

Intellectual Property Strategy and the Tech Transfer Process: Advanced Issues for Researchers

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Advanced Issues?

- Broaden Understanding of the Process
- View of the Forest
- How You Can Help



Agenda

- What is a Patent
- Why Patent
- When to Patent
- Researcher's Role in the Process
- Q&A



Patent Quotes

- "The patent system added the fuel of interest to the fire of genius." - Abraham Lincoln
- "... the very first official thing I did ... was to start a patent office; for I knew that a country without a patent office and good patent laws was just a crab, and couldn't travel any way but sideways or backwards." - Mark Twain



What is a Patent

- A Business Instrument
 - Affords companies, universities and innovators freedom to operate and protects/promotes financial and intellectual capital
- Legally
 - Constitutionally provided government granted right to exclude others from practicing the claimed invention for up to 20 years from filing
 - Intended to encourage disclosure to the public
 - Covers new, useful and non-obvious inventions



Why Patent

- Company Perspective
 - Protect a valuable product or method (for self or licensee)
 - Scope of protection (geographical and technical)
 - Grow portfolio to enhance value – actual or perceived (start-ups, early stage, established companies)
 - Defensive protection (or publish)
- Emphasis may differ by industry sector



Why Patent

OHSU Perspective

- Preserve value for OHSU
 - Sponsored research
 - Royalty revenue
 - Startup investments to researchers and to university
- Dissemination of technology
- Preserve value of potential collaborator (see previous slide)
- Satisfy government regulations (Bayh-Dole)



Why Patent

Innovator Perspective

- Dissemination
- Notoriety
- Sponsored research
- Royalties
- Seed value for start-up enterprise



Challenges / Stresses

Challenges:

- Most good research can be patented
- Not all good research should be patented
- Research changes over time (inconsistent)
 - Patent process on different time scale
- Early stage research difficult to match to commercial end
 - Knowledge of markets, relevant players, uses of technology, and timing are all needed to maximize value
- Patent or publish or both?
 - Impact of public disclosures on value



What to Patent

- OHSU patents are the TRC's product
- Patenting decisions are based on realizable value to industry
 - Disruptive or incremental improvement
 - Market size (3rd party license or startup)
 - Market accessibility
 - Strength of IP
 - Foreign rights (read: publication bars)
 - Pioneering invention vs. Crowded Field
 - Single product or platform technology
 - Stage of research



Researcher's Role in the Process

- Procuring a Patent
 - Identify and clarify the novelty (w/ PTO)
 - Advantages over the art
- Promoting the Technology
 - Identify commercial applications
 - Assist with contacts in industry
 - Technical lead in negotiations
- Communicate early and often with TRC
 - Especially about public disclosures



Summary

- Patents are business instruments
- Patents only have as much value as collaborators are willing to provide
- Determining value in advance is hard (but not qualitatively impossible)
- The TRC needs the innovator involved



Q & A

Thank You

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