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CARL DUISBERG
GESELLSCHAFT e.V.



WORLD INTELLECTUAL
PROPERTY ORGANIZATION

WORKSHOP ON INNOVATION SUPPORT SERVICES AND THEIR MANAGEMENT

organized by
the World Intellectual Property Organization (WIPO)
and
the Carl Duisberg Gesellschaft (CDG)
in cooperation with
the German Patent and Trademark Office (GPTO),
the Aachen Corporation for Innovation and Technology Transfer (AGIT)
and
the European Patent Office (EPO)

Munich, Nuremberg, Aachen (Germany), June 12 to 22, 2001

**BAYERN PATENT - AN INITIATIVE FOR THE PROMOTION OF PATENTING AND
COMMERCIAL EXPLOITATION OF INVENTIONS AT BAVARIAN UNIVERSITIES**

*Document presented by Dr. Oliver Kemper, Licensing Manager, Fraunhofer Patent Center
for German Research (PST), Munich*



Bayern Patent

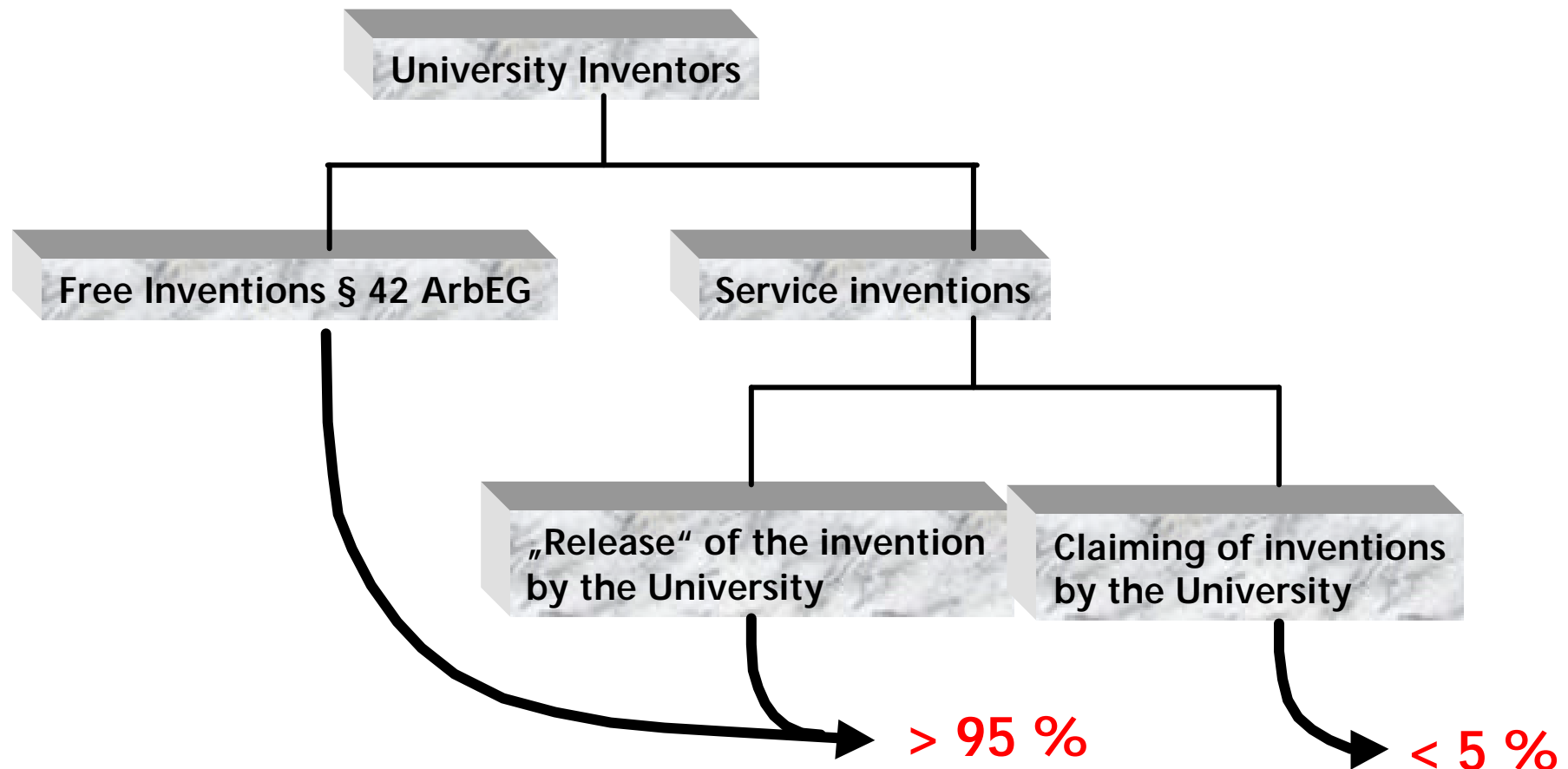
Die Bayerische Hochschul-Patentinitiative

An Initiative for the promotion of patenting and commercial exploitation of inventions at Bavarian Universities

Christian Stein, Koordinator
Oliver Kemper, Manager Licensing
Joachim Langstein, Manager Patenting
Markus Berg, Administrator



Different Types of University Inventions



Service Inventor - Free Inventor


Service Invention Law

Service Inventor:

- Employee under contract
- Notification of the Invention to the Employer, Release or Claiming of the Invention by the Employer within 4 Months

§42 defines free Inventors:

- **University Professors and Lecturers**
- **Scientific Assistants** (independent scientific Service in Research and Teaching, with the possibility of independent Research)
- **Students without contract like interns and scholarship holders**



§42

ArbEG

Fraunhofer-Patent center for German Research

Mandate: „ The Patent Center is tasked with consultation of free inventors, Universities, and Research Institutes, Support of selected Inventions and the Directing of Commercial Utilization of these inventions by Industry “

- **Foundation: April 01, 1955**
 - **Institute of the Fraunhofer Society**
 - **60 Employees, of which 35 are Scientists**
 - **Legal Agent for the Fraunhofer Society in all matters pertaining to Patents and Licensing**
 - **Service for Companies, Research Institutes, Universities and Inventors**
 - **The Patent Center supports and consults free Inventors since its inception**
 - **Further Tasks: Servicing University-associated Projects like DHGP, Bayern Patent**
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Why do Universities not currently claim Inventions ?

- Scientific Publications take top priority
- Lack of Interest in Patenting at the University and with Inventors
- Lack of Funding for Patenting
- Lack if Infrastructure for Patenting and Commercial Exploitation at Universities

Central Starting Points of *Bayern Patent*:

- Intensification of Patenting Culture
- Making Funds of the *High Tech Offensive* available for Patenting
- Provision of the necessary Infrastructure (Inventor Consultants, Patenting buro, Licensing bureau)

Tasks of the Inventor Consultants

- Consultation and Support for Inventors (Service Inventors AND Free Inventors) at the Universities
 - Motivation of Scientists to utilize the Patent System
 - Attendance and Consultation for Areas relevant to Inventions at Universities through personal Contacts
 - Consultation of Inventors in Discovering Patentable Content in Results of Scientific Research
 - The Inventor Consultant is the link between University Inventor, Institute, Administration and Patent bureau
 - Organization of Presentations and Lectures
 - Setting up of Consultation hours and Individual Consultation
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Role of the Patent Bureau

- Treatment of Inventions according to Law and Regulations of Funding Agencies (Free-Service-, Multi-Party Inventions), Legal Agreements among the parties
 - Evaluation of Inventions (Patentability, Search for Relevant Publications, Technical Feasibility, Economical Exploitability), Recommendation to the University for Claiming or Release of the Service Invention (Alternatively, Transfer of Rights from Free Inventors)
 - Instructing Patent Attorneys, Supervising Patent Applications and the patenting Process
 - Coordination with the University Regarding Patenting Strategy (Which Kind of Protection to Apply for, in which Countries, Keeping Applications and Patents Alive) According to Business- and Market-specific Criteria
 - Education of the Inventor Consultants and Koordination of their Tasks
 - Initiation of Licensing Activities by the Licensing Bureau
 - Organizing of all Information Relevant to Inventions, Patents and Licenses and Storing it in a Central Database
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Tasks of the Licensing Bureau

- Commercial Exploitation of Inventions Covered By Patent Applications
 - Coordination of a Licensing Strategy with the University
 - Creation of Technology Offers
 - Search for Potential Licensing Partners
 - Presentation of the Invention at Companies (Together with the Inventor)
 - Negotiation of the Conditions for the Licensing Contract between University and Industry Partner
 - Supervision of Licensing Contracts
 - Balancing Accounts of Licensing Revenues
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Bayern Patent -Procedure for Service Inventions

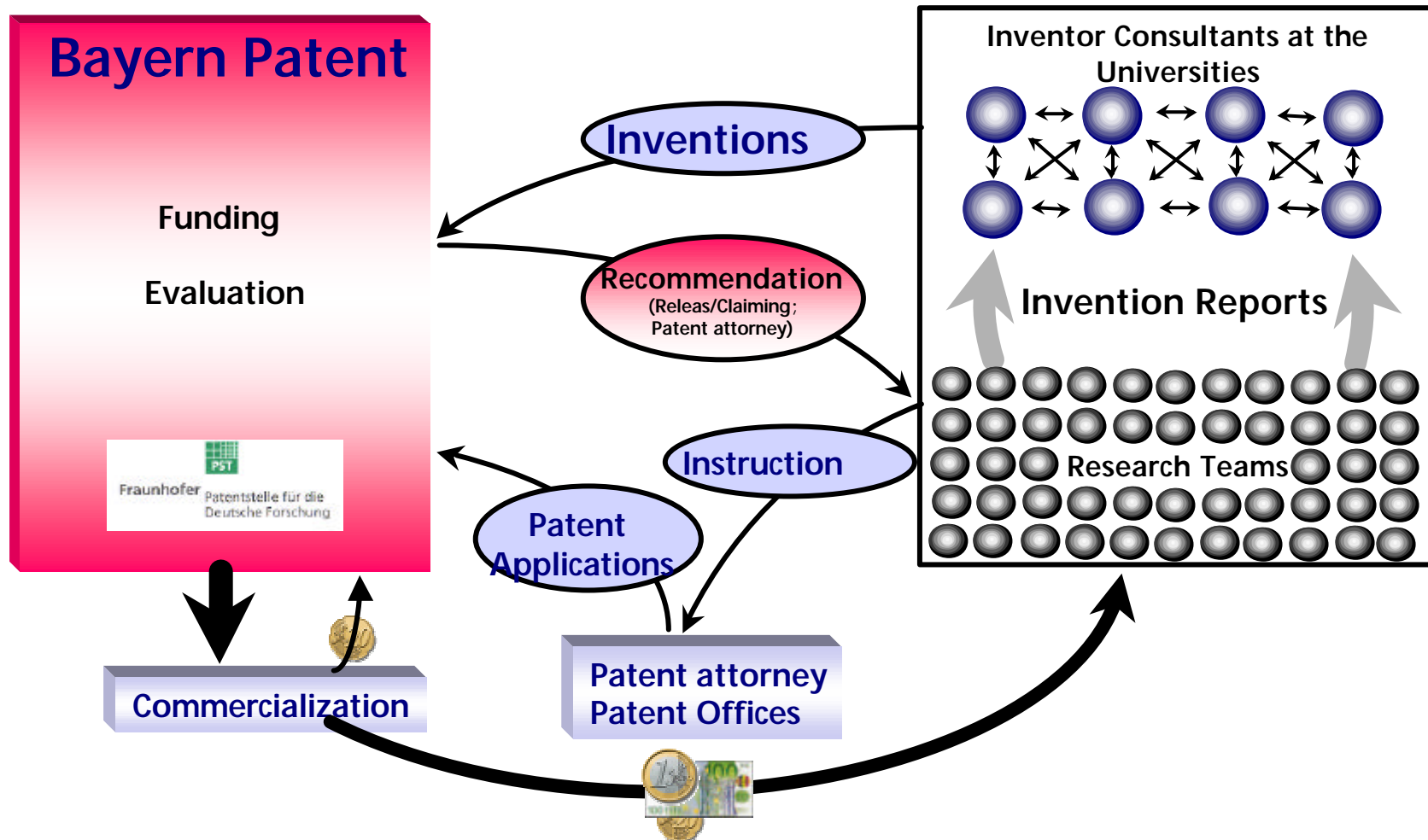
- Service Inventor Reports the Invention to Inventor Consultant and Receives Consultation
 - The Invention is Formally Reported to the University Chancellor (Form „Invention Report“)
 - Patent Bureau Evaluates the Invention and Recommends Claiming or Release by the University
 - The University Files for Patent Protection (When Claiming the Invention) in her Name
 - The Cost of Patenting is Defrayed by Bayern Patent
 - The Licensing Bureau Manages The Commercialization of the Invention
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Bayern Patent -Integration of Free Inventors

- Free Inventor Reports Invention to Inventor Consultant and Receives Consultation
- Invention Is Reported to the Chancellor
- Patent Bureau Evaluates the Invention and Recommends Claiming or Release
- **The Free Inventor Transfers the Invention to the University**
- Further Procedure Identical to Service Inventors
- Free Inventor is Treated in Correspondance with Treatment of Service Inventor



Alternatively, The Free Inventor May File the Invention in His Own Name, but Must Defray the Costs on his Own






Bayern Patent: Training of Inventor Consultants


Dates: Nov. 2000 - May 2001


Place: Munich

Duration: 2 Days per Block

- Course 1:  The Bavarian University Patent Initiative
 Introduction into IP Protection

- Course 2:  Technology Transfer at Universities

- Course 3:  Commercialization

- Course 4:  Communication and Presentation Techniques

12 Lectures per Course + half-day Workshop

Bayern Patent: Distribution of Costs and Revenues

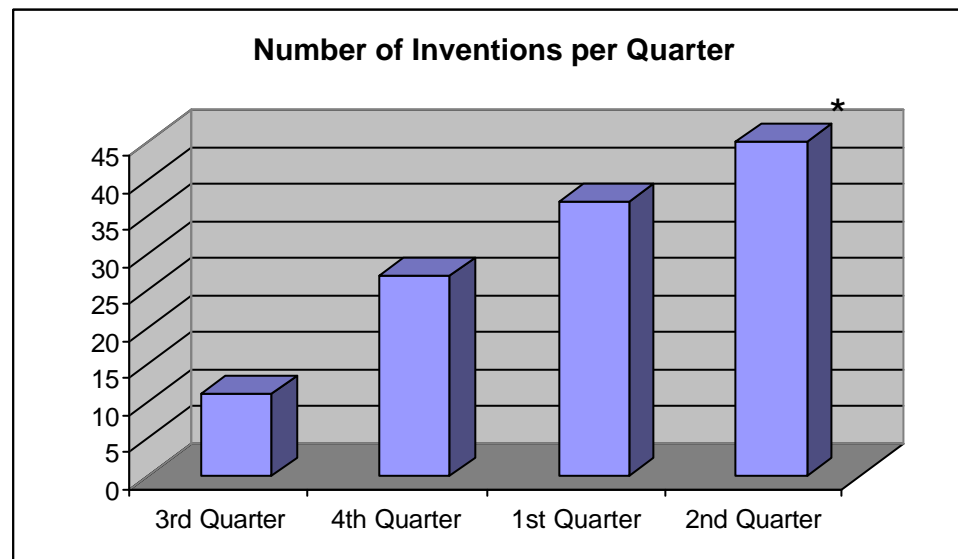
	Revenues	Costs
Inventor	25 %	0 %
Faculty	25 %	0 %
Bayern Patent	25 %	100 %
University	25 %	0 %

Distribution according to Current Law (ArbEG)

(For Claimed Inventions)

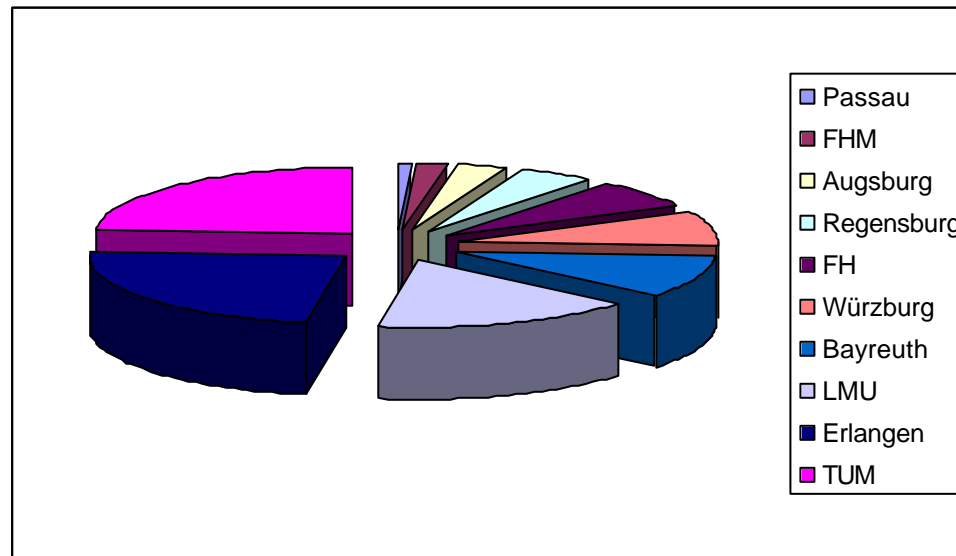
	Revenues	Costs
Inventor	ca. 1-15 %	0 %
Faculty	? %	0 %
Bayern Patent	-	-
University	ca. 85-99 %	100 %

Bayern Patent: Number of inventions reported

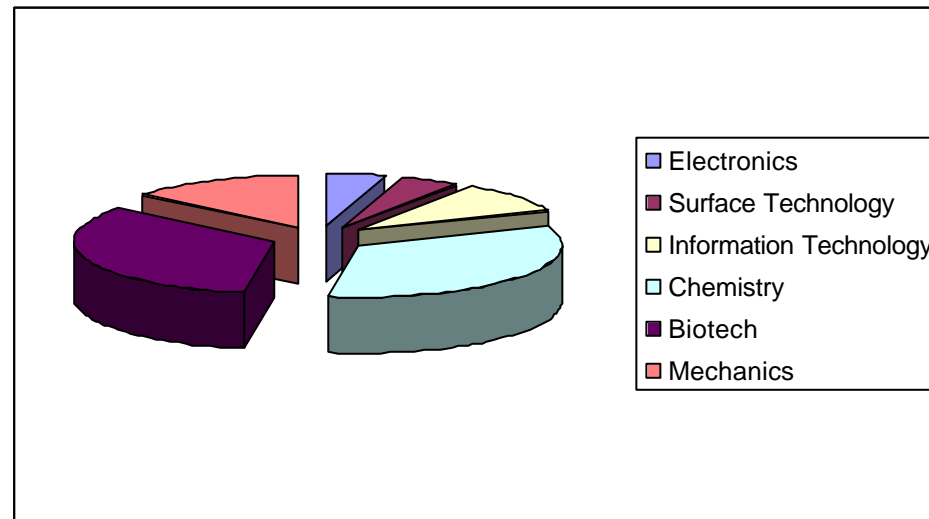


*estimated

Bayern Patent: Source of invention reports



Bayern Patent: Technical Areas of Supported Inventions





Augsburg

Dr. Florian Becke

TC Augsburg, University Augsburg, TC Kempten, TC Neu-Ulm

Bayreuth

Dr. Gerd Kammerer

University Bayreuth, TC Coburg, TC Hof

Erlangen

Dr. Rolf Kapust

Friedrich-Alexander-University Erlangen-Nürnberg, TC Nürnberg, TC Ansbach

München

Dr. Andrea Friedrich

Ludwig-Maximilian-University Munich

Dr. Oliver Werner

Technical University Munich

Dr. Wolfgang Mayer

TC Munich, TC Weihenstephan, TC Rosenheim, TC Ingolstadt

Passau

PL Dr. Andreas Roser

University Passau, FH Deggendorf

Regensburg

Dr. Stefan Kreitmeier

University Regensburg, TC Regensburg, TC Landshut, TC Amberg-Weiden

Würzburg

Dr. Jürgen Kappel

University Würzburg, TC Würzburg-Schweinfurt, TC Aschaffenburg