



NATIONAL SCIENCE
AND TECHNOLOGY
DEVELOPMENT AGENCY



DEPARTMENT OF
INTELLECTUAL
PROPERTY



MAHIDOL
UNIVERSITY



JAPAN PATENT OFFICE



NATIONAL WORKSHOP

WIPO/IP/UNI/BKK/18/INF/1
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National Workshop Two on Intellectual Property (IP) Commercialization in the Framework of the Enabling IP Environment (EIE) Project

organized by
the World Intellectual Property Organization (WIPO)

in cooperation with
the National Science and Technology Development Agency (NSTDA), Thailand and
Mahidol University, Thailand

and with the assistance of
the Japan Patent Office (JPO)

Bangkok, Thailand October 8 to 12, 2018

PROGRAM

prepared by the International Bureau of WIPO

Monday, October 8, 2018

For participants from Hub and Spokes

9:00 – 9:15 **Welcome Addresses by:**

Acting Vice President for Research, Mahidol University

Mr. David Simmons, Counsellor, Regional Bureau for Asia and the Pacific, World Intellectual Property Organization (WIPO), Geneva

9:15 – 9:45 **Introduction of faculty, participants, and Overview of the Workshop**

Mr. Richard S. Cahoon, President, BioProperty Strategy Group Inc./
Adjunct Professor, International Programs, Cornell University, Ithaca,
New York (NY), United States of America (USA)

9:45 – 10:00 **Enabling the Intellectual Property (IP) Environment (EIE):**

- **Project Overview;**
- **Current Status, Developments & Upcoming Activities**

Ms. Yumiko Hamano, IP Consultant, Partner, ET Cube International,
Echenevex, France

10:00 – 11:00 **Roundtable: Spokes & Hub raise IP management / Technology Transfer issues**

All the Spokes & Hub given approximately 10 minutes to present their issues

11:00 – 11:15 Coffee/Tea Break

11:15 – 12:15 **Roundtable: Addressing issues raised by Spokes & Hub**

12:15 – 13:15 Lunch Break (working lunch)

Presentation: Mr. Steve Susalka, Chief Executive Officer, Association of University Technology Managers (AUTM)

13:15 – 14:15 **Invention Disclosure Triage:** Extension of Workshop I concepts

Mr. Richard S. Cahoon

Ms. Yumiko Hamano

14:15 – 15:15 **Technology Characterization, Evaluation, Assessment; Activities to Prepare for Licensing**

Mr. John A. Fraser, President, Burnside Development and Associates LLC,
Bethesda, Maryland (MD), USA

Mr. Surya Raghu, Chief Executive Officer, Advanced Fluidics LLC, Partner,
Columbia, MD, USA

15:15 – 16:00 **Team Exercise:** Spokes' Triage their Technology

16:00 – 16:15 Coffee/Tea Break

16:15 – 16:45 **Team Exercise:** Spokes report on their Technology Triage

16:45 – 17:30 **The Crucial Convergence:**

1. **Potential patent/IP scope;**
2. **Technical Performance;**
3. **Market Relevance**

Mr. Richard S. Cahoon

17:30 End of Day 1

Tuesday, October 9, 2018

For participants from Hub and Spokes

- 8:30 – 9:00 **AUTM Presentation**
Mr. Steve Susalka
- 9:00 – 10:00 **More Technology Characterization: Completing Phase II of Triage Evaluation**
- **Evaluation, Assessment, Market Viability;**
- **Market Relevant Claims;**
- **Tech Brief as Process and Product**
Mr. Richard S. Cahoon
- 10:00 – 10:45 **Exercise:**
- **Technology Evaluation; Drafting the Technology Brief**
Mr. Richard S. Cahoon
- 10:45 – 11:00 Coffee/Tea Break
- 11:00 – 11:30 **Market Assessment 1:**
- **Market Description - Technology Push vs. Market Pull;**
- **Top-down vs. Bottom-up approach to market estimation- Competition Analysis**
Mr. Surya Raghu
- 11:30 – 12:00 **Market Assessment 2:**
- **Understanding the Criteria using AF case**
Ms. Yumiko Hamano
- 12:00 – 12:30 **Market Assessment 3:**
- **Finding Market Information;**
- **Scope/Extent of Information to be gathered and used**
Mr. John A. Fraser
- 12:30 – 13:15 Lunch Break
- 13:15 – 14:45 **Exercise:**
- **Market Research / Assessment for Spokes' Technology;**
- **Continue Drafting Tech Brief**
- 14:45 – 15:30 **Licensing Strategy, Finding Potential Licensees, Preparing for and Starting Tech Marketing**
- **Licensing to Domestic & Foreign Companies**
Ms. Yumiko Hamano
- 15:30 – 15:45 Coffee/Tea Break
- 15:45 – 16:30 **Research Tools for Finding Potential Licensees**
Mr. Eric Deleglise, Business Development South-East Asia, Questel, Singapore

- 16:30 – 17:15 **Exercise:**
- **Research Tool Practice;**
 - **Begin List of Potential Licensees**
- 17:15 – 17:45 **AIM & AUTM: The Professional Thai TTO Organization**
- Mr. Steve Susalka
- 17:45 End of Day 2

Wednesday, October 10, 2018

Audience: participants from Hub and Spokes (Room A)

Note: This session runs in a separate room and in parallel to the session for Intrapreneurs / Company attendees. Therefore, there are two different programs for the Spokes and the Intrapreneurs / Company Attendees for this day.

9:00 – 9:45 **Institutional Mission & the Licensing Imperative, License Agreements as Value-capture Envelope, Intro to Pre-negotiation Valuation**

Mr. Richard S. Cahoon

9:45 – 10:30 **Exercise:**
- **Defining a License Value-envelope for a Technology**

Mr. Richard S. Cahoon

10:30 – 10:45 Coffee/Tea Break

10:45 – 11:30 **Key License Terms; Term Sheets Drafting & Negotiation**

Ms. Yumiko Hamano

11:30 – 12:15 **Developing the TTO's Commercialization Vision**

Mr. Richard S. Cahoon

12:15 – 13:00 Lunch Break

13:00 – 13:45 **Cost-effective IP Strategy / Management: Where to File Patents; Other Types of Valuable IP (e.g. Software, Copyright, etc.)**

Ms. Yumiko Hamano

Mr. Surya Raghu

13:45 – 14:30 **Bioproperty Management and Licensing; Plant Variety IP & Licensing**

Mr. Richard S. Cahoon

14:30 – 15:15 **Win-Win License Negotiations; Closing the Deal; International Licensing**

Mr. John A. Fraser

15:15 – 15:30 Coffee/Tea Break

15:30 – 16:00 **Exercise:**
- **Spokes Develop Their Technology Term Sheet**

Ms. Yumiko Hamano

16:00 – 16:45 **Software Licensing:** Open Source Code, Big Data Ownership, etc.

Mr. John A. Fraser

16:45 – 17:15 **Exercise:**
- **Continue Tech Brief / Term Sheet Development**

Ms. Yumiko Hamano

17:15 – 17:45 **Summary, Q&A, Roundtable Discussion**

17:45 End of Day 3 (for Spoke participants)

Wednesday, October 10, 2018

Audience: Intrapreneurs / Company Attendees (Room B)

Note: This session runs in a separate room and in parallel to the session for participants from the Hub & Spokes. Therefore, there are two different programs for the Spokes and the Intrapreneurs / Company Attendees for this day.

9:00 – 9:15 **Self-Introduction of Intrapreneurs**

9:15 – 10:00 **Expanding Business through Open Innovation; Technology Acquisition & Partnering Benefits and Approaches: Why consider Universities for new Business Opportunities? (Pros and Cons)**

Mr. Surya Raghu

Mr. Eric Deleglise

10:00 – 10:30 **The importance of Intellectual Property (IP): Scouting for IP-based Technology Acquisition**

Mr. Surya Raghu

Mr. John A. Fraser

10:30 – 10:45 Coffee/Tea Break

10:45 – 11:30 **Introduction to Intrapreneurship; Overview of the Technology Transfer Process**

Mr. Richard S. Cahoon

11:30 – 12:15 **Licensing Explained, Licensee and Licensor Perspectives, Rights & Responsibilities, Risks and Opportunities**

Ms. Yumiko Hamano

Mr. John A. Fraser

12:15 – 13:00 Lunch Break

13:00 – 14:00 **More Details of the Technology Transfer Process:**

- **The University Position;**
- **Explained (University Approaches to Technology Transfer Collaboration;**
- **What the University will Offer and Why), the Information Gathering Stage,**
- **Negotiation Process - Information Exchanges,**
- **Confidential Disclosure Agreements (CDAs),**
- **Material Transfer Agreements (MTAs),**
- **Licensing Term Sheet**

Mr. Richard S. Cahoon

Mr. John A. Fraser

- 14:00 – 14:45 **Collaborative Research, Contracts, Licensing (and the Term Sheet), Consulting in more detail**
Ms. Yumiko Hamano
- 14:45 – 15:30 **A Licensor/Licensee dialogue: Key License Terms, the Term Sheet and Negotiations**
Mr. Richard S. Cahoon
Mr. Surya Raghu
- 15:30 – 15:45 Coffee/Tea Break
- 15:45 – 16:30 **Exercise:**
- **Practice Negotiation**
- 16:30 – 17:00 **Summary, Q&A, Roundtable Discussion**
- 17:00 End of Day 3 (for Company Participants)

Thursday, October 11, 2018

Audience: participants from Hub and Spokes (Room A)

Note: This session runs in a separate room and in parallel to the session for Intrapreneurs / Company attendees

9:00 – 10:00 **Technology Marketing (continued); Interacting with Licensees: the Process**

Mr. Richard S. Cahoon

Mr. Surya Raghu

10:00 – 11:00 **Complex (multi-party, multi-owner IP) Transactions; Know-how & Trade Secret Licensing**

Mr. Richard S. Cahoon

11:00 – 11:45 **Case Studies: JICA's International Cooperation in Science, Technology and Innovation (STI) & Innovative Business Support**

Mr. Toru Homma, Senior Advisor (Private Sector Development: Investment, Trade & Industry), Japan International Cooperation Agency (JICA)

11:45 – 12:45 Lunch Break*

** From the lunch break, Hub/Spokes & Intrapreneurs / Company sessions merge and follow the same afternoon program (see below)*

Thursday, October 11, 2018

Audience: Intrapreneurs / Company Attendees (Room B)

Note: This session runs in a separate room and in parallel to the session for participants from the Hub & Spokes

9:00 – 10:00 **How to Collaborate with Research Institutions**

Mr. John A. Fraser

10:00 – 10:45 **Structuring University / Industry Research Contracts**

Ms. Yumiko Hamano

10:45 – 11:45 **Partnering on the Commercialization Collaboration:
- Licensing, Consulting, Sponsored & Collaborative Research**

Mr. Richard S. Cahoon

Ms. Yumiko Hamano

Mr. Surya Raghu

11:45 – 12:45 Lunch Break*

** From the lunch break, Hub/Spokes & Intrapreneurs / Company sessions merge and follow the same afternoon program (see below)*

Thursday, October 11, 2018

Audience: For all Participants

- 12:45 – 13:45 **Introductions of Participants**
- 13:45 – 14:30 **Roundtable Discussion by Participants: the Benefits of Collaboration**
- 14:30 – 15:15 **Case Studies: What works, What doesn't**
Mr. John A. Fraser
Mr. Richard S. Cahoon
- 15:15 – 15:30 Coffee/Tea Break
- 15:30 – 16:00 **Case Studies: JICA's Development assistance in SME Promotion and Industrial Development**
Mr. Toru Homma, Senior Advisor (Private Sector Development: Investment, Trade & Industry), Japan International Cooperation Agency (JICA)
- 16:00 – 16:45 **Exercise:**
- **Mock Negotiation# between Participants**
- 16:45 – 17:30 **Summary, Q&A, Roundtable Discussion**
- 17:30 End of Day 4

Note for NSTDA: The mock negotiation on Thursday afternoon is intended to be the type where the two negotiating sides are given separate instructions to negotiate a deal. That deal can be quite difficult if they don't look for win-win. If they do look for win-win, they are much more likely to see the not-so-obvious solution to the negotiation. The take-home message is that fighting too hard for one's own position may make you blind to a win-win solution.

Friday, October 12, 2018

Audience: For all Participants

- 9:00 – 9:45 **Panel discussion: Updating Current Status of Thailand Bayh Dole Act (Thai Session) and Sharing Views on the Act**
- Panellists: Dr. Lerson Thanasugarn, National Science Technology and Innovation Policy Office
Assoc. Prof. Dr. Pongpan Kaewtatip, Thailand Research Fund
Assoc. Prof. Dr. Duanghathai Pentrakoon, Chulalongkorn University Intellectual Property Institute
Representative from SMEs: TBC
- Moderator: TBC
- 9:45 – 10:30 **Sharing Views form the US Bahy-Dole Practice, followed by Q&A**
- 10:30 – 11:00 Networking & Coffee/Tea Break
- 11:00 – 11:45 **Introduction of AIMS & its potential collaboration with AUTM**
- Representative from (Thai speaker TBD)
- 11:45 – 12:45 Lunch Break
- 12:45 End of Workshop

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