Managing Government IP Assets – What Should We Consider?

AYELET FELDMAN, ADV.

INTELLECTUAL PROPERTY LAW DIVISION MINISTRY OF JUSTICE, ISRAEL

Overview

• Management Model:

- Ownership Options
- Remuneration Models

Choosing Management Model:

- Goals for Development of Knowledge
- Goals of the Organization
- Role of Innovation in the Organization
- Type of Knowledge
- Source of the Knowledge
- Practical Aspects
- Balanced Mechanism

Ownership Options

- Retain Sole Ownership
 - Retain for in-house R&D
 - License to third parties
- Joint ownership
- Waiver of first right of ownership in favor of employee
- Sale/Assignment of IPRs
- Donate to Public domain

Remuneration Models

- One-time payment
- Royalties
- Milestone Payments
- License Fee
- Equity/ Exit Payments
- Shares/ Options
- License Back or Products

Choosing Management Model

- Ownership Model + Remuneration Model = Management Model
 - Single policy
 - Ad hoc individually tailored policy
 - Systematic process for weighing factors

Goals for Development of Knowledge

Economic purposes

- General revenues
- Continuing R&D
- Improving the organization's activities
- Promote innovation
 - More and better goods and services
 - Spillover effect
- Public interest
 - competitive advantage to the local economy
 - Global benefits

Goals of the Organization

- Research and development
- Technology and knowledge transfer
- Other social values
 - Health care system
 - Defense system
 - Food security
 - Public order

Role of Innovation in the Organization

- Main activity of the organization
- Secondary activity of the organization together with other objectives
- Achieving objectives through innovation
- Improving activity

Type of Knowledge

- Technology and applied knowledge
- Methods and standards
- Articles and reports
- Basic research
- Maps and Geographic information
- Data bases, such as:
 - Licensing examination questions
 - Public transportation timetable; landing and departure times
 - Anonymized medical data
 - IP rights registries

Source of the Knowledge

- Created by state entity
 - Employees hired to invent
 - Expectations of employees
 - Employee retention
- Acquired by state entity
 - Purchase of R&D services
 - Product development
- Financial support from the State

Practical Aspects

- The existence of commercialization mechanisms
 - Cost of establishing and maintaining mechanisms
- Centralized or de-centralized management
- Demands of the partners

Balanced Mechanism

- Varying weight to each category according to the different social and economic values of the different countries;
- Integrated with the characteristics of specific organization
- Uniform policy, flexible outcomes

Thank you

AYELETF@JUSTICE.GOV.IL