

Only One Theme

Wave 2

An awareness campaign on Innovation Management

Only

Setting up a Patent Cell

Premnath V

Director | Venture Center



17 October 2023
4:00 PM to 5:00 PM



Online via ZOOM
Broadcasted from
IBPL Studio Room





Tech Transfer Hub at Venture Center
Supported by NBM - BIRAC

Topic: Setting up & Running a Patent Cell

Speaker: Premnath V, PhD

Founder Director, Venture Center; Chief Scientist, CSIR-NCL



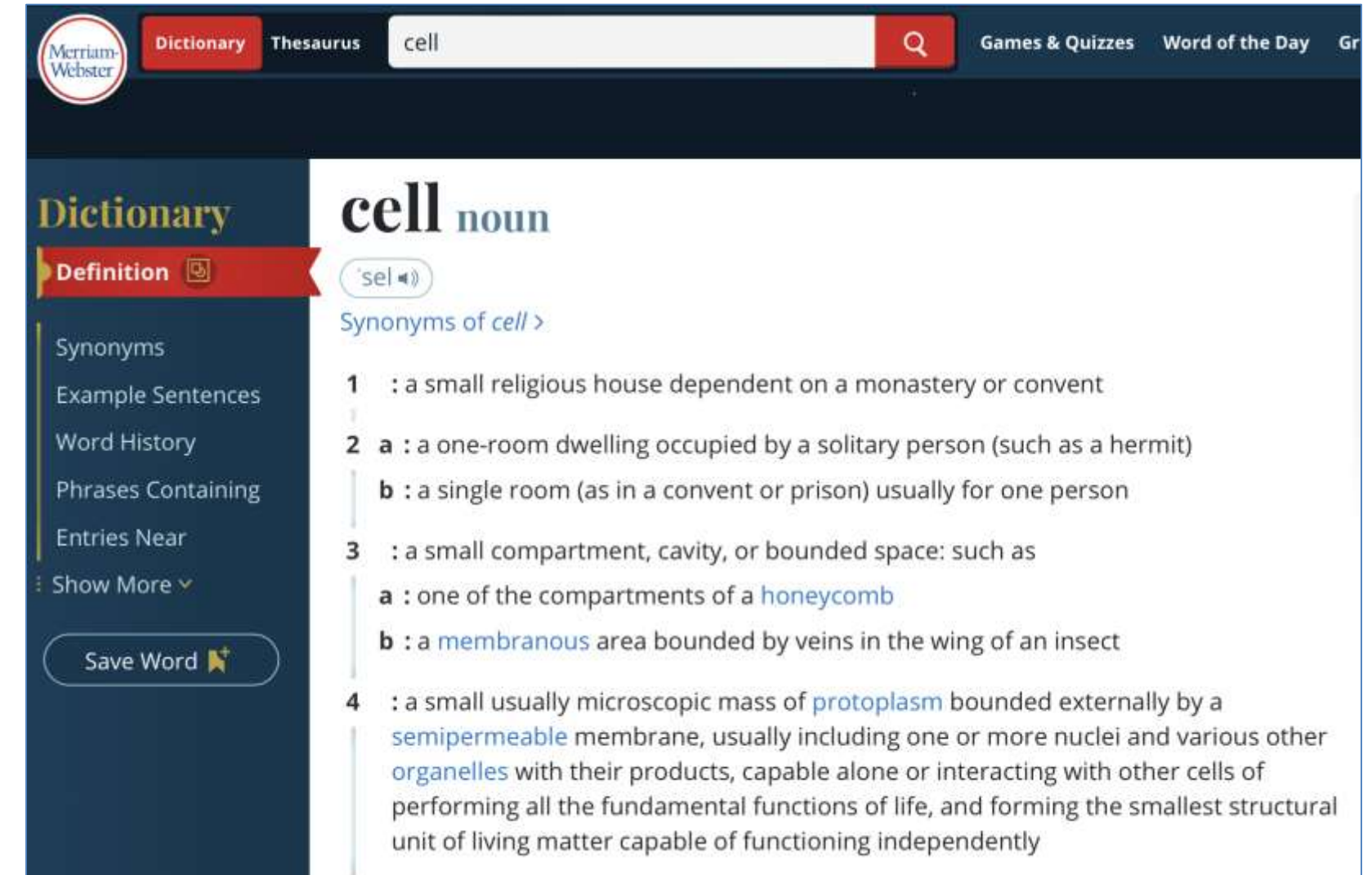
Nomenclature and Scope

Nomenclature:

- ❖ Only “patents” or “intellectual property” or more
- ❖ Cell or Office or Group

Scope:

- ❖ Protection ? Portfolio Admin?
- ❖ Marketing ? Leads? Match making?
- ❖ Deal making ? Contract mgmt?



Example: Intangible assets that may be of value coming out of medical research institutions:

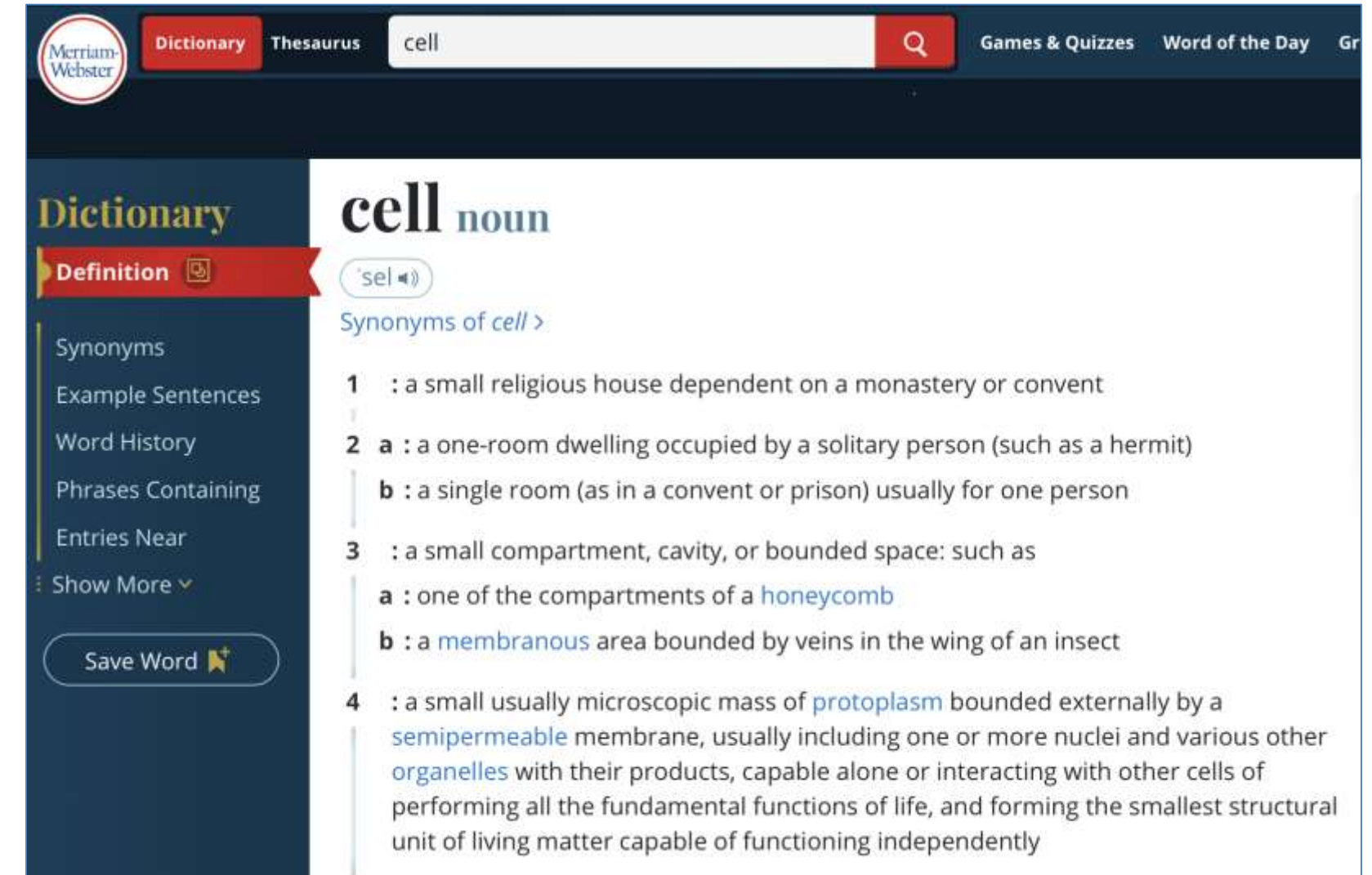
- ❖ Inventions
- ❖ Designs
- ❖ Software and databases (including clinical records and datasets)
- ❖ Unpatentable materials (including biological materials; collections in biobanks)

Nomenclature:

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Example for Scope: NCL's Intellectual Property Group

Purpose/mission:

- *To help build and administer an IP portfolio (with an emphasis on patents) for NCL as cost effectively as possible and with efficient, scientist-friendly systems/ processes.*
- *To oversee and manage all issues relating to ownership, inventorship, sharing of information with IP potential, advise on IP clauses etc*

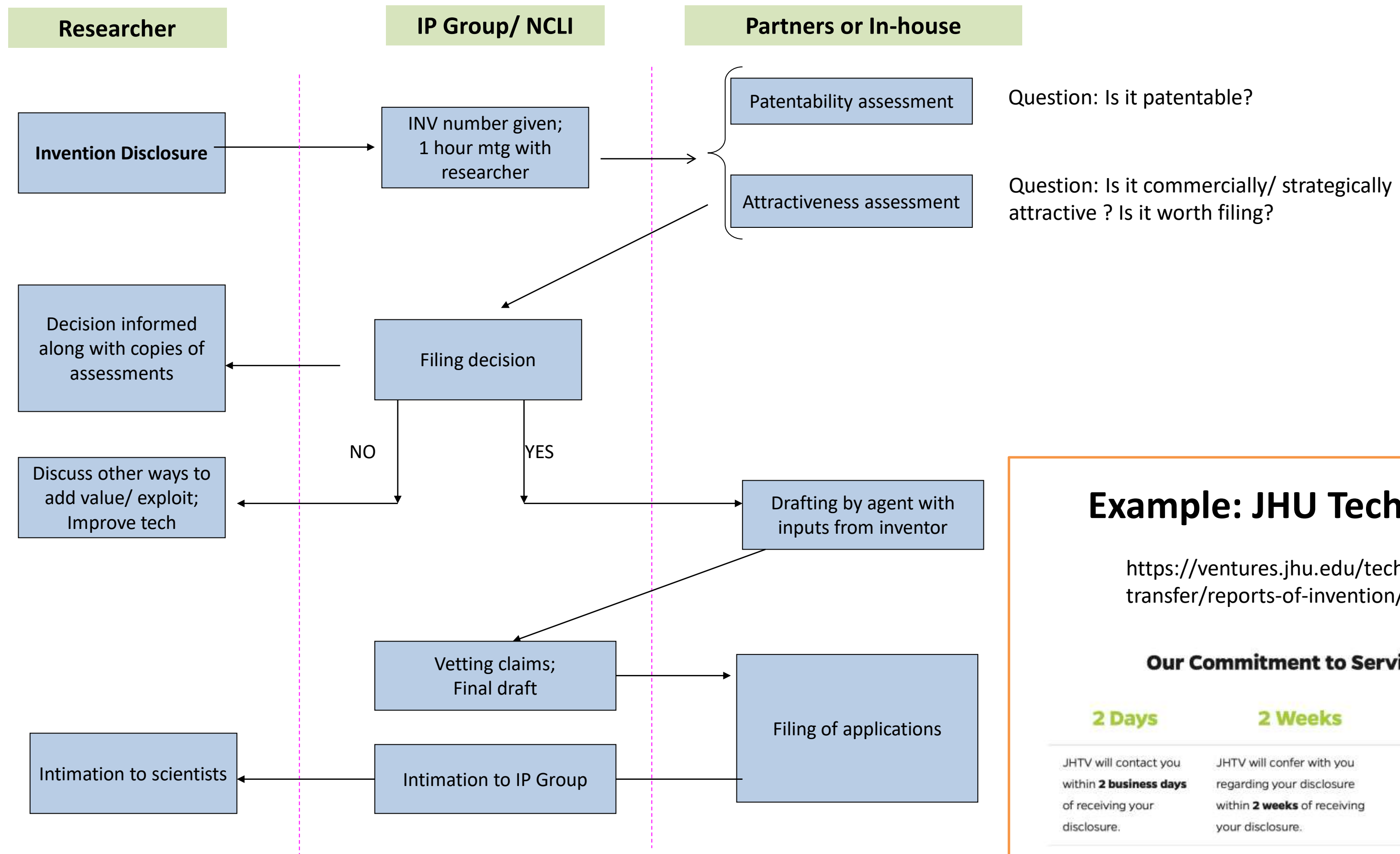
Focus areas:

- *Quantity of IP*
- *Quality of IP*
- *Efficiency and speed*
- *Cost optimization*
- *Clarity in ownership rights, patent administration responsibilities, minimum disagreements/ surprises*
- *Good record keeping*
- *Increase awareness and sensitivity; patent evangelism*
- *Scholarship in IP strategy; Good advise on IP related matters*
- *Compliance to laws*

Workflows of an IP Group/ Patent Cell:

1. Disclosures → Filings → Prosecution → Grant → Maintenance
2. Ownership, rights and responsibilities; Agreements like MTA, JDA, JIAA
3. Portfolio planning and cost management
4. Data and records management; correspondence
5. Awareness, training and scouting for inventions/ other IP
6. Engaging external service providers/ consultants; Call and contract mgmt.
7. Advise the leadership team on IP matters, clauses in agreements etc

Example: NCL's patent document flow and decision points



Example: JHU Tech Ventures

<https://ventures.jhu.edu/technology-transfer/reports-of-invention/>

Our Commitment to Service: 2-2-2

2 Days

JHTV will contact you within **2 business days** of receiving your disclosure.

2 Weeks

JHTV will confer with you regarding your disclosure within **2 weeks** of receiving your disclosure.

2 Months

JHTV will provide a written determination within **2 months** about the commercialization plan.

Agreements/contracts shaping ownership:

- ❖ Staff – Employment (regular/ temporary) contracts
- ❖ Students – Fellowship/ scholarship agreement
- ❖ Consultants – Consulting agreements
- ❖ Visiting students/ staff – IP agreement on joining
- ❖ Academic Collaborators – Collaboration agreement or MoU
- ❖ Industry Collaborators – Joint development agreement or sponsored research agreement

Agreements for protecting against misuse:

- ❖ CDA/ NDA
- ❖ MTA

Components of an IP Group/ Patent Cell:

IP Policy

Core Team

Authority for
Decisions
(Individual or
Committee)

Budget

External Service
Providers; Attorney
Firm

Office and Meeting
Room

Workflows and
formats

Assessments and
Decision Support
Reports

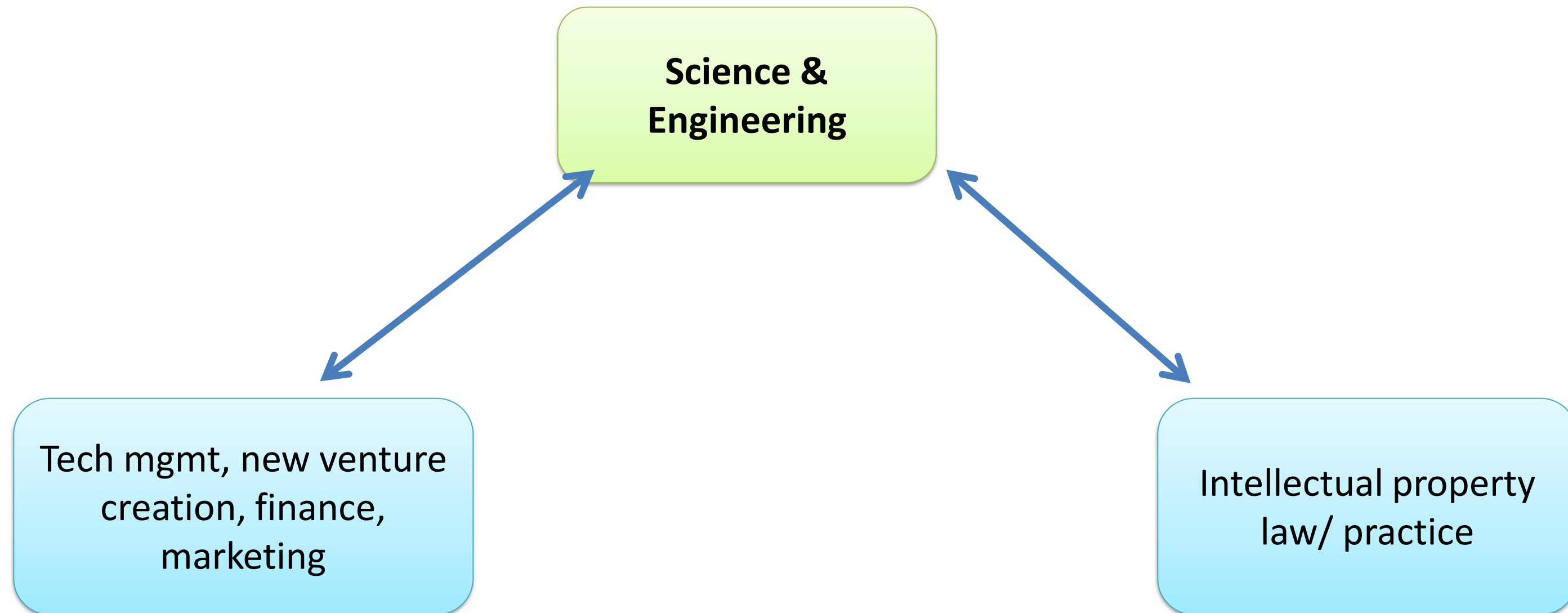
Database of IP
assets with
portfolio analysis
tools

IP Search Databases

Team at IP Group/ Patent Cell – desired abilities:

- ❖ Ability to understand and document an invention; Visualize draft claims
- ❖ Ability to conceptualize and strategically design claims (in organizations interest)
- ❖ Ability to gauge if the case for novelty and non-obviousness is strong or advise how it can be strengthened
- ❖ Understanding of the law and procedures/ terminology of the patent offices; translate legalese to simple language for inventors
- ❖ Prepare decision support documents; provide recommendations

Broader team for innovation management:



Decision making authority:

- ❖ Many organizations in India use committees. Single person can also be authorized to take decisions. That is more common in TTOs in US.
- ❖ Pointers:
 - ❖ Ensure committee understands about IPR and has read the policy
 - ❖ Ensure committee has a supportive, positive tone
 - ❖ Ensure committee has time and is sensitive to deadlines/ speed
 - ❖ Structure decision making process to be as objective as possible
 - ❖ Provide decision support documents

Budget – typical cost items

- ❖ IP Protection Cost:
 - ❖ Drafting, filing, prosecution services/ IP attorney cost
 - ❖ Statutory fees for filing, examination etc
 - ❖ Others like translation costs
 - ❖ Maintenance fees
- ❖ HR and engaging specialized consultants
- ❖ Software and databases, if required

Pointers:

- ❖ If an organization wants inventors to file for more patents, then the organizations should create a separate pool of funds for IP costs and not expect the researcher to arrange money for the IP costs.

Events

- ❖ Talks for awareness, inspiration
- ❖ Workshops for training students and researchers
 - ❖ Example: How to do patent searches?
 - ❖ Example: How to spot an invention?
 - ❖ Example: How to come up with inventive ideas?
 - ❖ Examples: A primer on patents for researchers
- ❖ Opportunities for IP Group/ Patent Cell team to scout for potential inventions
- ❖ Events recognizing/celebrating inventors in the organization
 - ❖ Example: Mahindra's has an Inventors Day; GE has Wall of Inventors (celebrates prolific inventors)

External service providers

- ❖ Drafting, filing, prosecution
- ❖ Decision support documents – ex: Patentability Assessment
- ❖ Training
- ❖ Research planning reports – ex: Patent Landscape, Freedom to Operate, Whitespace Analysis

The need for attorneys:

- ❖ Experience in drafting, filing, prosecution
- ❖ Larger attorney firms can afford to have industry-specific specialists
- ❖ Certain jurisdictions will require filings, prosecution by a qualified attorney
- ❖ Between attorney firms and their foreign affiliates, specialist advise for each jurisdiction is possible. Inventors may not have depth knowledge of different patent laws. Inventors alone may not have the time to learn about each jurisdiction and handle logistics for multiple countries
- ❖ Patent filing to grant and maintenance require careful monitoring/actions and not missing deadlines
- ❖ Must-have for litigations

Portfolio and cost management:

- ❖ Decisions – should we file?
- ❖ Where should we file? Scope of filing? How much will it cost?
- ❖ Maintenance decisions and how much will it cost?
- ❖ What to keep ? What to let go? – focus areas, patent “thickets”, complementarity, strategic vs commercial interests

How to increase submissions of invention disclosures – basic needs:

- ❖ Do not ask inventors to find their own funds for patenting costs
- ❖ Reduce time spent by inventors on drafting, answering queries/ clarifications etc
- ❖ Reduce barriers/delays to publications/ presentations to minimum (**very important**)
- ❖ Reduce bureaucracy, paperwork, delays in decision making (committees and hierarchy), empowering inventors
- ❖ Awareness, remove fear of the unknown, remove myths
- ❖ High level support – commitment, carrot and stick
- ❖ Inventors should not have to deal with IP jargon and legal processes
- ❖ Sincere and authoritative efforts for licensing/ commercialization

CONTACT US

FOR MORE INFO



+91 91564 65146



tto@venturecenter.co.in



**750, Venture Center, NCL Innovation Park,
Dr Homi Bhabha Road, Pashan,
Pune 411008, India**



www.techex.in



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THANK YOU

