

# A Research Institution's Perspective

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# INTRODUCTION TO A\*STAR

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- 2200 Researchers
- Two Research Councils
  - Biomedical Research Council
  - Science and Engineering Research Council
- 21 Research Institutes
  - 14 Life Sciences
  - 7 Physical Sciences

# INTRODUCTION TO ETPL

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- Exploit Technologies Pte Ltd is the commercialization arm of A\*Star
- Intellectual Property Managers handle the IP Acquisition Activities
- Commercialization Officers handle the commercialization reviews
- Also have
  - Investment and Spin-Off Management Division
  - Planning, Innovation, Network and Enterprise Division

# ETPL Focus

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- Acquisition of Intellectual Property Rights
  - Review RI ideas/inventions
  - File IP applications
  
- Commercialization of Technology
  - Determine Commercializeableness of ideas/inventions
  - Negotiate Collaboration and License Agreements
  - Spin-Off Planning and Assistance

# ETPL Funding

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- Bridging the Gap Funding
  - Specific deliverable(s)
  
- Project Funding
  - Tied to definable Return on Investment

# Strategies

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- Optimize Commercialization of Technology
  - Through Non-Exclusive Licensing
  - Through Focused Exclusive Licensing
    - Focused as to Territory
    - Focused as to Field of Use
- Collaborate to Obtain Needed Expertise/IP
  - Joint Collaboration
  - License-In of Background IP

# Focus of Agreements

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- Collaboration
  - License In for R&D
  - License Out for Commercialization
  
- Spin-off
  - Technology Transfer
    - IP License
    - Technological Support

# Collaboration Agreements

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- Understand what IP will be needed for the Collaboration and What IP will be needed for continuing after the Collaboration
- Negotiate Background IP Licenses for Collaboration and Post- Collaboration
- Define Foreground IP (Ownership, Licenses)
- Define Scope of Work During the Collaboration
  - Timetables and Deliverables



# Likely Areas of Dispute

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- Scope of Work not being met
  - Define how and when to discuss
  - Define how to Amend Scope of Work
  - Define Resolution
    - Failure to Provide Deliverables
    - Failure to meet Timetable
- Development of Foreground IP
  - Patent Applications not being filed
  - Untimely Disclosure of Ideas/Inventions

# Technology Transfers

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- Identify the Technology Needed
  - What IP Licenses are Needed?
  - What Expertise is Needed?
- Controls on the IP
  - Particularly Trade Secret Handling
- Goals and Time Lines for Commercialization of the Technology

# Likely Areas of Dispute

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- Failure to Commercialize
  - When to “Pull the Plug”
- Failure to Meet Goals
  - Obtain Necessary Expertise
  - Obtain Timely Financing
- Mishandling of IP
  - Trade Secrets
  - Copyrighted Material

# Approaching Companies Outside Singapore

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- Identify Interested Group/Location within Company
- Or Identify Needed IP
- Or Identify Persons of Interest or Related Expertise

# Negotiating Cross-Border Agreements

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- Due Diligence
  - Define the Walk-In and Walk-Away Positions
  - Define Acceptable Exit Strategies
  - Identify a Team
  - Understand the Other Party
    - Previous Agreements
    - Potential Needs/Wants
  
- Negotiate Scope, Term, and Technology of License