

LICENSING OF TECHNOLOGY

Acquisitions/licensing of Biotech Patents and Trade Secrets; Basic Principles of Technology Licensing; Due Diligence. Case Study/Group Exercise on Negotiating a Technology Licensing Agreement

Dr. Prabuddha Ganguli

CEO

"VISION-IPR"

*101-201, Sun View Heights, Plot 262,
Sher-e-Punjab, Andheri East, Mumbai 400093, India*

Tel: 91-22-28264348; Fax: 91-22-28264344

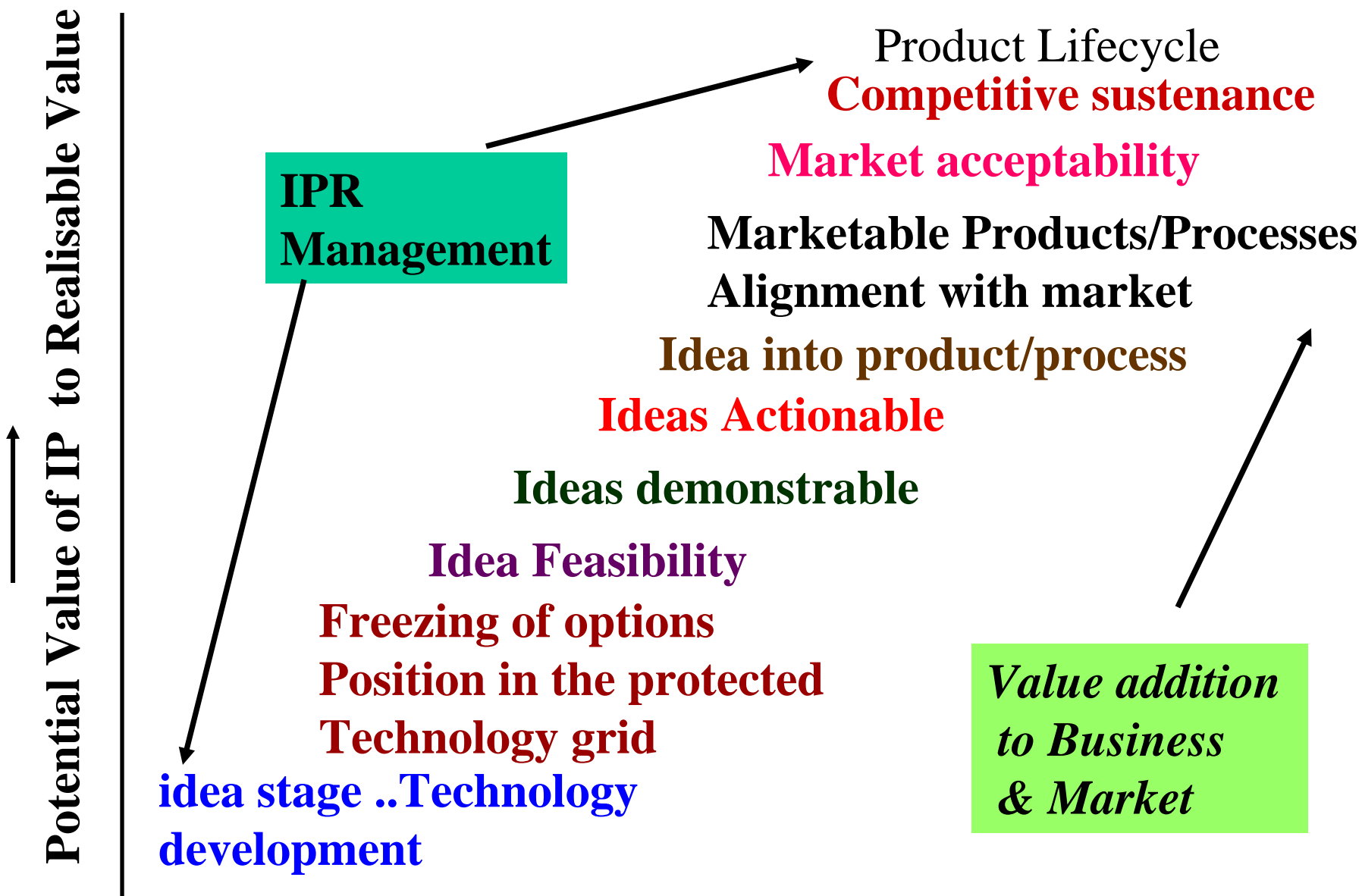
Mobile: +91 9820352815

e-mail: pgang@mtnl.net.in

WIPO-BCIL-BIRAP IPR Workshop

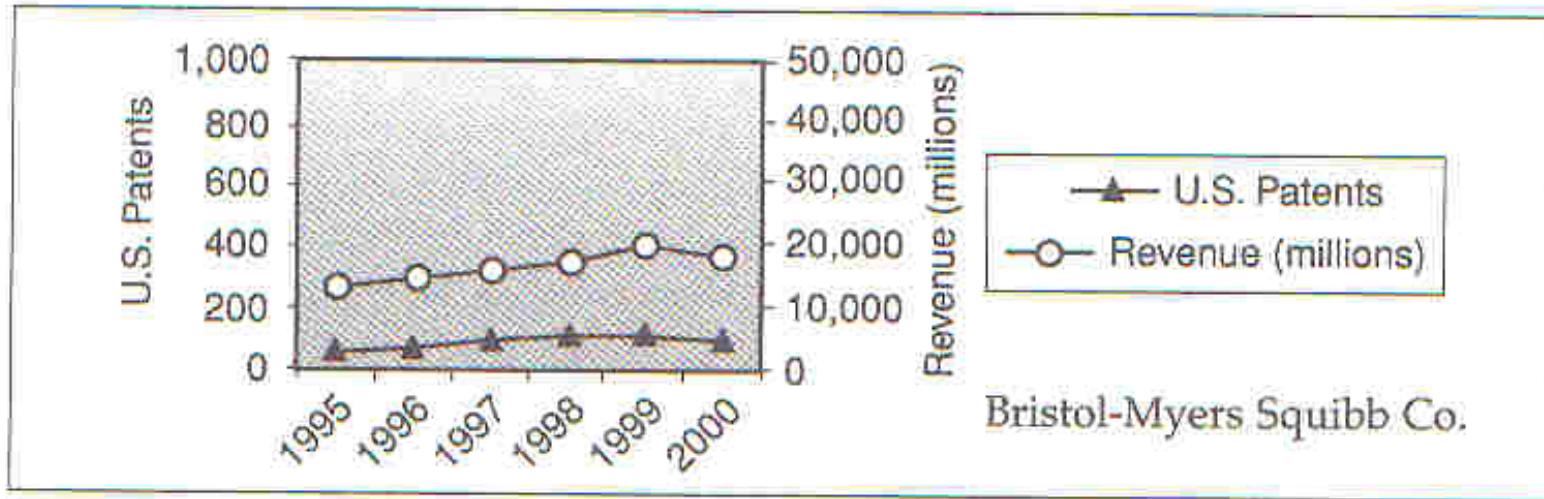
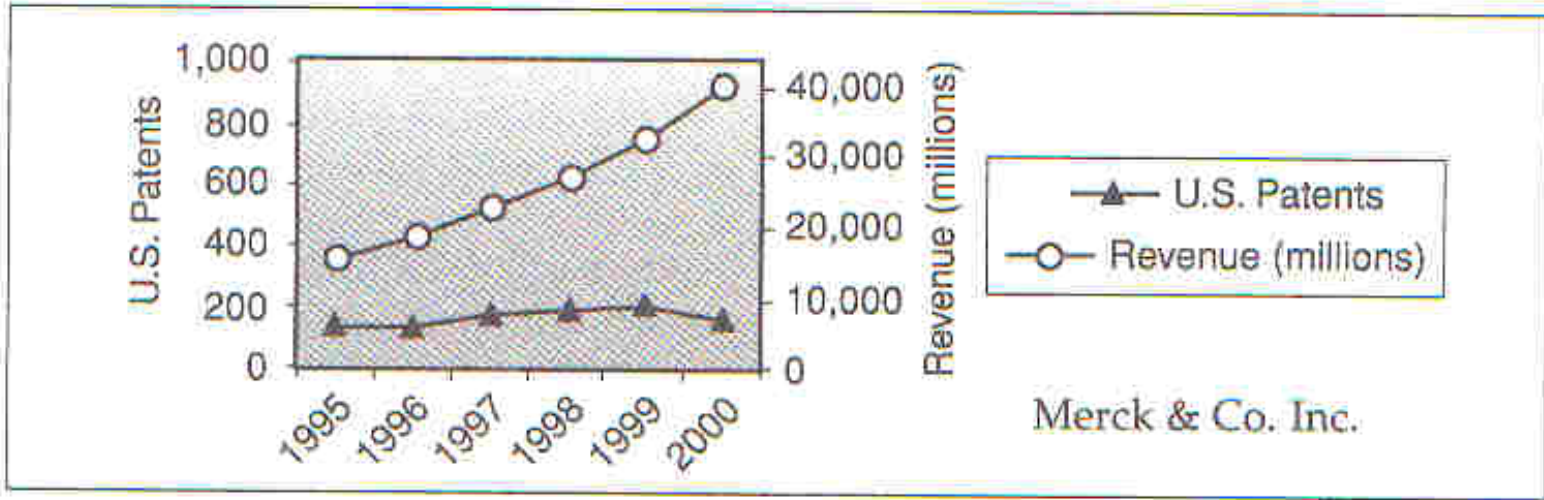
Delhi, April 5-9, 2010

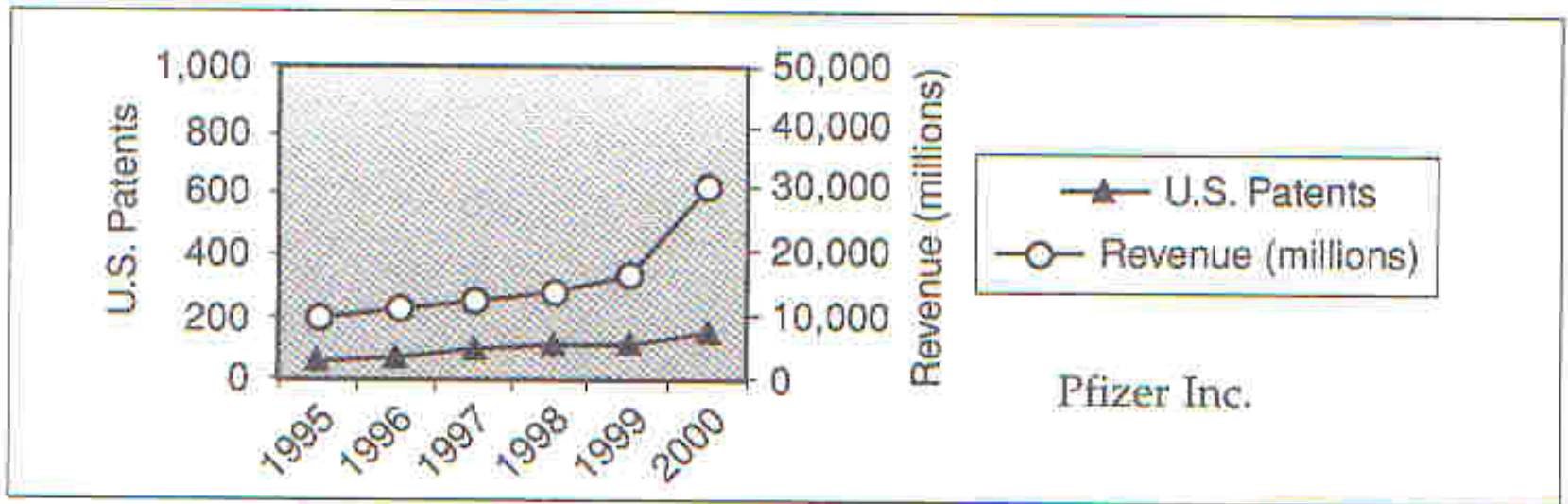
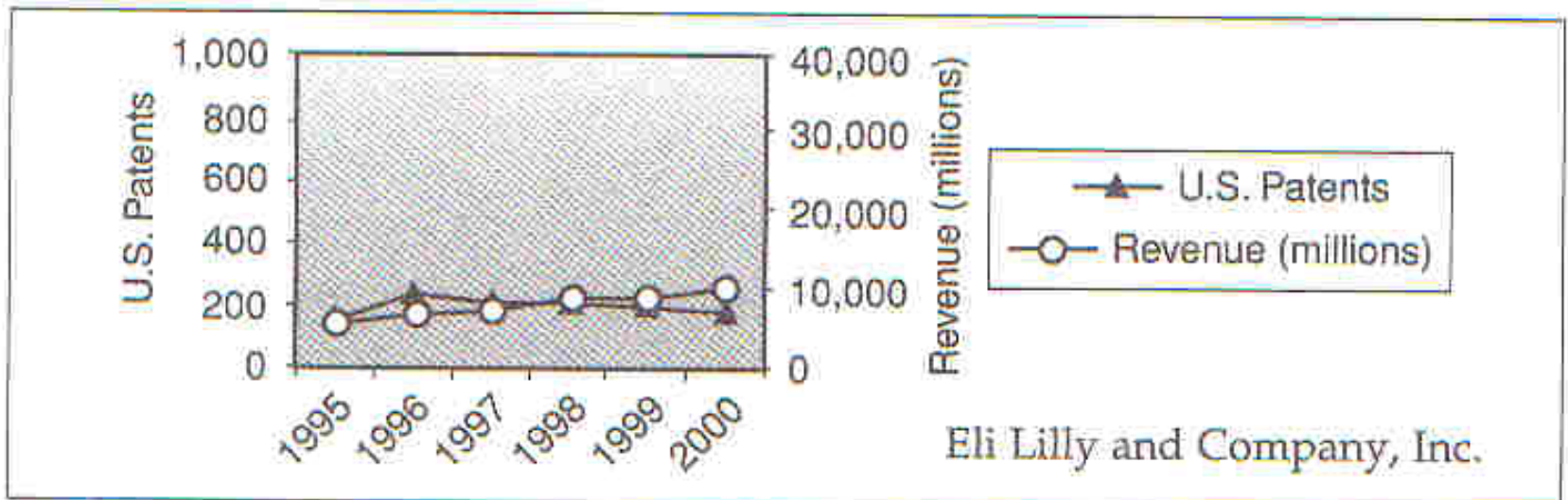
Business_IPR Weave



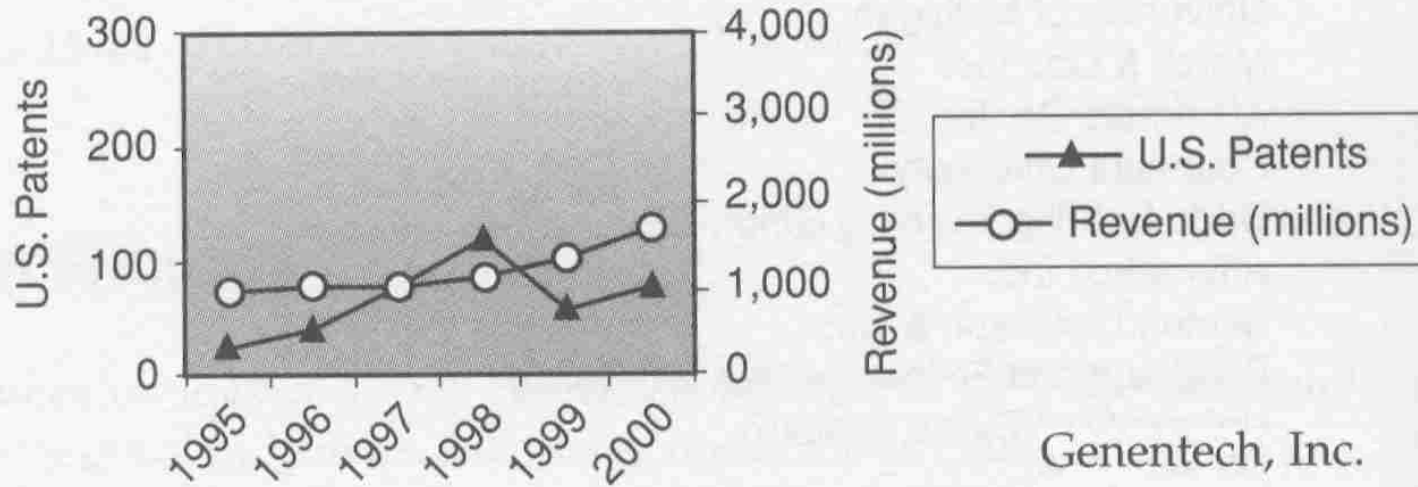
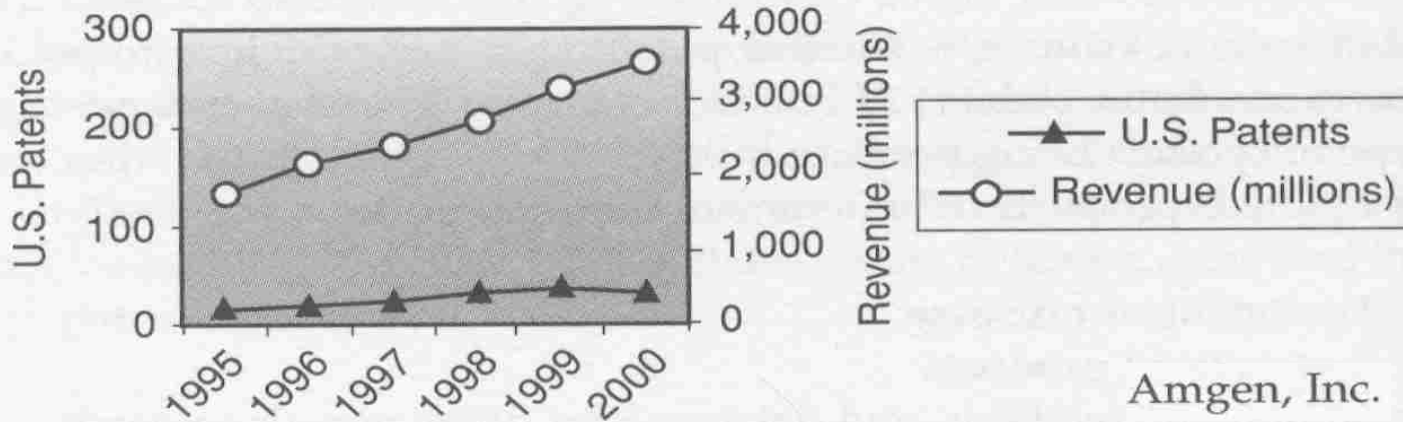
Does Intellectual Property Bring
in value?

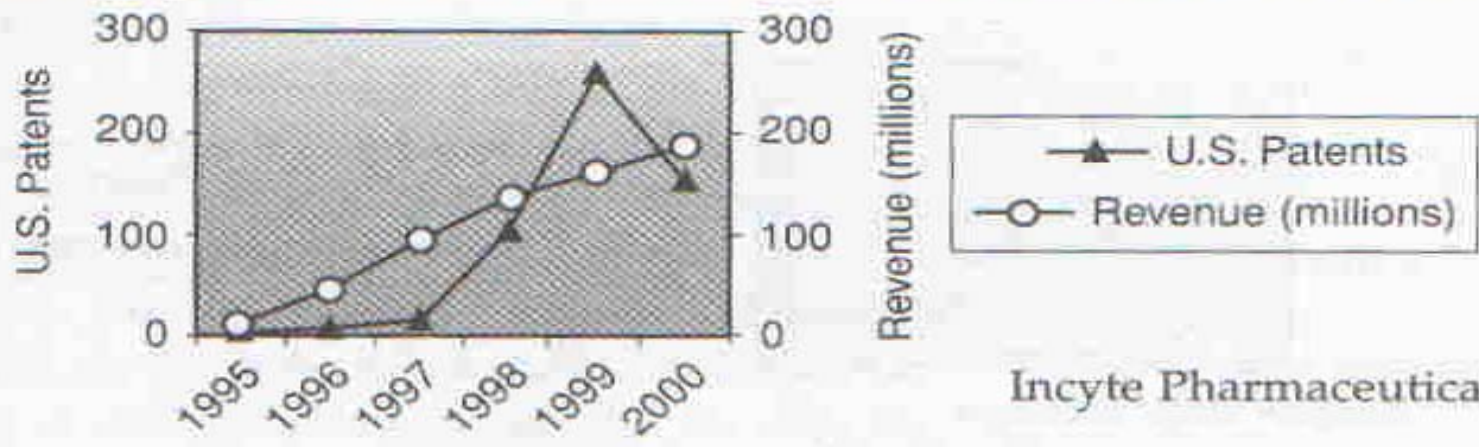
Pharmaceuticals



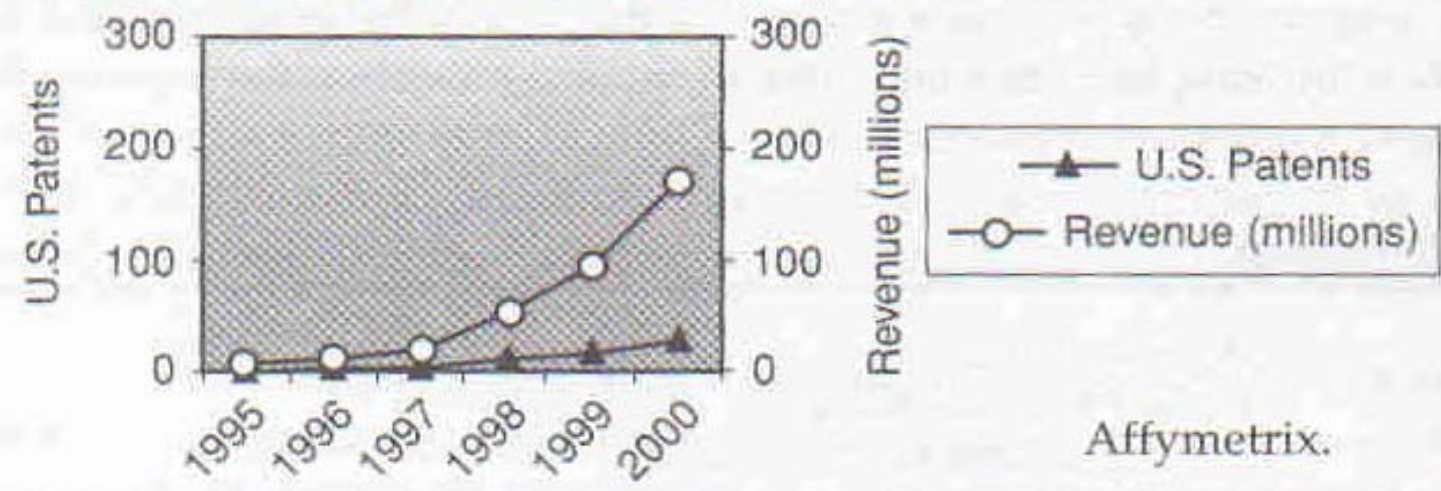


Biotechnology

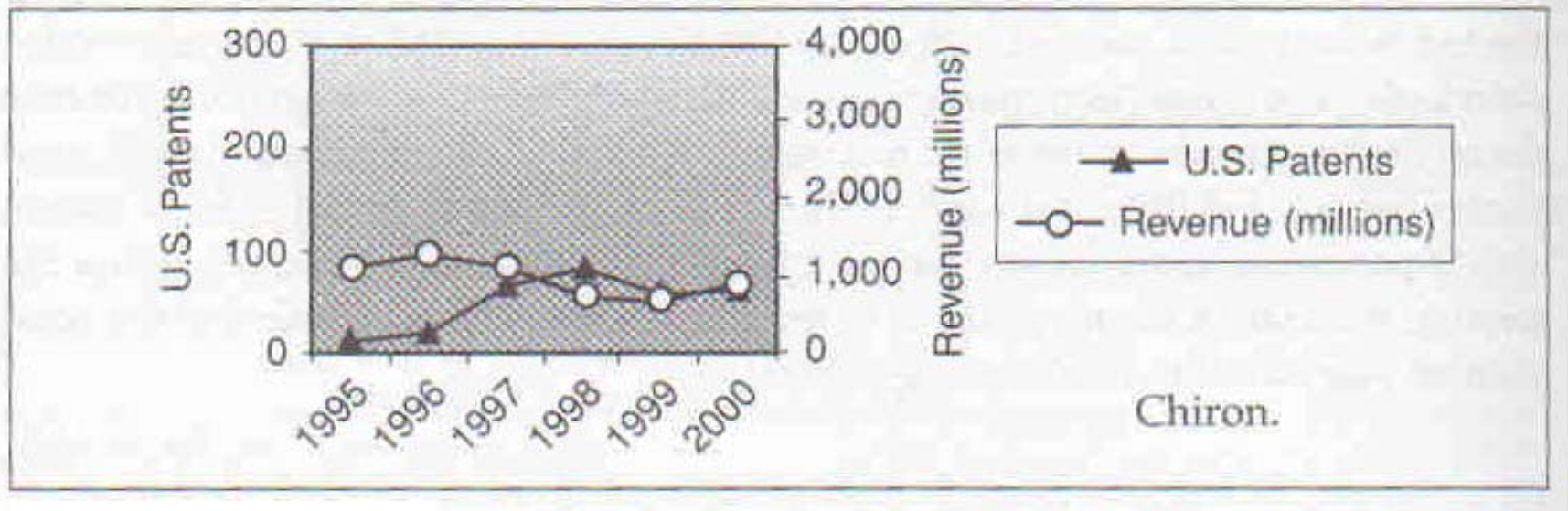
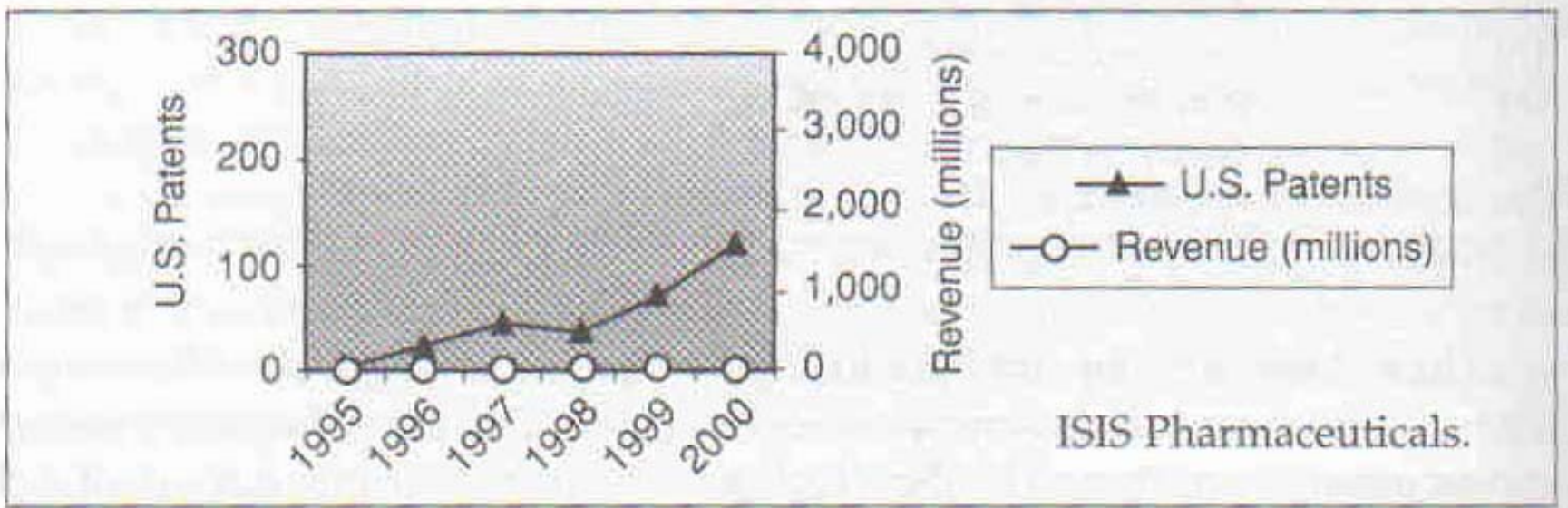


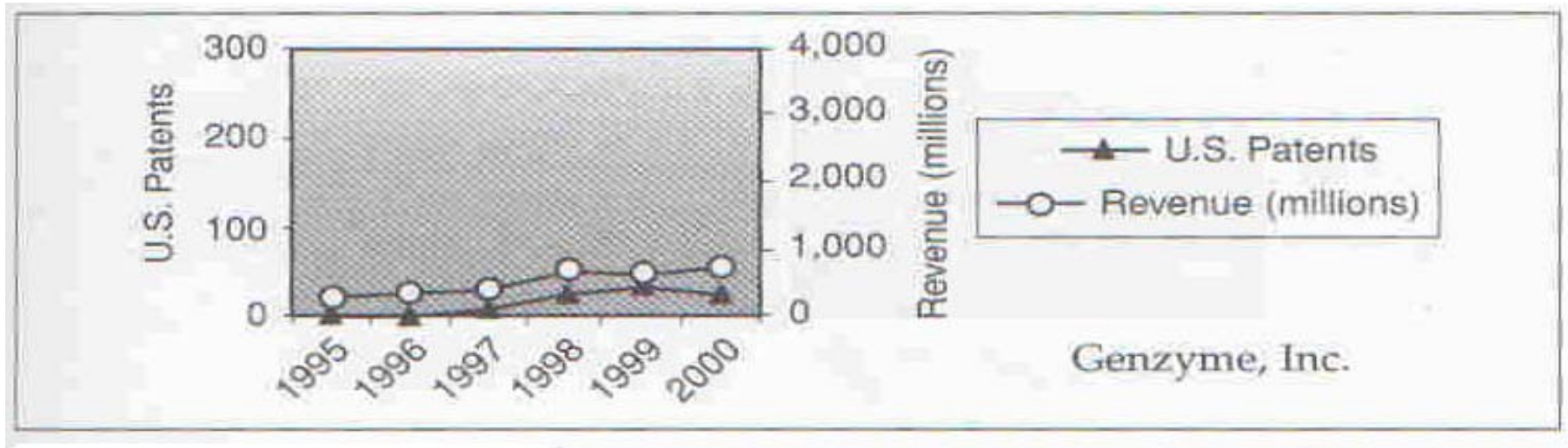
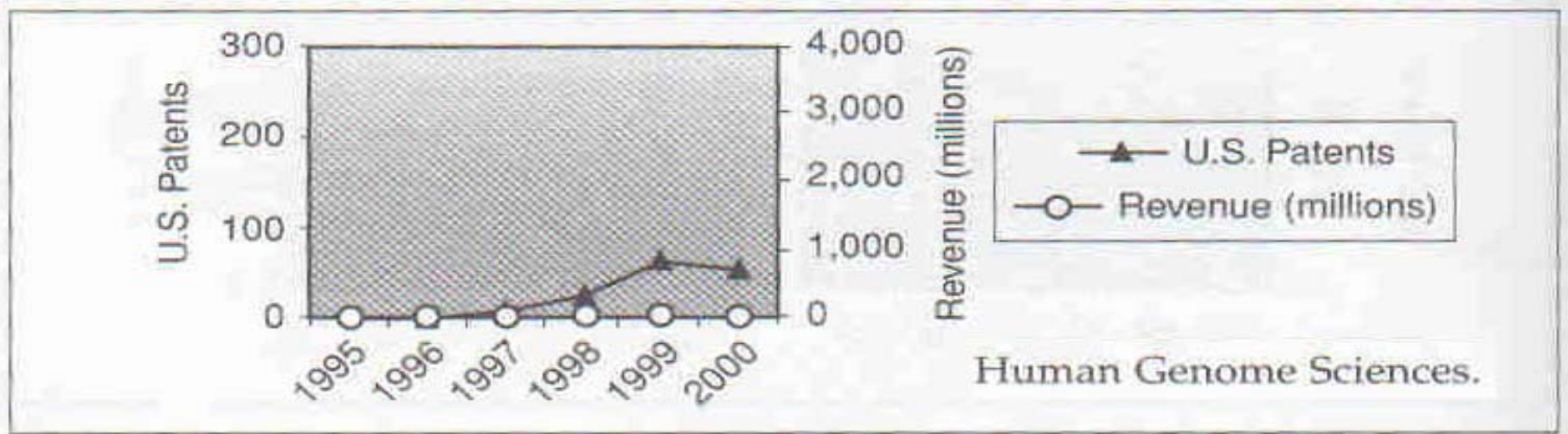


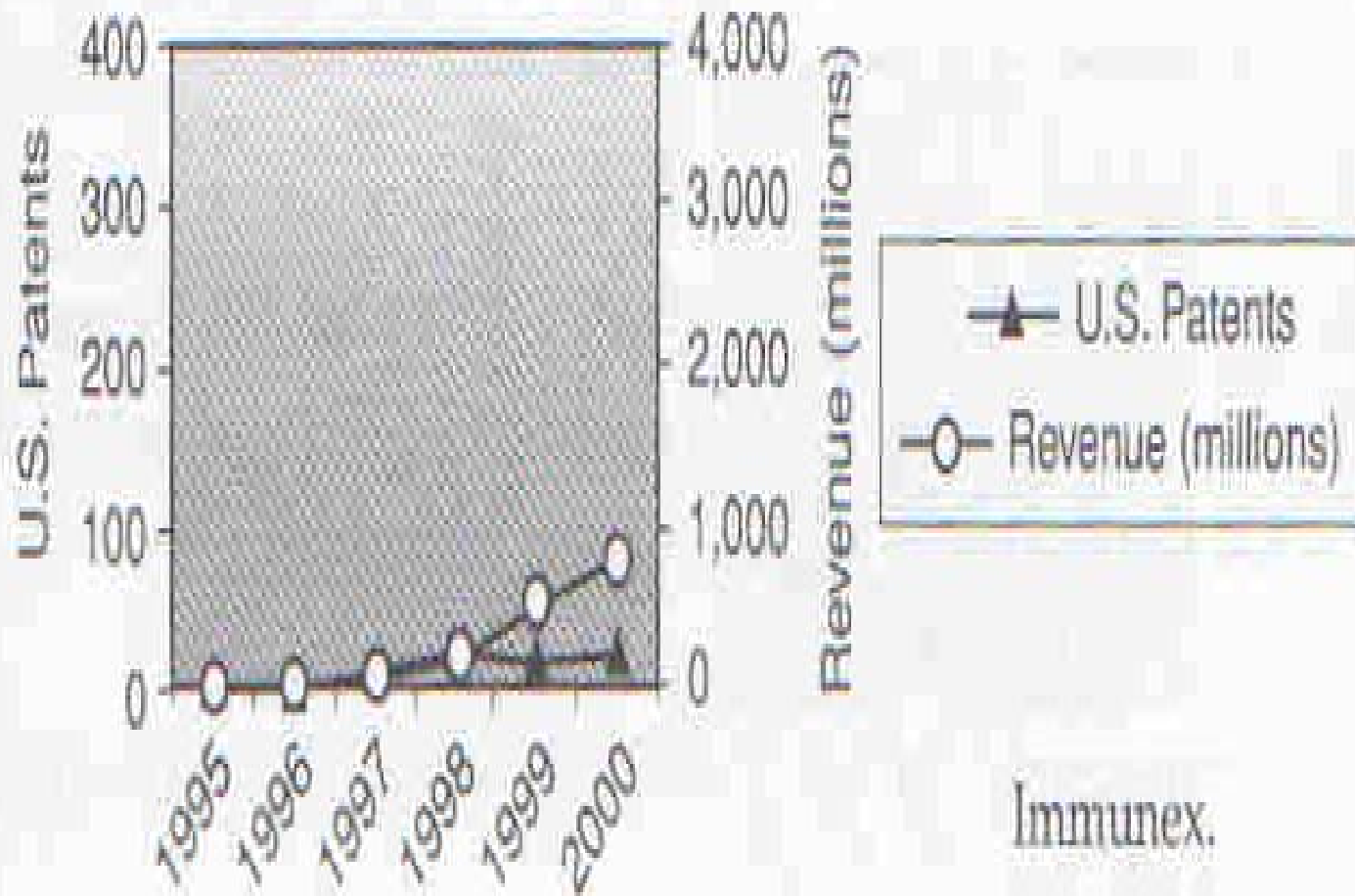
Incyte Pharmaceuticals.



Affymetrix.







Immunex.

Some Options for the IP proprietor

- Use the IP ... manufacture the product, use the process, sell by self or by contracting it to another party.
- License it to someone for manufacturing but market the product by self or by contracting it to another party.
- Sell the IP
- Set-up a Joint venture
- Source of one-time or steady long term income from the license fees/royalties
- Negotiate License for manufacture by and /or marketing with geographical breakup of the markets.

Some Options available to the IPR Holder

- License the IPR to another party (s) with mutually negotiated benefit sharing arrangements
- Cross License for mutually independent working and / or collaborative working
- Assign the IPR to another party (s) for an appropriate return
- Barter rights
- Establish a franchise system involving other parties
- Take action against those who infringe the IP
- Let the rights selectively lapse in certain countries

Paths to Technology Transfer

- Delivery of Know-how and Trade Secrets
- Contract Research and Development
- Establishing Joint Ventures
- Setting up Plants, establishing production processes, quality control procedures, etc. on a turnkey basis
- Licensing patents, designs and other forms of IPR
- Collaborative R&D

A basket of Legal Frameworks to be considered in Technology Transfer

- Contract law
- Patent Law
- Trademarks. GI, Copyrights and Design Law
- Law relating to restrictive and unfair trade practices
- International laws
- Tax and revenue related laws

Note: This is not an exhaustive list

Managing IPR ... A framework

Business Mission

Product and Services Portfolio Strategic Intent

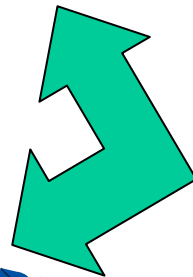
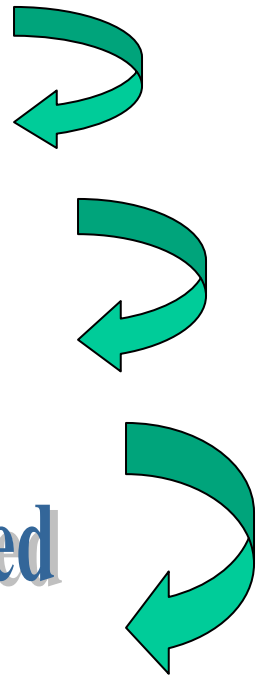
Market and Competitor Positioning

Protection needed
vis-a-vis

existing Intellectual Assets

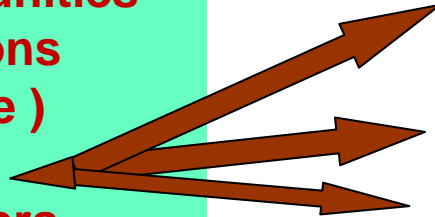
Innovation Strategy and IPR plan

Vision-IPR[®]



Managing IPR ... Concept Phase

- Business Opportunities
- Technology Options
(mapping exercise)
- Strategic Options
- Possible Customers



Acquire Externally ?

Generate Internally ?

PART INTERNALLY/EXTERNALLY ?

Use Patent Information

Generate IP Grid Maps

Formulate Business & Innovation plan

Managing Intellectual Property

CONCEPTS

**INNOVATION
PROCESS**

OUTPUT

MARKET

- Business Opportunities
- Technology Options
(mapping exercise)
- Strategic Options

- Working through the
.IP grid
- Patents & other IPR
Filings/Registrations
- Strategy for
Foreign Filings
- Licensing Options
- Joint Developments

Record Maintenance & Updating IPR Information

Managing IPR

... Innovation Phase

- Working through the IP grid
- Decisions on Patents & other IPR Filings/Registrations

Project Implementation

- Strategy for Foreign Filings
- Litigation Strategy (clearing IPR mine fields)
- Licensing Options
- Joint Developments

Business driven

Decisions

*Signing of NDAs/IPR assignments with employees/contractors,
MOUs with possible partners, Trade Secrets,*

milestone payments, royalty and other benefit sharing arrangements

Managing Intellectual Property

CONCEPTS

- Business Opportunities
- Technology Options
(mapping exercise)
- Strategic Options

**INNOVATION
PROCESS**

- Working through the
.IP grid
- Patents & other IPR
Filings/Registrations
- Strategy for
Foreign Filings
- Licensing Options
- Joint Developments

OUTPUT

- Fit in IPR Portfolio
- Marketing tieups

MARKET

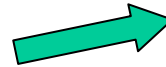
Record Maintenance & Updating IPR Information

Managing IPR

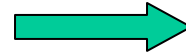
... Output Phase

- Fit in IPR Portfolio
- Marketing tie-ups

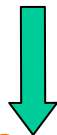
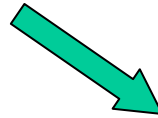
Valuation of the IPR



Evaluate fit
with business strategy
and growth plans



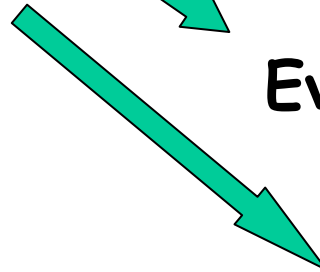
Evaluate Licensing Options



Options for IPR
value extraction

(e.g. venture capital,
business incubators, etc.)

Technology life cycle
analysis



Managing Intellectual Property

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(mapping exercise)
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**INNOVATION
PROCESS**

- Working through the
• IP grid
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Filings/Registrations
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OUTPUT

- Fit in IPR Portfolio
- Marketing tieups

MARKET

- Product Lifecycle
- Managing IPR Portfolio
- Monitoring IPR
- Policing IPR
- Enforcing IPR

Record Maintenance & Updating IPR Information

Managing IPR

... Market Phase

IPR protection during product life

- Product Life-cycle
- Managing IPR Portfolio
- Monitoring IPR
- Policing IPR
- Enforcing IPR

*IPR notification on products
and services*

*IPR Portfolio Maintenance
Strategy*

*Synergy with other IPRs
in the organisation*

*Litigation Strategy
to retain leadership*

Value of Competitors' IPRs

Monitoring possible infringers

Action against infringers

Managing Intellectual Property

CONCEPTS

- Business Opportunities
- Technology Options
(mapping exercise)
- Strategic Options

**INNOVATION
PROCESS**

- IPR Study
- Patents\ other IPR
Filings/Registrations
- Strategy for
Foreign Filings
- Licensing Options
- Joint Developments

OUTPUT

- Fit in IPR Portfolio
- Marketing tieups

MARKET

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Record Maintenance & Updating IPR Information