



IP PRAGMATICS

OUTLINE COURSE FORMAT:

An Introduction to Intellectual Property and its Relevance to Research Scientists

Background & Aims:

Researchers at universities and institutions have an obligation to themselves and their employer to safeguard intellectual property. As a first step they must become familiar with the basics of what constitutes intellectual property and what arrangements exist within their host organisation for dealing with intellectual property matters.

This introductory course aims to provide researchers who are at a career stage where they will want and be expected to take a more direct responsibility for the creation, protection and exploitation of intellectual property with relevant hands on knowledge of:

- the Institute's or University's policies with respect to intellectual property and the people responsible for implementing this.
- what constitutes intellectual property and how this can be protected.
- the role and impact of intellectual property in contracts, grants and material transfer agreements.
- how intellectual property can be exploited and the benefits/pitfalls for the researcher and the Institute or University of the different approaches that can be taken.
- how intellectual property matters can be safeguarded during interactions with industry
- how researchers can best work with their technology transfer office to maximize the value and minimize the impact intellectual property can have on their research activities.

Course Format:

The course will be in two modules run over two thirds of a day. The general format for the course will be a combination of informative presentations, question and answers sessions and hands on case studies of direct relevance to the institute or university concerned. The courses are expected to have between 25 and 35 participants who will be expected to play an active role during the day.

The first module will cover the basics of what intellectual property is, why it is important and how it can be protected in a way to maximize its value and minimize the impact it can have on research. In the afternoon session, the second module will cover the exploitation of intellectual property, how opportunities are assessed, what the different exploitation routes are and how to interact with industry to maximize the benefit to research and minimise conflicts.

The course will be run by experienced technology transfer practitioners who have more than 35 years of collective experience in the protection and exploitation of early stage intellectual property from academic research institutions. As well as running the course these individuals will be available during the day to address specific questions that any of the sessions may raise.



IP PRAGMATICS

Attendees will be provided with a course handout and accompanying notes for them to keep for future guidance and reference.

Outline Programme Example

0925 Registration

0930 Introduction to the course and its aims

0935 Session 1: Funders and University/Institute intellectual property policy

- Why is intellectual property important to our funders and the Institute/University, and what are the drivers coming from government
- What is the University/Institute IP policy
- What support mechanisms does the University/Institute have to help support knowledge transfer
- How are researchers rewarded for their intellectual property contributions

Format – 20 min talk , 5 min Q&A

1000 Session 2: Introduction to intellectual property

- What types of intellectual property are there and which are most important to research scientists
- Patents – what are they, how do you apply for them and what factors need to be considered when deciding when and how to apply for a patent
- What is the role of the researcher in the patent process
- Other forms of relevant IP (e.g. copyright / database rights / know how) – what are they and when might they be relevant to your research outputs
- Inventorship and why its different to authorship on a paper
- Disclosure – what constitutes a disclosure and how does this effect the patenting process at different time points
- Lab notebook keeping hints and tips

Format – 40 min talk, 30 min interactive Q&A with recent University/Institute case studies

1110 Tea & Coffee Break

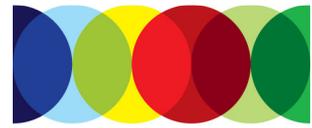
1125 Session 3: Engaging with industry and safe guarding intellectual property in grants and contracts

- Why interact with industry? Benefits for the researcher and the University/Institute
- Myths and realities of interacting with industry
- Different routes/opportunities to interact
- Government schemes to facilitate such interactions (e.g. LINK / Faraday)
- Maximising the value and avoiding the pitfalls from such interactions
- What role do grants and contracts have on intellectual property
- How can these grants and contracts impact on your research activities and how can pitfalls be avoided
- What is the role/responsibility of the research scientist in putting together such contracts and where does the University's/Institute's contract and commercial office assist
- Specific contracts, their role and impact on IP including material transfer agreements and sponsored research agreements

Format – 20 min talk, 20 min interactive Q&A with recent University/Institute case studies

1205 Morning session wrap up and discussion

1210 Lunch break



IP PRAGMATICS

- 1300 Introduction to afternoon session – Exploiting intellectual property**
- 1305 Session 4: Evaluating the opportunity**
- What are the important steps to take when finding and evaluating a new IP opportunity
 - What due diligence is required and how can the researcher assist the tech transfer staff with this process
 - How opportunities are valued and what input may be required from the researcher
 - What invention disclosure system is used by the University/institute and how does this operate
 - Turning a “maybe” to a “yes”
- Format – 20 min talk, 20 min interactive Q&A with recent University/Institute case studies**
- 1345 Session 5: Exploitation routes: licensing versus spin out**
- What are the different exploitation routes that can be taken
 - What are the benefits and pitfalls of each route
 - What are the drivers for going down each route
 - How might these routes impact differently on the researcher and their research
 - What is a licence and the licensing process
 - The process of forming a new spinout
 - Information on what external support mechanisms exist (e.g. government schemes and local ones such as Challenge Funds)
- Format– 25 min talk, 20 min interactive Q&A with recent University/Institute case studies**
- 1430 Session 6: Implementing best practice (IPPL or local tech transfer office led)**
- Summary of key best practice pointers
 - How to interact and maximize assistance from local technology transfer staff
 - Local TTO set up and contacts
 - Finding further help – external and internal
- Format– 10 min talk, 10 min interactive Q&A**
- 1450 Wrap up and conclusions**
- 1500 End**

Session Overviews:

Session 1: Funders and University/Institute intellectual property policy

This first session sets the scene for the day by explaining the government’s drive for knowledge transfer and how this has been translated into action by universities and the research councils. It also covers the various mechanisms the university/institute has to help researchers protect and exploit their IP.

Session 2: Introduction to intellectual property

The talk part of this session introduces the

audience to the different forms of intellectual property. Recent examples of university/Institute patents, exploitable know-how, copyright etc are used to illustrate this. The talk goes on to talk in more detail about patents and the patenting process, including time lines and costs. The talk finishes with a section on inventorship, disclosure and lab notes book-keeping.

There are two hands on case studies used during the session. One on inventorship where the audience is given a history of the work behind a recent invention, a list of possible inventors and is asked to discuss as a group why they feel each may or may not be an inventor. The second is on



IP PRAGMATICS

disclosure where the audience is presented with a series of scenarios where a researcher has discussed their work or submitted it for publication and they are asked to discuss which constitutes a disclosure and which don't.

Session 3: Engaging with industry and safe guarding intellectual property in grants and contracts

This session introduces the researcher to the different ways in which they can receive research funding, including working with industry, and the impact these grants and contracts can have on intellectual property and their basic research. The session also covers government funding schemes that are available for encouraging interactions with industry. The theme of the session is to help the researchers understand that these agreements do impact on their research and that they need to be managed properly with assistance from their contracts office. The emphasis is put on grants that are relevant to the local department (e.g Research Council, EU FP7 grants, Wellcome, TSB etc). The university's policy with respect to materials transfer agreements can also be included.

The hands on case studies used include one which illustrates a recent grant caused problems with IP exploitation and an example of a researcher interfering with IP exploitation contract negotiation to the detriment of the institution's contract office. The later is used to help them understand how best to work with the contracts office to safe guard their research interests and the institution's needs.

Session 4: Evaluating the opportunity

This session will illustrate to the audience how and why evaluation on new IP opportunities is carried out and specifically how the local tech transfer office goes about finding and evaluating such new opportunities and what will be expected of the researcher within this process. A case study of three evaluation opportunities is used to ask the audience to review and comment on each one's exploitation potential. The examples used are either real ones from the institution or made up ones based on the research activities of the local

department. They include a clear cut good opportunity, one which is border line and one which has no commercial potential. These examples help the audience appreciate that evaluation covers IP strength, market needs, market potential and inventor support.

Session 5: Exploitation routes: licensing versus spin out

The main theme of this session is to illustrate how researchers can influence the exploitation route taken with commercial opportunities and what their role in this can/needs to be. Again this will bring out to the audience the role that the local tech transfer office plays in this process and how researchers should interact with them to maximize their benefit from the process and minimize hassle. The session also covers local and government support schemes that can be used to help develop opportunities to increase their exploitation potential (e.g. university challenge funds, BBSRC follow on funds etc). The case studies used include one on licensing royalties using three real institution examples or fictional examples to illustrate how researcher expectations and commercial reality can be somewhat different. The audience is asked to review each example and come up with a percentage figure on what they feel is a reasonable royalty return to the institution. The real or likely deal terms are then discussed. A second case study on exploitation routes uses three real institution examples or IPPL real examples to get the audience to assess and discuss whether each is a licensing or spin out company opportunity. This helps them appreciate the drivers and benefits for going down either route. Tech transfer personal involved in the real deals can be brought in to the discussion to say how the real situations progressed and what the issues were.

Session 6: Implementing best practice

This is an opportunity to pull together the different messages from the day and to reinforce the local tech transfer contacts that are there to support the researchers.

IP Pragmatics Limited, 1 Quality Court, Chancery Lane, London WC2A 1HR, UK
www.ip-pragmatics.com

Tel: +44 (0)20 3176 0580 Fax: +44 (0)20 3176 0396 Registered in England No. 3989268 VAT Registration No. 824038644