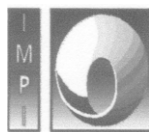


WIPO/INV/MTY/02/10

ORIGINAL:English

DATE:April2002



MEXICANINSTITUTEOF  
INDUSTRIALPROPERTY



WORLDINTELLECTUAL  
PROPERTYORGANIZATION



INSTITUTEOFTECHNOLOGYAND  
SUPERIORSTUDIESOFMONTERREY

**INTERNATIONALWORKSH OPON  
MANAGEMENTANDCOMME RCIALIZATIONOFINVENT IONS  
ANDTECHNOLOGY**





organizedby  
theWorldIntellectualPropertyOrganization(WIPO)  
incooperationwith  
theMexicanInstituteofIndustrialProperty(IMPI)  
and  
theInstituteofTechnologyandSuperiorStudiesofMonterrey(ITESM)

**Monterrey(Mexico),April17to19,2002**




PRESENTATIONOFTHE BAYERNPATENTINITIA TIVE -PROMOTIONOF  
PATENTINGANDEXPLOI TATIONOFINVENTIONS BYBAVARIANUNIVERS ITIES

*DocumentpreparedbyDr.OliverKemper,DirectorofLicensing,BayernPatent,Faunhofer  
PatentCenterforGermanResearch(PST),Munich,Germany*

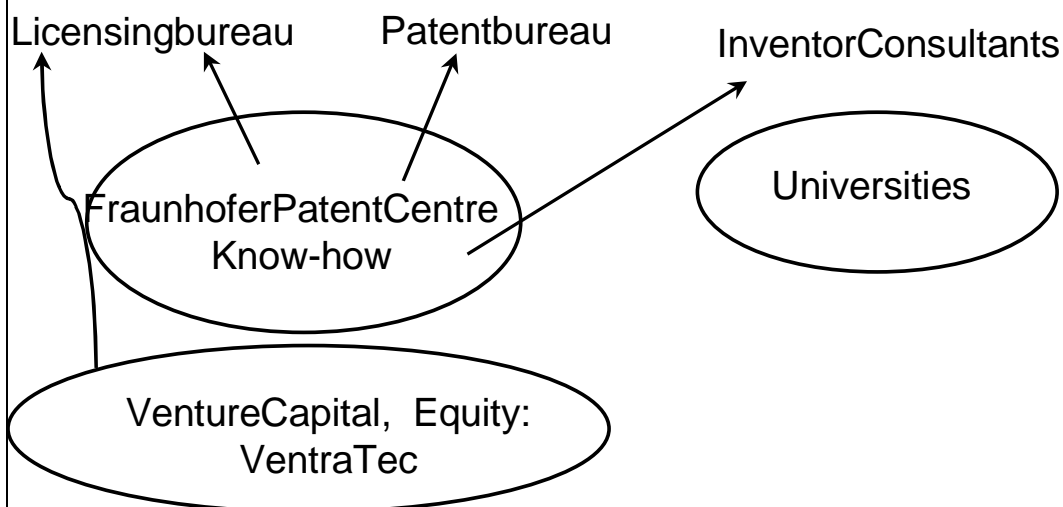
## Why do Universities not currently claim Inventions ?

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

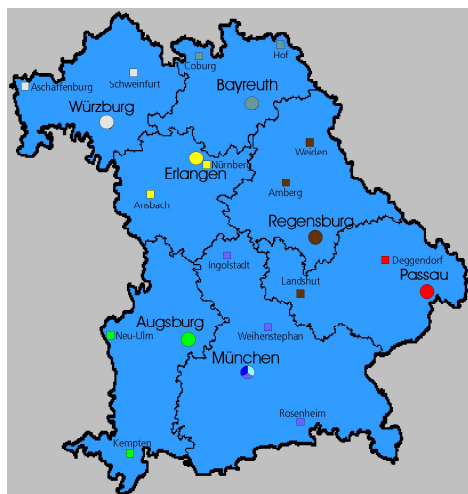
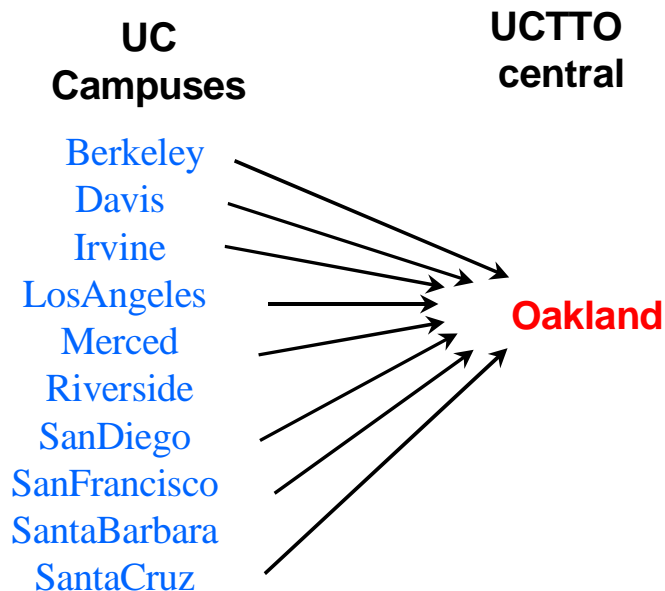
### ➔ Central Starting Points of *BayernPatent* :

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

## Structure of BayernPatent: decentral-central



## TT Structuresinternational: ExampleCalifornia



**Augsburg**

Wolfgang Grenz  
TCAugsburg, UniversityAugsburg, TCKempton, TCNeu-Ulm

**Bayreuth**

Dr. Gerd Kammerer  
UniversityBayreuth, TCCoburg, TCHof

**Erlangen**

Dr. Rolf Kapust  
Friedrich-Alexander-UniversityErlangen -Nürnberg, TCNürnberg, TCAnsbach

**München**

Dr. AndreaFriedrich  
Ludwig-Maximilian-University Munich

Alexandor Papaderos  
Technical University Munich

Dr. WolfgangMayer  
TC Munich, TCWeihenstephan, TCRosenheim, TCIngolstadt

**Passau**

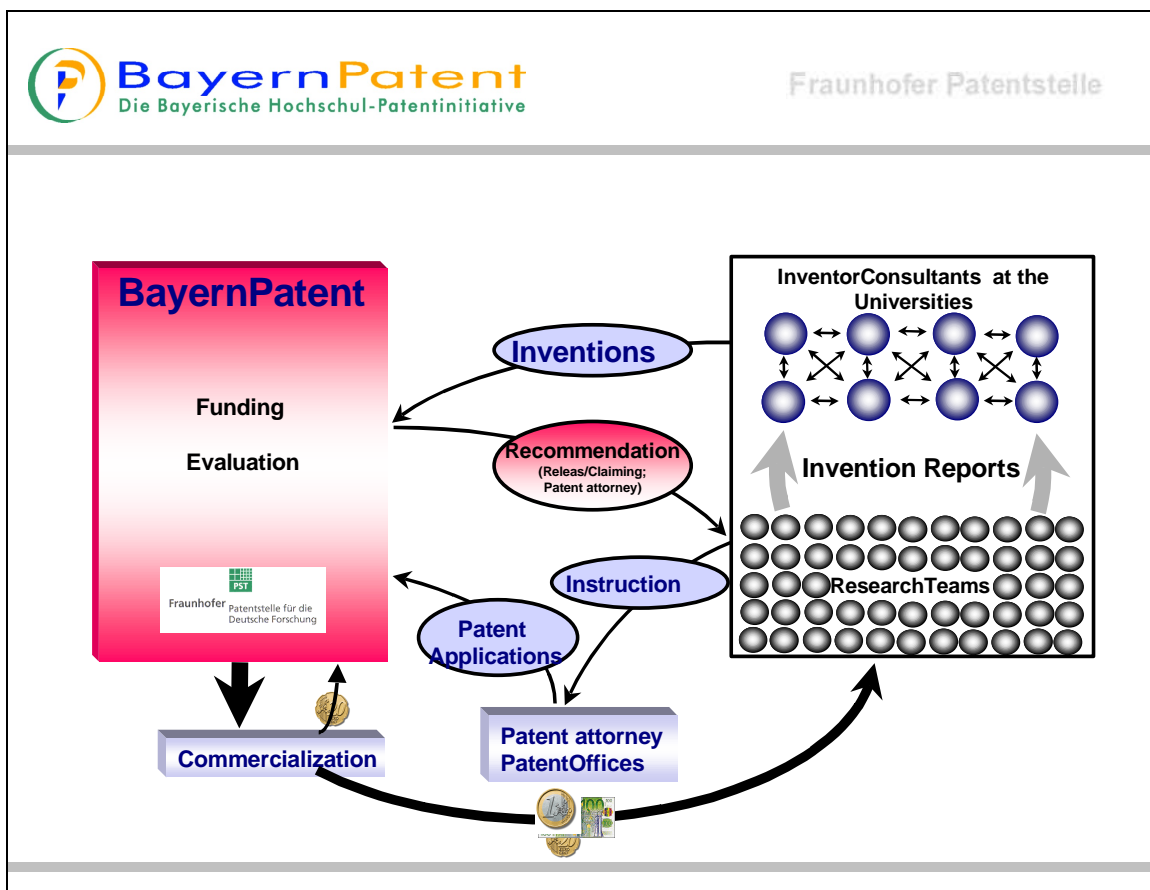
PL Dr. Andreas Roser  
UniversityPassau, FHDeggendorf

**Regensburg**

Dr. Stefan Kreitmeier  
UniversityRegensburg, TCRegensburg, TCLandshut, TCAmberg-Weiden

**Würzburg**

Dr. JürgenKappel  
UniversityW ürzburg, TCW ürzburg-Schweinfurt, TCAschaffenburg



**BayernPatent**  
Die Bayerische Hochschul-Patentinitiative

**Advantages of a Centralized Patent- and Licensing Bureau:**

**Critical Mass of Technologies**

**One Stop Shop for Inventions out of Bavarian Universities**

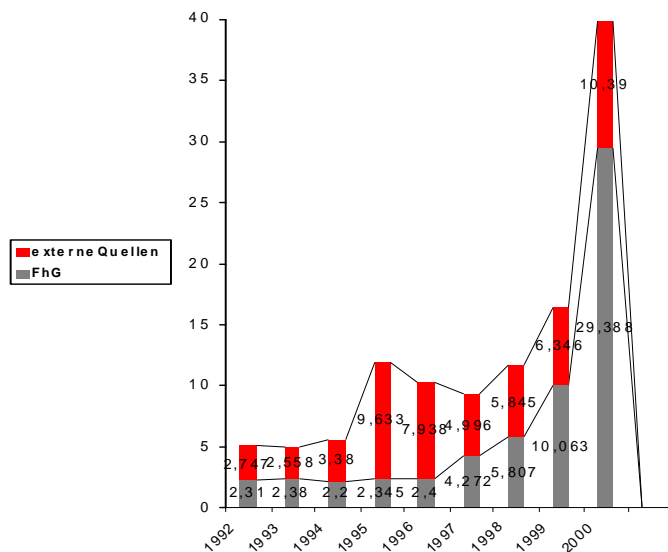
**Establishment of Technology Transfer based upon Fraunhofer Patent Centre 's Know-how**

## 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, BayernPatent**

## Licensing Revenues of Fraunhofer Patent Centre (Mio DM)



## 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

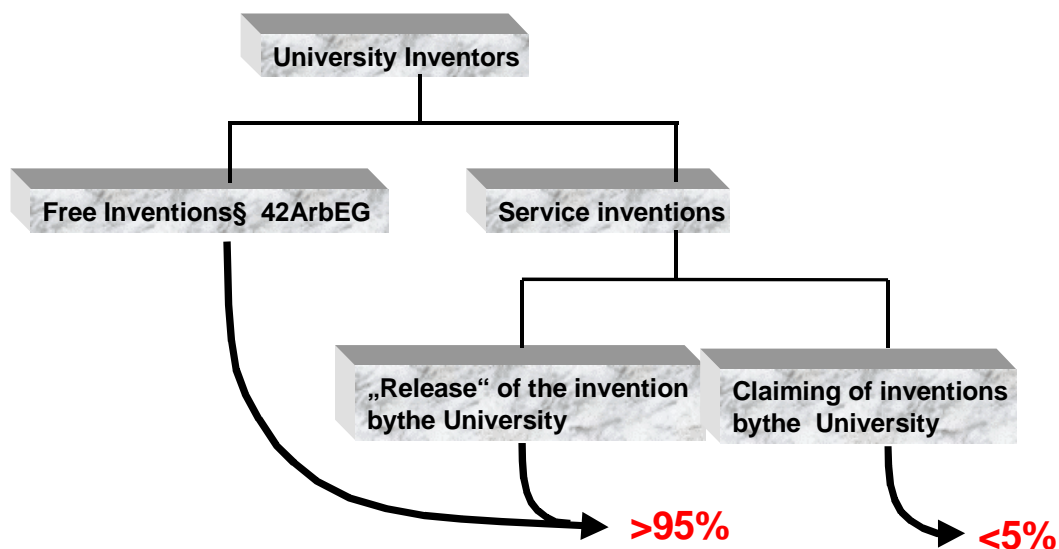
## Role of the Patent Bureau

- 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 Coordination 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

## 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

## Different Types of University Inventions (old Law)



## Service Inventor -Free Inventor (old law)

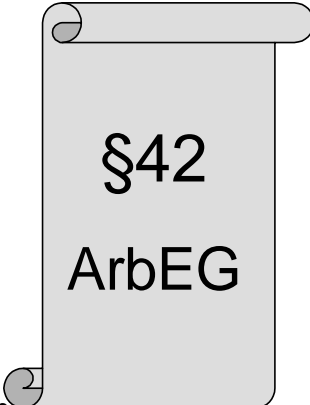
 **Service InventionLaw**

 **Service Inventor:**

- Employee undercontract
- Notification of theInvention to theEmployer ,Release or Claiming of theInventionbytheEmployerwithin 4 Months






 **§42 definesfreeinventors :**

- UniversityProfessorsand Lecturers
- Scientific Assistants (independent scientific ServiceinResearch and Teaching, withthepossibility ofindependentResearch)
- **Students without contract likeinterns and scholarsholders**



§42  
ArbEG

## ServiceIntention Law- § 42 old

-  University Techers owntheirinventions , they do nothave to reportinventions to theuniversity
-  Thisleads to inventionescommonlyowned e.g. by a Professorand the University
-  The invention may be soldto third parties without consultationof the university( Cooperation Agreements)
-  TheUniversit ät is hinderedin licensing its own partin the invention
-  Also the free partof the invention cannot belicensedby itself and isnotattractivefor a company



## ServiceIntention Law - § 42 new (7.2.2002)

- Ⓢ University teachers are service inventors as are all other employees of universities: Duty to report **all** inventions
- Ⓢ University may acquire the entire right to its invention
- Ⓢ **No exception** for third party funded research
- Ⓢ 4 Month term for claiming the invention  
But: Inventors may publish within 2 Months if so declared (constitutional law Art.5, para 3)
- Ⓢ Negative „Freedom to publish“ (constitutional law)  
But: If publication is intended later, the invention must be reported before publication

## ServiceIntention Law - § 42 new (7.2.2002)

- Ⓢ University may no longer profit from inventor's own licensing activity
- Ⓢ Right of the inventor to use the invention for Research (exceeds experimental use)
- Ⓢ Inventor receives 30% of gross Licensing income
- Ⓢ Cooperation agreements must be adapted to the new law by 7.2.2003

**BayernPatent: Distribution of Costs and Revenues**

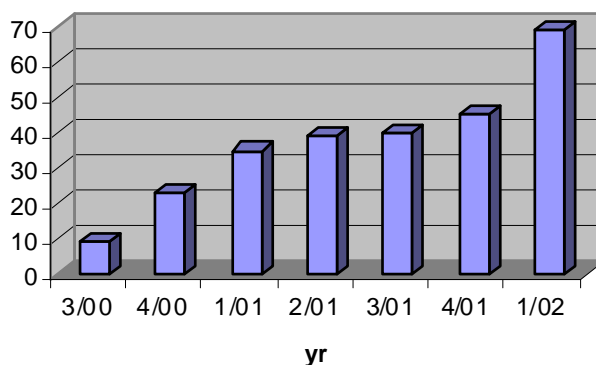
	Revenues	Costs
Inventor	25(30)%	0%
Faculty	25(22.5)%	0%
BayernPatent	25(22.5)%	100%
University	25(22.5)%	0%

**Distribution according to Service Inventor's Law ( ArbEG)**

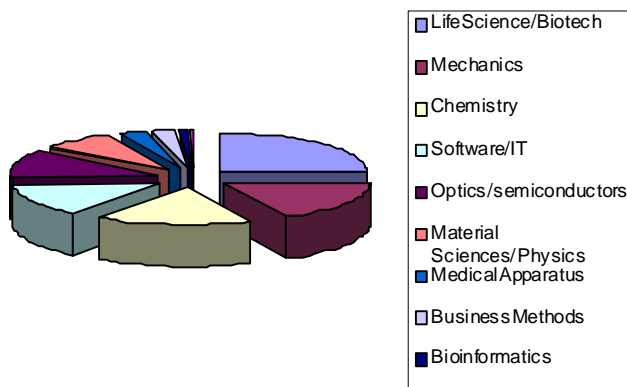
	Revenues	Costs
Inventor	ca.1-15%	0%
Faculty	?%	0%
BayernPatent	-	-
University	ca.85-99%	100%

**BayernPatent: Number of inventions reported**

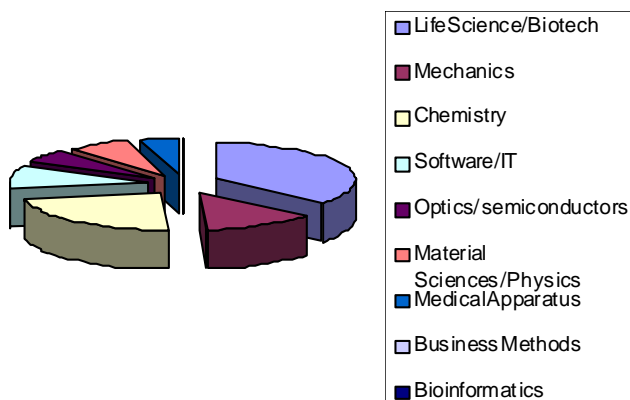
**Number of inventions per Quarter**



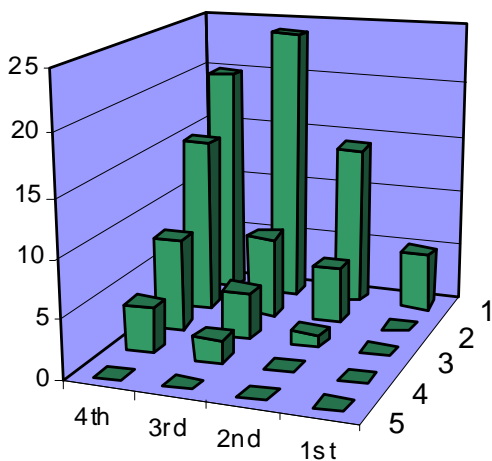
### BayernPatent: TechnicalAreas of Inventions Total



### BayernPatent: TechnicalAreas of supportedInventions



### BayernPatent: Status of Supported Projects



- 1 Strategy formulated
- 2 Contact to companies
- 3 Company Interest
- 4 Negotiations
- 5 Contract and Controlling

Thank you for your attention



Oliver Kemper, Director Licensing

