

**Patenting By Universities
Commercial Aspects for Inventors and
Administrators**

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24 February 2006

Why are universities different?

- Because they don't manufacture and sell products.
- So patents are not inherently linked to and funded by a production process or product
- Only prospect of financial return is licensing.

Where the research is collaborative with industry there may be immediate financial return but will it cover patenting costs? If so, for how long and to what extent?

Also, in many cases research is more long-term in its character, and its results.

Industry is generally different as product is often on the market shortly after patent application filed.

So how do you manage this?

- Control cost
- Budget
- Delay cost
- Bring as much as possible in house
- Be realistic with commercialization

Control Cost

- Conduct prior art search and evaluation to ensure patentability – patent + literature
- Good invention disclosure – English
- Budget to establish how much you can spend on the invention and stick to it unless something changes – negative and positive.

- Act quickly and completely when search report/written opinion received
 - Keep it relevant to the issue at hand
- Timely instructions
- If no return in reasonable time, start lapsing patents and applications
- Carefully selection of agents/attorneys - watch quality and competence not just cost

Delay Cost

- World patent system is jammed mainly due to political interference and underfunding
- Many countries way behind in search and examination
- Use low cost first filing then PCT
 - But this may cause major delays in e.g. USA. Is this a problem? This delays major cost (national filings) for up to 30 months

- Be ruthless but practical in reducing list of countries for filings. For EP, reduce designations.
- Combine related inventions and file divisionals when required
 - But, watch extra search and examination fees

In house

- The more you do , the less we do
- Therefore, lower cost
- But it must be done well
- And watch increased administration cost
- Training of research staff on patent issues
- Use the free services of your attorneys

Commercialization

- Be realistic on how much licensees should pay
- Invention may be great, but how much is it worth to your industry partner?
- Identify and negotiate with industry partners early. Have them pay for patenting.
- Collaboration agreements for long-term research - and in research?
- Be futuristic

Watch for infringement guarantees

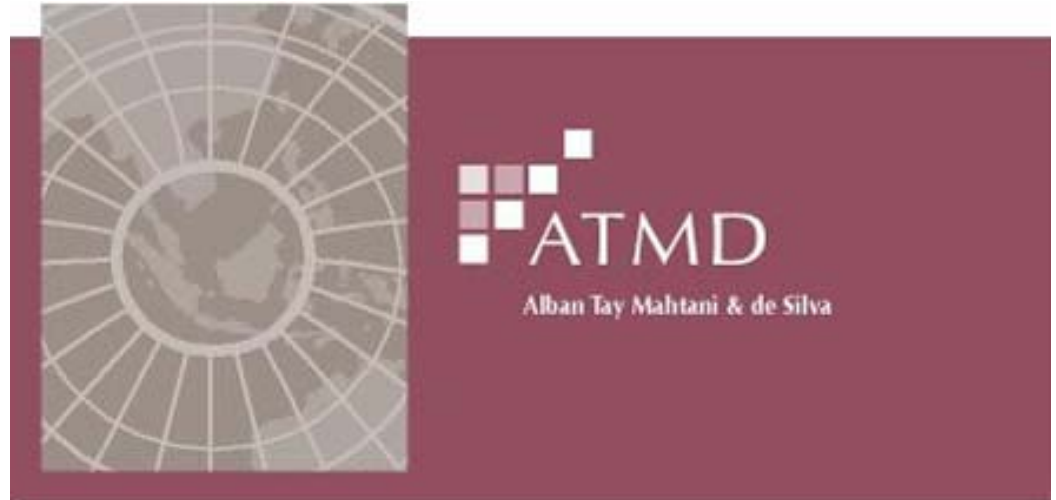
- You can't.

Your industry partner should do this as they are far more aware of the market conditions, who is doing what, and to whom.

- Patenting is expensive
- Particularly when there is no sale of a product/process to fund the cost
- Good management and quality work can control, delay and reduce costs

At each and every step:

- Do we really need this?
- Can we afford this step?
- Can we afford to not do this step?
- Is it of value?
- Who are our industry partners? Actual or possible?



Thank You!

Q&A