



Institutional IP Policy

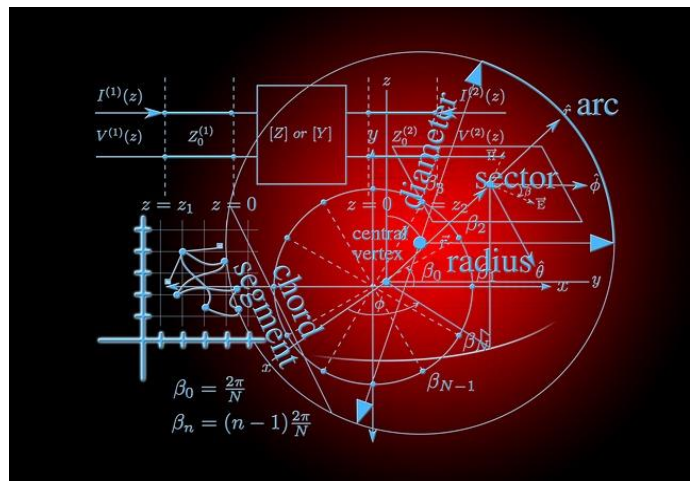
Yumiko Hamano
IP Consultant – IP Commercialization
Partner, ET Cube International

University and IP

Universities should identify, protect, manage, utilize, benefit from IP rights in the fields of :

- Patents
- Trademarks
- Industrial Designs
- Copyrights
- Computer programs/ Algorithm
- New plant variety
- New biological materials
- Traditional Knowledge
- Trade secrets

And contribute to national development.



Institutional IP Policy

IP Policy:

Principles of actions adopted by an organization – often legal implication.

IP Policy provides:

- Clear rules and guidelines for research operations
- The legal framework for commercialization
- Guidance for IP and technology management procedures
- Clear policy on ownership criteria and benefit sharing
- Consistency of approach (in a systematic manner)
- Transparency in decision making process
- Objectivity in measurement

and fosters:

- Transfer of technology generated in the university
- Innovation and creativity in the university
- Local and National economic growth

Who the IP Policy Applied to?

- All university staff (i.e. professors , researchers, students and the management and TTO and IP management units)
 - Governments
 - Partner Industries
 - Partner universities
 - Public
- Institutional IP Policy need to be disseminated and well-understood by all stakeholders particularly by researchers.



Institutional IP Policy

Key Issues Covered

- Definitions
- Objectives of the IP policy
- Administration and application of IP Policy
- Types of IP covered
- **Obligation of reporting inventions**
- **Ownership of IP rights**
- **Benefit /revenue sharing**
- **Government rights**
- **Privately funded research**
- **Spin-off or start-up companies**
- **Licensing**
- IP audit management
- **Research commercialization**
- **IP protection**
- **Incentive for researchers**
- **Conflict of interest**

Obligation of Reporting Inventions

Most of Institutional IP Policies include a provision “Obligation of Reporting Inventions” and its procedures.

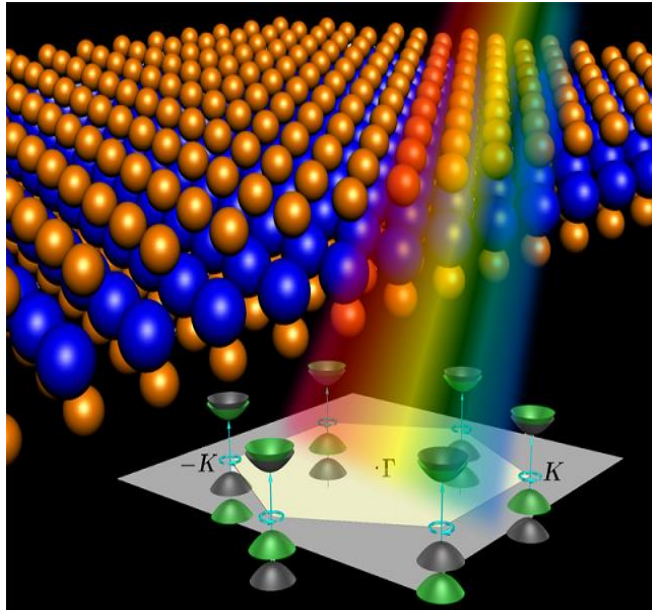
- Invention Disclosure Form
- To whom?
- How it is submitted
- How it is treated by the TTO

Ownership

Who owns IP generated by publicly funded research?

- Generally national law defines who owns IP (inventions) arising from work conducted for an employer
- In some cases, national laws specifically address ownership of inventions arising from publicly sponsored research
- Sometimes IP ownership covered in different laws (e.g., Employment law, Patent law, Innovation law, University law)

Ownership



- Government
- University
(e.g., Germany, Austria, Japan, China, South Korea, UK, France, US, Denmark – Most of countries)
- Creator/ Faculty
(e.g., Finland, Norway, Sweden)

Ownership

General principle:

Employment Law:

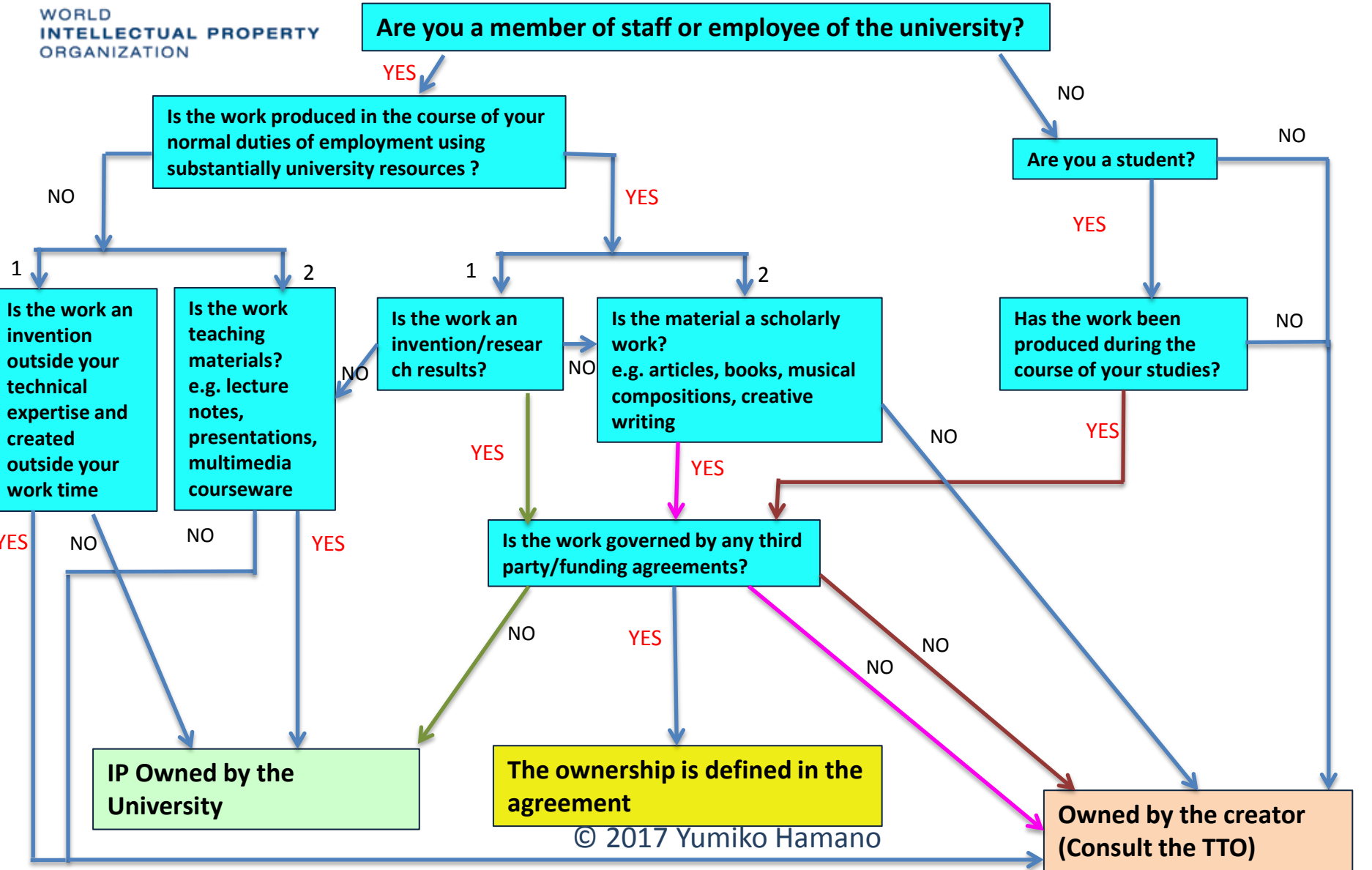
Employer is entitled to IP rights created by an employee in the course their employment

Innovation Law:

University can claim ownership of invention created by academic staff in the course of their employment using substantially the resources of the university (time, equipment, premises, research funds).



Ownership Flow Chart



Benefit Sharing

How are the revenues from research commercialization shared among Inventor, faculty, university and other stakeholders?

Bay-Dole and Stevenson-Wydler provide that royalties from commercialization should be shared with the inventor to provide an incentive to create inventions for practical use.

Benefit Sharing

- **The distribution proportions differ by institution**
 - **Inventor(s)**
 - **Faculty**
 - **University**

- **On average,**
 - **Inventor: 25 - 85%**
 - **Faculty: 25 - 30%**
 - **University: 25 - 50%**



Benefit Sharing

- In many cases, the university provides part of its portion to the TTO (or the administrative unit)
- Rule of thumb $1/3: 1/3: 1/3$
- Institution portion often used for funding research
- In many cases, the benefit is calculated after overhead costs including patents.
- In some universities, the TTO's operation budget is set based on its income (licensing royalties and other income).

The government roles:

- represents the interest of the public and society
- ensures that the tax payers benefit from the results of R&D activities

Responsibility to ensure that the public and society receive maximum benefit from R&D investments and to protect the interests of society

- March-in-right

one of the most contentious provisions in Bayh-Dole. It allows the funding agency, on its own initiative or at the request of a third party, to effectively ignore the exclusivity of a patent awarded under the act and grant additional licenses to other "reasonable applicants"

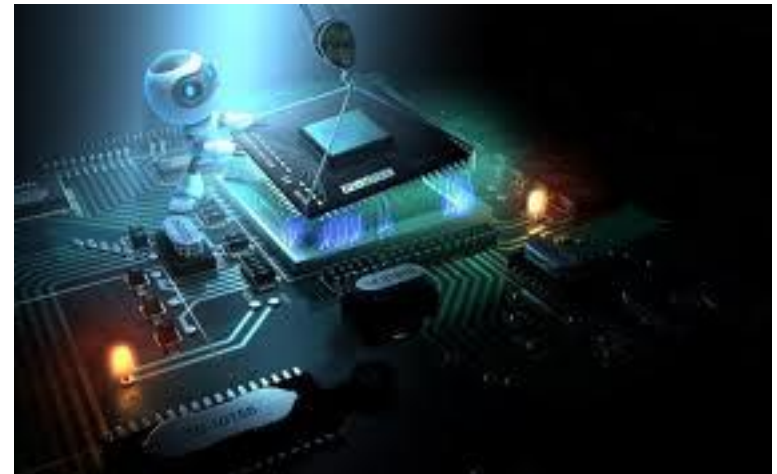
Manufacturing in the country
(preference for the national industry)

Compulsory license
(for national Safety and public health needs)



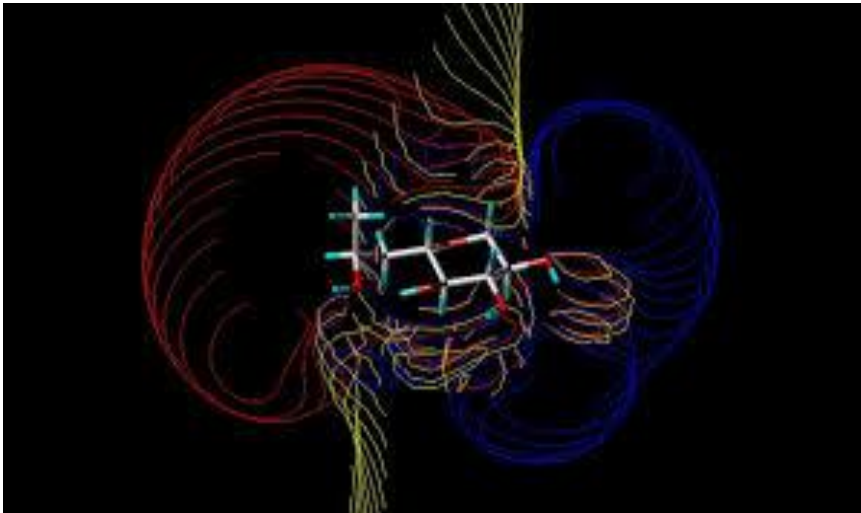
Privately Funded Research

- How to deal with private industries
- Approval process
- Contracts and Agreements
- Ownership
- Negotiation process



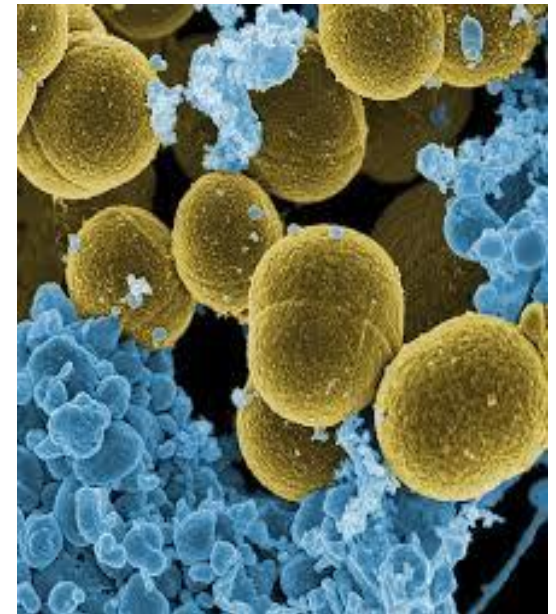
IP Protection

- Decision process
- IP Committee
- Financing
- Maintenance and administration



Confidentiality

- Especially before filing a patent
- Especially when collaborating with external organization particularly industry
- Publish or Perish issue



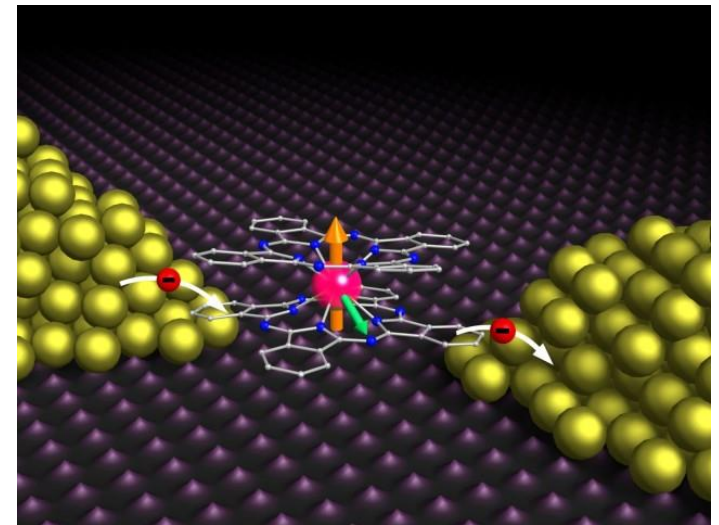
Commercialization

- Who does what
- Roles of TTO
- University protocol
- Who signs contracts and agreements?



Spin-off/ Stat-up

- Procedures
- Approval
- IP ownership
- Financing
- License



Incentive for Researchers

- Financial
- Personal
- Promotion Scheme
- Rewarding ceremony (e.g. dinner with the Dean)
- Invention certificate
- Relationship with TTO (Researchers can benefit from TTO services)
- Involvement of researchers in commercialization process
- Information sharing
- Training

Conflict of Interest

How are conflicts of interest and commitment handled?

- Mandate of universities vs. those of industries
- Social Concern
- Institutional Concern
- Individual concern

Issues of Concern

e.g.

- Ownership
- Benefit sharing
- IP protection and Commercialization
- Consulting work
- University time
- Students supervision
- Equity holdings

➤ IP Policy should include provision of mediation and legal Procedures in case of a dispute

Conclusion

- Institutional IP Policy provides clear rules and guidance to University IP management procedures
- Institutional IP Policy needs to provide clear policy on ownership criteria and benefit sharing
- Institutional IP Policy has legal implication
- Researchers need to understand IP Policy very well – Need information/training sessions for researchers
- IP Policy is applied to all stakeholders
- Often administered by TTO
- The Univ. Senior managers need to be involved in its policy settings and IP management strategies



Thank you for your attention

Yumikoh@etcube.com

yhamano309@gmail.com