of IP for companies

Manage risk through proper understanding and negotiation of terms

Room to develop innovative interactions with University?

THANK YOU!

The importance of Intellectual Property (IP): Scouting for IP-based technology acquisition

Key Issues:

(Ref: (www.forbes.com) 2016/03/17/ Harroch, Lipkin and Smith