

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**)

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EIE National Workshop I - Thailand

Topic 14

Management of IP and other Property Protection

Managing IP & Other Property Protection

- In your triage, you've determined that cost-effective IP and/or bioproperty is possible
- Now, link the possible IP/bioproperty with the potential applications and value of the technology you've uncovered in your initial evaluation/triage
- What is cost/effective IP/bioproperty strategy given the potential applications and value of the invention?

Managing IP & Other Property Protection

- Is a Utility Model approach sufficient given the uniqueness and value of the invention?
- Is a Philippine patent sufficient?
- Is there sufficient global potential to warrant a PCT?

Managing IP & Other Property Protection

- Be very aware of the link between scope of potential patent claims and value in the marketplace

Example: patent claims on

“A ball-point, ink pen”

versus

“A blue-striped, ball-point, ink pen”

16 billion manual writing implements
(all pens, pencils sold per year)

5 billion pens sold per year

4 billion ball-point pens sold per year

150,000 blue stripe, ball point pens
sold per year



Managing IP & Other Property Protection

- Be very aware of the link between scope of potential patent claims and value in the marketplace

Example: patent claims on

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versus

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Don't pursue patent claims that have little or no value in the marketplace

Managing IP & Other Property Protection

Consider the “suite” of your property control options:

patent

know-how

copyright

plant breeder's rights

trademark

bioproperty

Managing IP & Other Property Protection

Managing bioproperty:

It's tangible, personal property rules

(possession is primary, bailment secondary)

Material Transfer Agreements

(has ownership been maintained regardless of physical transfers/)

Managing IP & Other Property Protection

Managing the patent prosecution

- Hand-pick IP law firms that are willing to work closely with you to manage costs
- Negotiate billing rates, “bulk pricing”, not-to-exceed price caps, etc.
- Require close coordination between IP lawyer, inventor, Tech Manager (Tech Mgr has final say)
- Be sure your patent attorney understands the market value scope of claims (no “blue stripe pens”)
- Stay on top of attorney’s change of claim scope – don’t be surprised by changes that don’t fit market value

Managing IP & Other Property Protection

Managing the patent prosecution

- Balance the patent prosecution (i.e. claim scope) strategy with information learned in marketing the technology
- Be aware to adjust claim scope with new market-based information

Managing the Patent Prosecution

How to involve your licensee

- Do not give licensee control
- Do give licensee every opportunity to have input into prosecution
- TTO (Tech Mgr) retains final say
- Exclusive licensees should pay (reimburse) all patent expenses) – field of use licenses are trickier

Managing Patent Cost

- Try to find, negotiate, and sign an exclusive licensee as soon as possible, so they pay your patent expenses
- PCT costs can be spread out over 30+ months so find a licensee that will pay these expenses ASAP
- PCT: initially designate all countries; pare down list of countries before national phase