



Consideration and Decision of Patent and other IP Protection

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File or not File.....?

- University needs to have its own IP Strategy!
- Process of TT and Commercialization involves many complex decision making along the way

Complex Decisions

- Patenting or not..... and Why?
- Publication....When?
- Patent costs
- National or International
- Value of technology
- Commercial potential/ Market size
- Economic ROI
- University perspective
- Research faculty perspective
- Relationship with industry
- Government perspective
- Public interest
- Social impact

Questions to Ask

- What problem does the technology solve?
- Is the technology useful?
- What is the unique feature of the invention? Competitive advantage?
- Is the technology ready to apply to or needs further development? Costs of development?
- Is the technology easy to reverse engineer or copy?
- Is there market? Where? How big? Who would be interested?
- Which companies are active in this technical field?
- Is it patentable? (New, Inventive step, industrial applicability)
- Patent costs?
- Does the technology contribute to solutions to social problems?

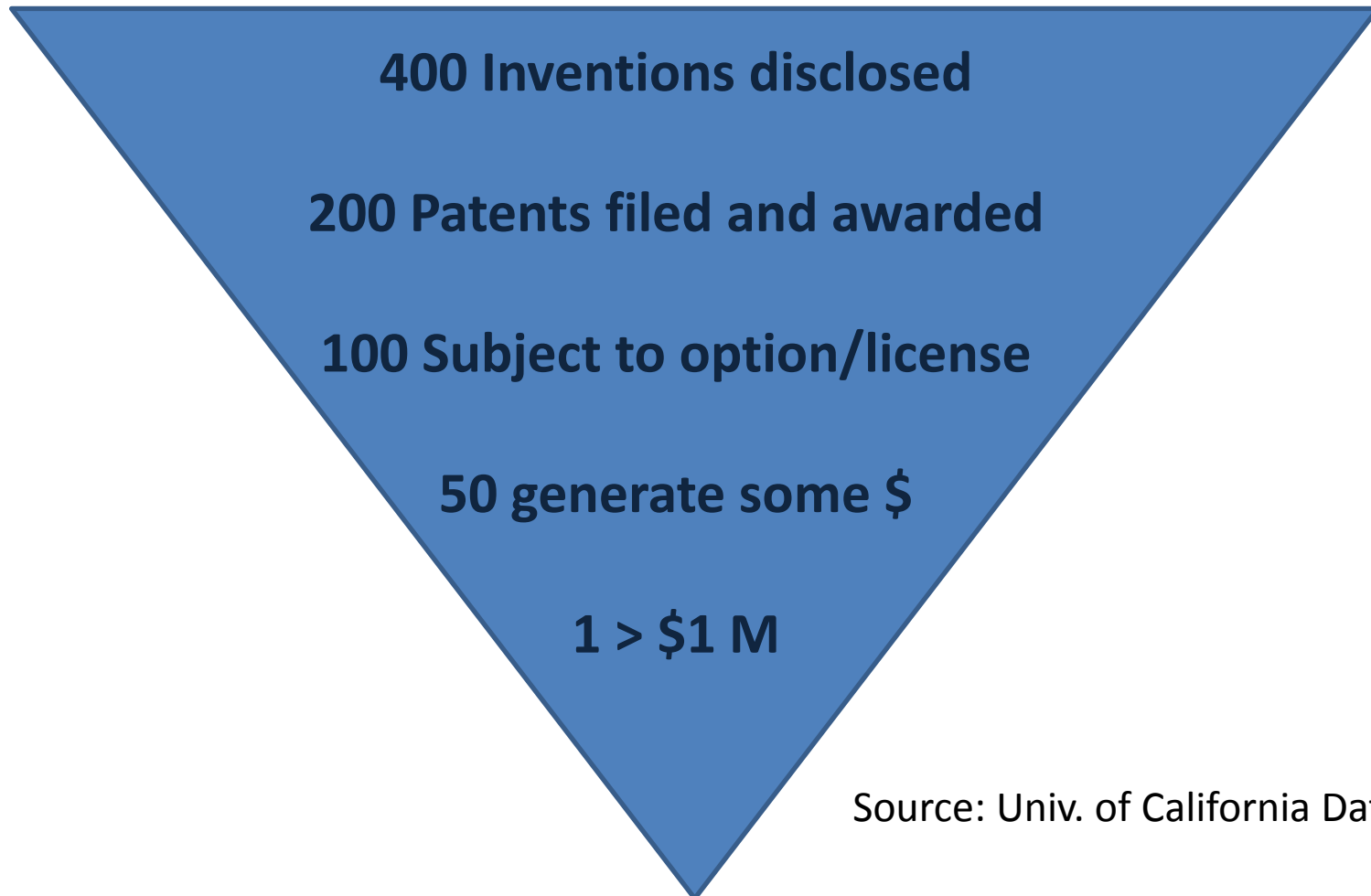
Questions to Ask

- How long will the technology survive in the market (before it becomes obsolete)?
- Scalability? (both technology, business setting)
- Manufacturing costs?
- Do I really need patent protection?
- National or International (PCT) patent?
- Which countries should I seek protection?
- Should I file provisional patent application first?
- Should I file now or later?
- Can I find potential licensee(s) easily?
- Track record of license deals of similar products?

Considerations for Value of the technology

- Risk
- Cost-to-Develop
- Time-to-Market
- Market Size
(How fast can you get ROI?)
- Are other Licenses Needed?
(Cost and Availability)

Approximate Invention Success Rate - Pyramid of Disappointment/Opportunity



Source: Univ. of California Data

Patent is certainly important for big companies....

But patent is even more important for small businesses and start-ups, because:

- The patent may be the only **competitive advantage**
- Essential **to find investors and commercialization partners or obtain access to enabling technologies**
- Investors typically view **patents as insurance** for their investment
- The value of a small company's patents may therefore be a **crucial factor** in the decision of a venture capitalist or other investor to invest in a company.
- Strong patents may also be used as **bargaining chips** for licensing, sales and business collaboration opportunities

Patent Filing Decision

Patents are expensive to obtain and maintain, so a sophisticated process is necessary to determine if the “Invention” is worth the cost of patenting it.

Exercise

Simulation cases: File or not file.....?



Thank you for your attention

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