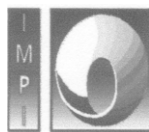


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MEXICAN INSTITUTE OF
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WORLD INTELLECTUAL
PROPERTY ORGANIZATION



INSTITUTE OF TECHNOLOGY AND
SUPERIOR STUDIES OF MONTERREY

**INTERNATIONAL WORKSHOP ON
MANAGEMENT AND COMMERCIALIZATION OF INVENTIONS
AND TECHNOLOGY**

organized by
the World Intellectual Property Organization (WIPO)
in cooperation with
the Mexican Institute of Industrial Property (IMPI)
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LICENSING AGREEMENTS FOR TECHNOLOGY CREATED THROUGH
UNIVERSITY RESEARCH PROGRAMS

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PROGRESSION THE SUBJECT

Informality of University-Business Relations



more formal, frequent and structured relations



contracts

Brazil

- ➔ new legislation
- ➔ sharing with researchers of profits derived from marketing
- ➔ sectoral funds the new way of financing research and promoting innovation
- Introduction of new features in University routine
- *Learning by doing process* continuous improvement training

MANAGEMENT OF THE UNIVERSITY-BUSINESS LINK

- Fundamental differences in the vocation, interests and objectives of the two entities
- Settle terms of cooperation before work starts- and avoid conflict
- Conflicts of interests- reconciling individual and institutional interests by establishing institutional rules on responsibilities and rewards
- Need for professional management
- Support foundations

R&D CONTRACTS WITH COMPANIES

• INTELLECTUAL PROPERTY RIGHTS

- Exclusive property of University - rules
- Joint ownership with company
- Exclusive property of company
 - strategic factor for the company in its relations with others in the same sector
- R&D projects with Government agency financing

R&D CONTRACTS WITH COMPANIES

SECURITY OF INFORMATION

- From the company angle
- From the University angle
- agreement on secrecy of issues fundamental to businesses
- ensuring the use of generic information for teaching and research purposes

R&D CONTRACTS WITH COMPANIES

- PUBLIC V. PRIVATE

- Privatization of knowledge
- Free enterprise and business incubation
 - redefining the boundaries between public and private
- Spin-off and business-incubating undertakings
 - juridical-legal and administrative *modus operandi*
- **Brazil** - new outlook with the Law on Technological Innovation

TECHNOLOGY AND PATENT LICENSING AGREEMENTS

- **Brazil** ➡ few patents ➡ few contracts
 - ➡ little technology transfer activity from university to business
- **EITT/UFRGS - lessons learned**
 1. **Preparing for marketing**
 - What is the technology worth?
 - To whom should the technology be offered, and how?

TECHNOLOGY AND PATENT LICENSING AGREEMENTS

2. Meeting the oppositenumber

- Negotiating the licensing
 - knowing the technology
 - obtaining maximum information on the business
 - in talks, above all, listen
 - spot the strong and weak points of the transaction
 - respect points of importance to the business without compromising aspects crucial for the university
 - set everything down in an official record
 - keep negotiations secret
 - clarify all points for correct inclusion in the contract
 - manage the expectations and concerns of researchers

TECHNOLOGY AND PATENT LICENSING AGREEMENTS

3. Licensing aspects

- Clear definition of the subject matter
- Type of licensing
 - exclusive or non-exclusive
 - conditions governing third-party licensing
- Manner, period and conditions of technical assistance
- Conditions of remuneration and payment of royalties
- Confidentiality and secrecy of information
- Period for use of the technology

TECHNOLOGY AND PATENT LICENSING AGREEMENTS

4. Drafting of the agreement

5. Signature of the agreement

6. And after signature?

- Technical assistance
 - researcher plays a fundamental role
 - vulnerability of the process
 - mutual trust

FINAL CONSIDERATIONS

- Intensification of the marketing of the technology and patents- **challenges to be met** -
- The contract is **only one aspect**
- After a contract, work to be done on awareness, dispute settlement and removal of obstacles
- In **Brazil**, resources obtained still unimpressive, but progress has been made
- Enjoyment of tangible benefits: prospect of recognition of the activity within the University