

Maximising the Value of IP Best Practices from the Commercial World

Dr Robert Harrison



Overview

- Big Company – idea submission
- SME – contracted research
- Consortium research



The Goal

A Patent without a (potential) Business is worthless

A Business with a Patent can be successful



THE BIG COMPANY



Big Company – Business Proposal

- Open Innovation promoted by many companies
- Beware – big companies have multiple research groups
- Technology scouts



Idea Submission Process

Submit Idea

Initial Review

Technical Review

Legal Review

Business Review

Initial Review

Generally Acceptable

Compatible with Current Technology

Complementary to Existing Technology

Potential new Business Model



Legal Review

IP Position

- Patent granted / pending
- Publication
- Copyright
- Third Party IP
- Trade Secrets

Inventorship / Authorship



Technology Review

Technically Feasible?

Understandable

IP Position

Appropriate Reviewers



Business Review

Can we make a business?

Costs of Implementation

Potential Sales Appropriate reviewers



Intellectual Property

- Open Innovation \neq No IP protection
- Patent application is often required for submission
- Patent application protects submitter's interests
- Don't give everything away at the beginning
- **Show and tell** is probably the most valuable aspect of the submission.



SME CONTRACTED RESEARCH



Contract Research

- Development of a new sealant material



IP Interests

Manufacturer

- Product Design (Design Rights)
- Market
- Need
- Electronics Technology (Some Patents)
- Skilled Engineers

Research Institute

- EMC Sealant Technology.
- Five Patents
- Know-how
- Skilled Engineers



Initial Position

Manufacturer

- All IP exclusive to manufacturer
- Free licence to background IP
- Confidentiality

Research Institute

- Full payment for work done
- No exclusivity
- Freedom to develop products for other customers
- Freedom to publish



Final Position

- Background IP
- Foreground IP
- Publication
- R&D
- No exclusivity
- Exclusivity + transfer of ownership
- Publication after patent
- Right continue to research



CONSORTIUM RESEARCH



Intellectual Property

- Background : all IP brought into consortium
- Foreground : all IP developed by consortium

How do we exploit this?

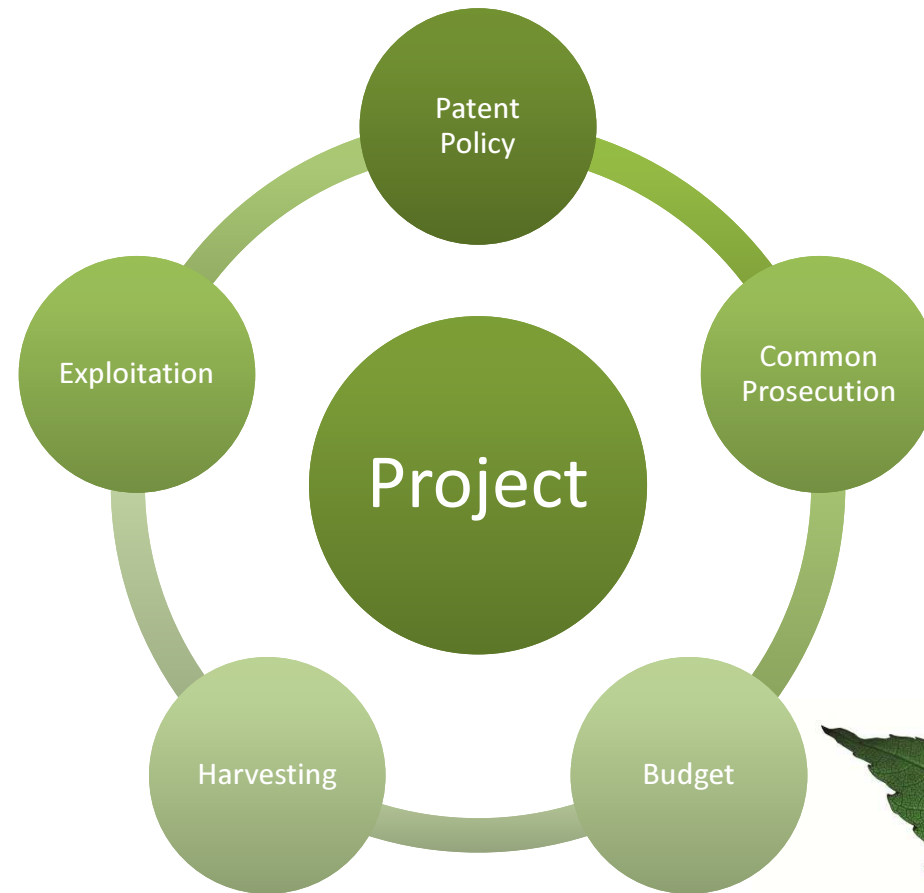


Prior to Consortium

- What is my IP?
- Identify what I bring to the table
- Example: Patent Harvesting



Consortium Work

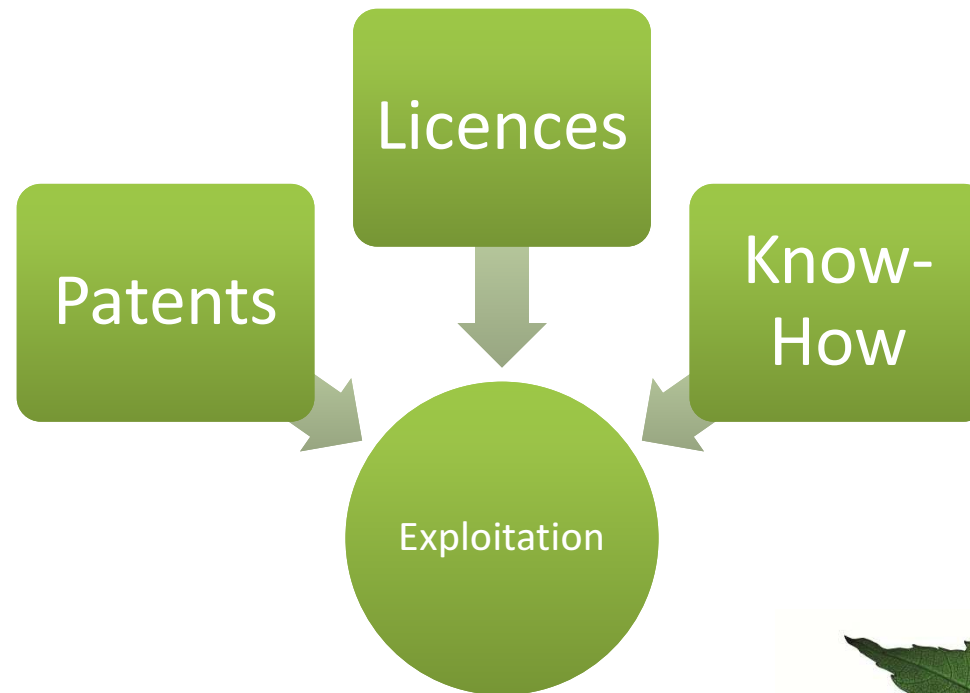


Exploitation

- Ownership depends on employer
- Fragmented licensing policies



Exploitation Company



IP Licensing Organisation Video Telephony

- Licensing Organisation holds some patents
- Licensing Organisation has exclusive licence to some patents + non-exclusive to others
- Licensing Package



A SUCCESS STORY



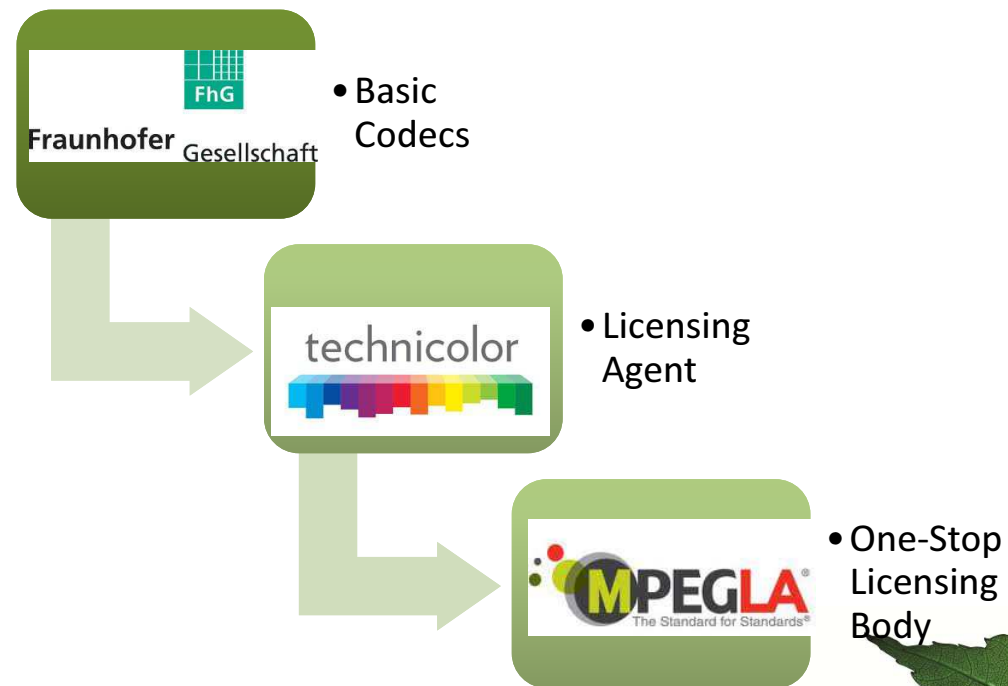
Software

- Is not patentable?
- Can only be patented in the US?





MP3 Licensing Chain



PHILIPS

Microsoft®

Lucent Technologies
Bell Labs Innovations



Thanks

Dr. Robert Harrison
harrison@24ip.com

Tel: +49 1511 2066 303

