



WIPO Toolkit for Academic Institutions – Connecting Research with Economy and Society

Mr. Michal Svantner

Director

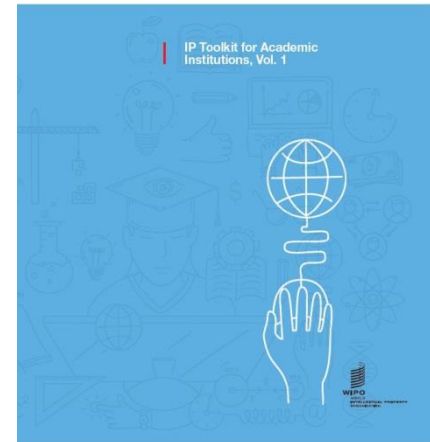
Department for Transition and
Developed Countries

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Volume 1

- IP Policy Template

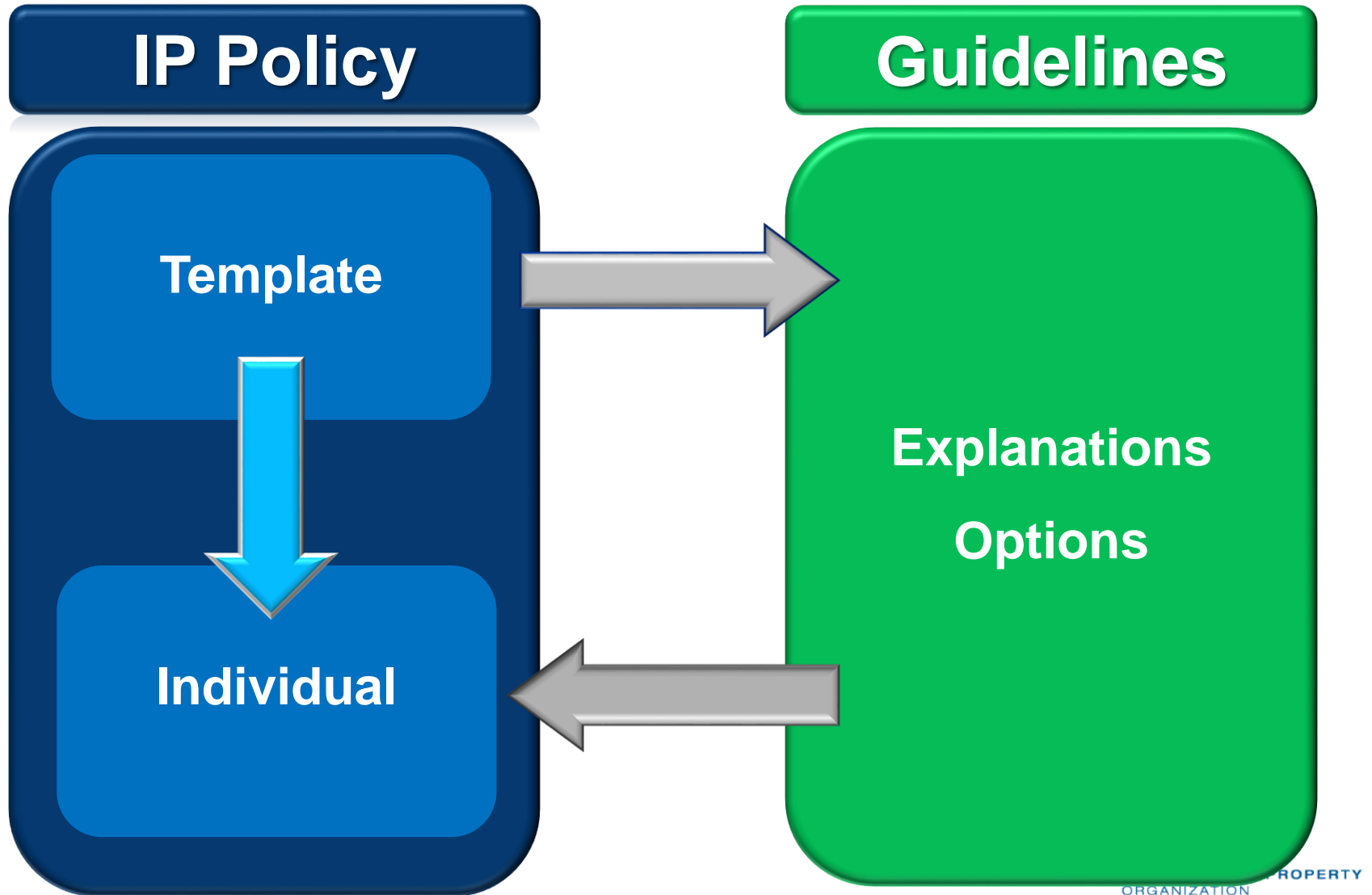


- Guidelines for customization

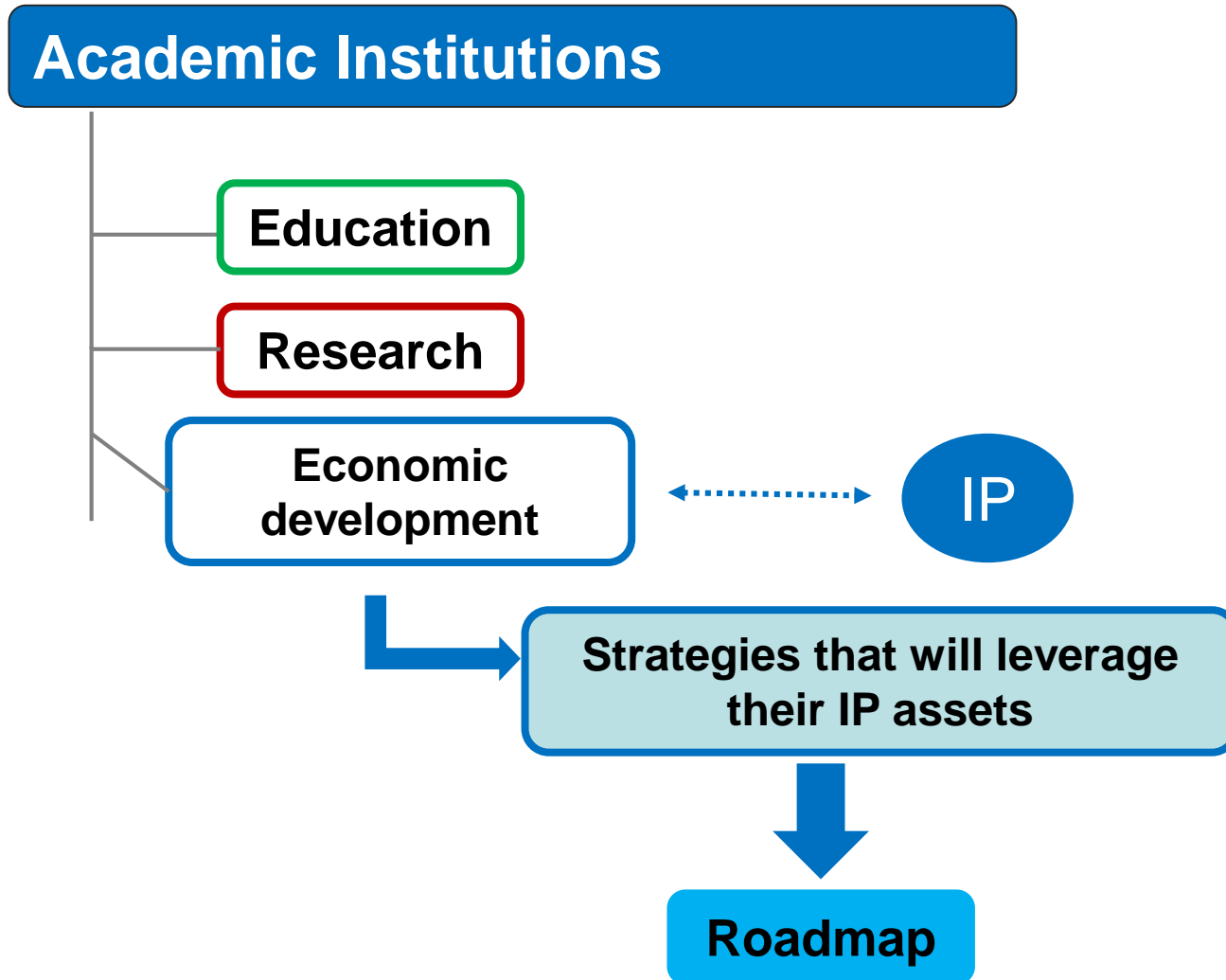
- Policy Writers Checklist



How it works



Importance of institutional IP policies

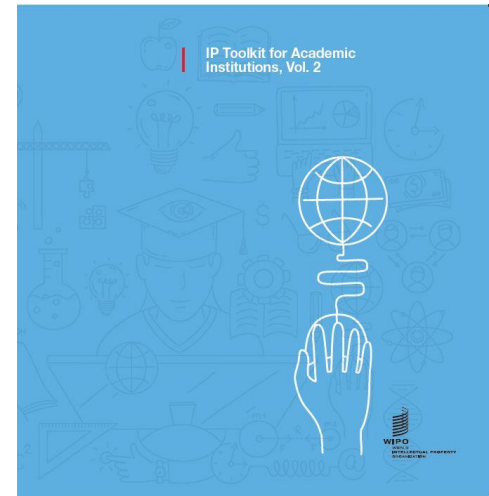


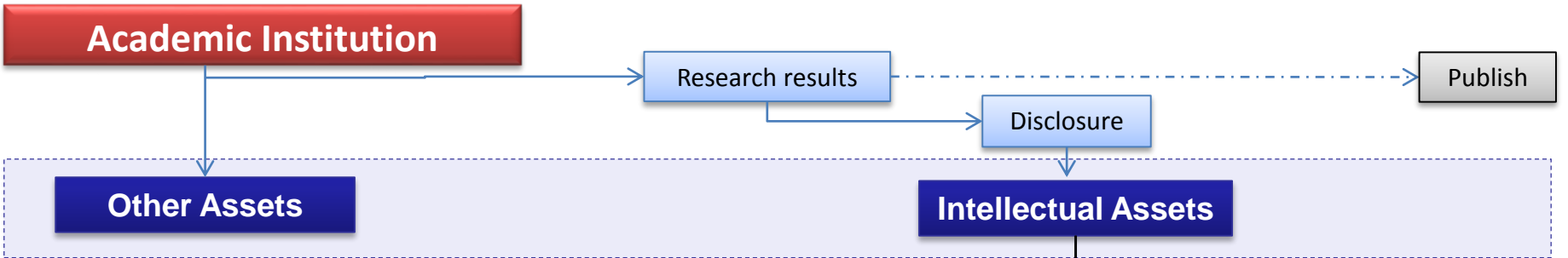
Volume 2

■ Roadmap for Commercialization

■ Model Agreements

■ Hypothetical Cases





- Collections of information (uncompiled and/or raw data, historic libraries, questionnaires, etc.)
- Collections of objects (materials) (biobanks, patient material, cell lines, animal model, historic objects, samples, etc.)
- Research infrastructure
 - Human Capital
 - Equipment
 - Labs
 - Capacity
 - Research Funds
- Collaboration support organisation
- License(s) – Certification to practice
- Access to patients
- Access to public funding
- Reputation
- Entrepreneurial culture
- ...
- Etc.

Knowledge (un-protectable IA by IP law)

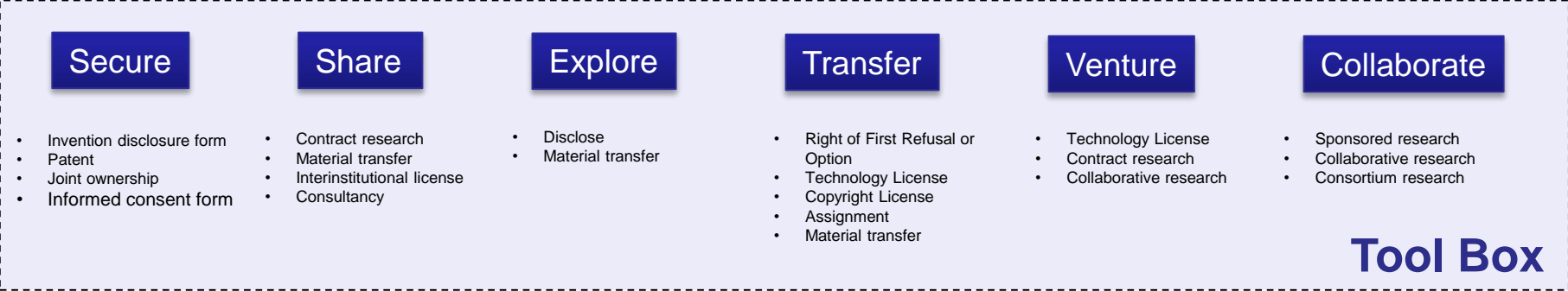
- Know-how
- Expertise
- Proprietary information
- Ideas/concepts
- Theories
- Rationales
- Observations
- Theoretical frameworks
- Solutions
- Instructions
- ...
- Etc.

Intellectual Property (protectable IA)

- Patents and patentable inventions
- Industrial design rights and protectable designs
- Copyrights and artistic works
- Database rights and databases
- Layout designs (topographies) and integrated circuits
- Plant breeders rights and new plants varieties
- Trade secrets
- Software

Roadmap = Utilization Strategy

Utilization Actions



Tool Box

Utilization Actions

- **Secure:** Secure ownership and/or freedom to use of the asset(s)
 - identify disclosed asset
 - determine owners
 - seek intellectual property protection, if appropriate (patent, copyright, trademark)
 - other protection, if government certification is not available (trade secret, collections, Know-How)
- **Share:** Offering the asset(s) to be used by 3rd parties for a commercial fee
 - marketing campaign to make others aware of asset and its problem-solving potential (leads to contract research, transfer of materials, consultancy, Inter-Institutional agreement for jointly owned assets)
- **Explore:** Offer the asset(s) to 3rd party in order to evaluate utilization potential
 - disclose assets
 - evaluate utilization potential by internal assessment and prototyping by external assessment and perhaps evaluation license
- **Transfer:** Assignment of ownership or licensing of utilization rights of the asset(s) to a 3rd party for the purpose of utilization
 - Right of First Refusal or Option to Acquire or License
 - License of defined rights
 - Sell or Assignment
- **Venture:** Transfer to a dedicated spin-off company for the purpose of utilization
 - new entity can acquire License, undertake contract research, participate in Collaborative research
- **Collaborate:** Pool own and 3rd party assets with the purpose of conducting research and/or utilization
 - contribute asset to multi party relationship focused on research and problem solving (via agreements for Sponsored Research, Collaborative research, or Consortia)
 - marketing campaign to make others aware of asset and its problem-solving potential (leads to contract research, transfer of materials, consultancy, Inter-Institutional agreement for jointly owned assets)

The Model Agreements

Toolbox			
index	Guidelines	index	Models of Agreements
	Introduction to Guidelines		
A	Informed Consent	A	Informed Consent Form
B	Invention Disclosure	B	Invention Disclosure Form
C	Intellectual Property and Commercialisation	C.1	Intellectual Property Policy
		C.2	Commercialisation Protocol
D	Confidentiality Agreement	D	Confidentiality Agreement
E	Rights of First Negotiation and Options to Negotiate	E.1	RoFN Agreement
		E.2	Option Agreement
F	Joint Ownership of Intellectual Property	F	Joint Ownership Agreement
G	Material Transfer Agreement	G.1	Material Transfer Agreement (academic)
		G.2	Material Transfer Agreement (commercial)
H	Research Agreements	H.1	Contract Research Agreement
		H.2	Sponsored Research Agreement
		H.3	Collaborative Research Agreement with Company
		H.4	Collaborative Research Agreement between Research Organisations
I	Consulting Agreement	I	Consulting Agreement
J	Exclusive Technology License Agreement (with options for patents, software, know how)	J.1	Exclusive Technology License Agreement
		J.2	Exclusive IP License Agreement
		J.3	Exclusive IP and Technology License Agreement
K	Exclusive Copyright License	K	Exclusive Copyright license
L	Inter-institutional License Agreement	L	Inter-institutional License Agreement
M	Consortium agreement		n.a.

Tool Box – Hypothetical Case Studies – Base for Capacity Building Programs

■ HYPOTHETICAL CASE STUDIES

- MATERIAL TRANSFER AGREEMENT (COMMERCIAL);
- EXCLUSIVE LICENSE;
- CONTRACT RESEARCH AGREEMENT;
- COLLABORATIVE RESEARCH WITH COMPANY;
- OWNERSHIP OF IP.

Reshaping Tool Box into a Toolkit

- Development of the standard program for capacity building trainings;
- Accompanying presentations – to facilitate trainings;
- Train the Trainers Programs – for academic institutions but also for IP Academies.

Conclusions

- Develop **your own** Institutional IP Policy !
- Involve **all stakeholders** (researchers, students, local firms) – it has to be their policy as well.
- Language and content should be “**user friendly**” and understandable also for those who are not lawyers.
- **Communicate** the text, make it publically available.
- It may be helpful to have **models (templates)** of the main technology transfer agreements – with the understanding that it should be used as a base – each situation has its own specificity.
- **Monitor** implementation, evaluate and improve.
 - **It is a dynamic process!** The IIPP is a living document, adjusting over time to the needs of a given institution to ensure a best fit.



Thank You

Michal Svantner

Michal.svantner@wipo.int