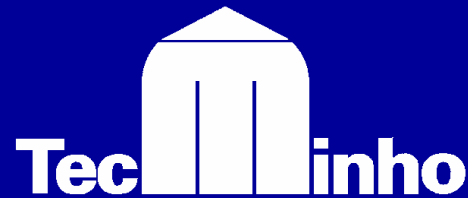




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From early stage IP assessment to closing the deal: experiences from University of Minho



*Marta Catarino
Tech Transfer Director
University of Minho, Portugal*



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University of Minho, Portugal



Location

**Campus of Azurém
(Guimarães)**



Rectory (Braga)



**Campus of Gualtar
(Braga)**



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Generic Information

- Founded in 1974
- 18000 undergraduate students
- 1300 Master and Specialization Students
- 800 PhD students from 22 nationalities
- 1100 faculty (2/3 PhD)



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Innovation Ecosystem



R&D

TecMinho (TTO)

Spinpark (Incubator)

Avepark (S&T Park)



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TecMinho – Tech Transfer Office

Private not-for-profit association, founded in 1990 as an interface of University of Minho.



Continuing Education Department



Technology Transfer Department



Entrepreneurship Department



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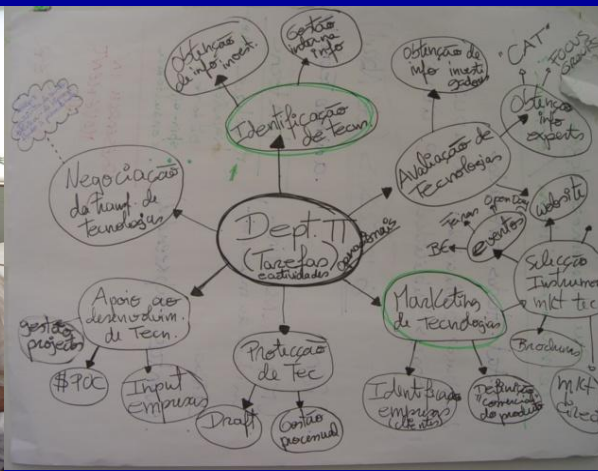


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TecMinho – Main activities

- Partnering
- Commercialising R&D results
- Supporting Entrepreneurship



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Examples



Oon Candlemaker
- Mário Silva

Transportable Tourist Tower
- DST/UM



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Lessons Learnt

- Early-stage assessment of commercial potential
- Professional management of University-Industry collaboration
- Dual approach



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Early stage Assessment

- Invention Disclosure is the starting point
 - often focused problem solving has taken place and the invention is an outcome of that problem solving
- The inventor needs to recognize that the invention has value
- The inventor must be willing to share the invention to reinforce the value assessment and to decide the appropriate next steps
 - researcher’s trust is key
- The inventor’s effort must be recognized and supported
 - monetary incentives, peer recognition, career enhancement

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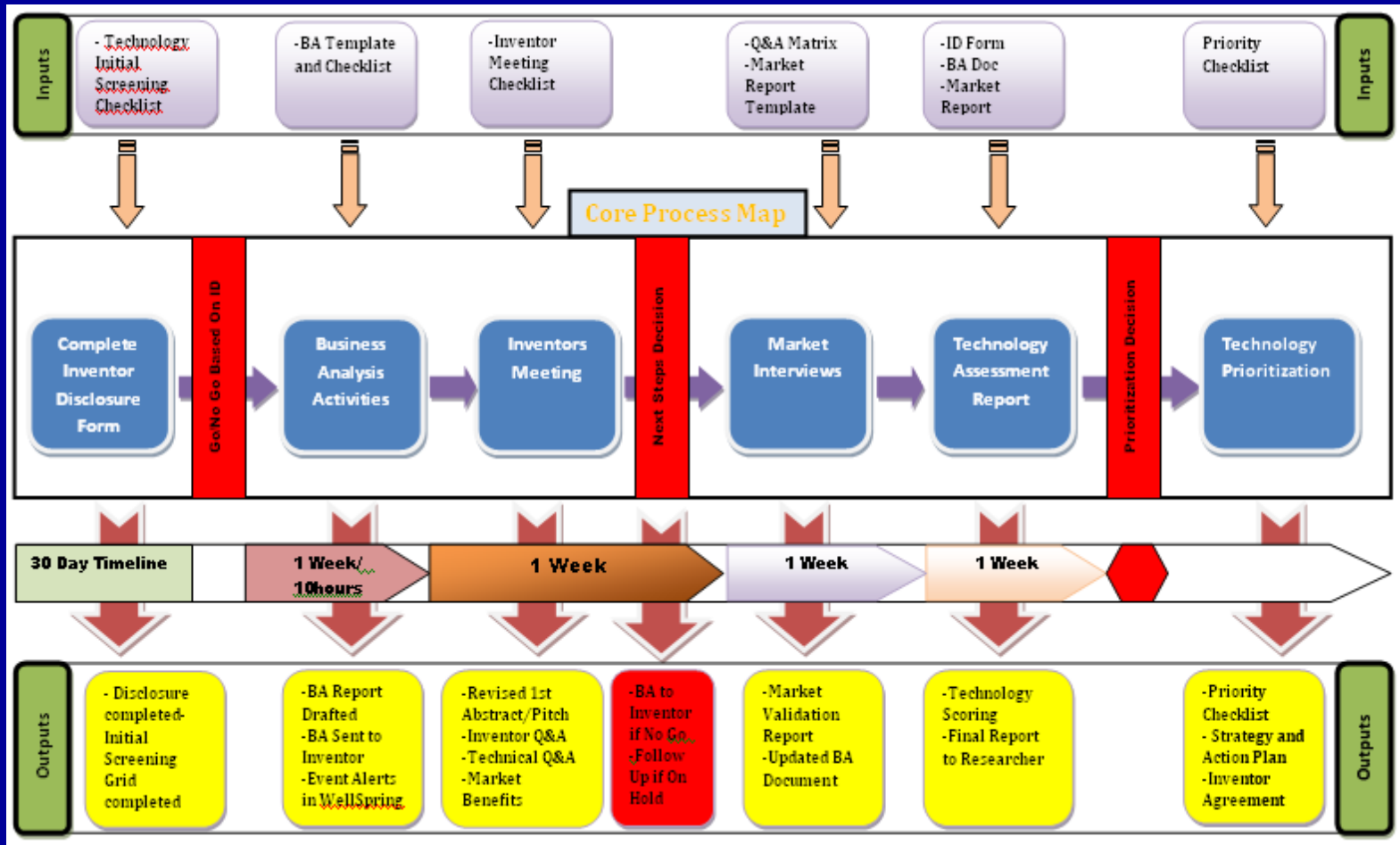
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Early stage Assessment

- 3 types of assessment:
 - Patentability
 - ownership, novelty, prior art, scope, “patent around”, enforceability, secret know-how, costs...
 - Technical feasibility
 - proof-of-concept, prototype, industry support, funding...
 - Commercial potential
 - value proposition, clients, market, suppliers, freedom-to-operate, competitors, funding...



Early stage assessment



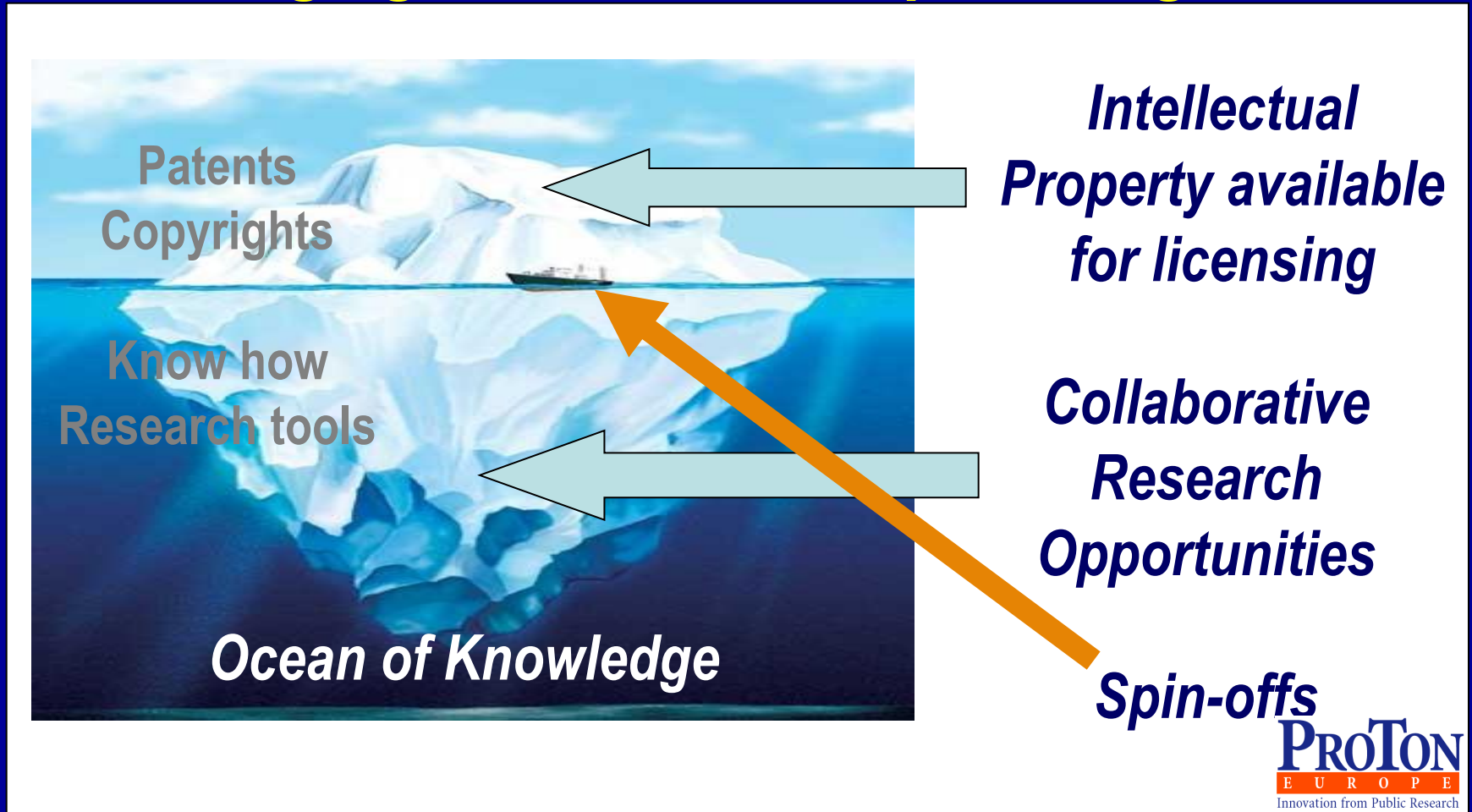
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Managing IP is more than patenting...



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University-Industry research projects

- Types of research funding
 - Open Research – wholly funded by public funds or grants. Results are generally published, publication can be delayed to allow patent filing.
 - Contract research – PRO is paid 100% of all costs (market rate + profits), acting as service provider. IP is fully owned by the contracting party.
 - Collaborative research - both parties provide resources for the project and both parties have an interest in its outcome. IP is agreed on a case by case basis.



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Collaborative research

- Ownership depends on many issues:
 - Who is paying the costs (research funding)?
 - Who proposed the project?
 - Who is designing/managing the project?
 - Is the project critical to the Industry partner?
 - On what Background IP or resources does the project rely?
 - Can the project be kept separate from other PRO researcher’s activities?
 - What is the effect on future research by PRO?



Code of Practice to manage Collaborative research

- Ownership of IP from Collaborative research:
 - Early and flexible agreement
 - Clear ownership of prior IP contributing to collaborative research
 - Should be decided on the basis of a combination of
 - The funding contribution by the parties
 - Intellectual contribution
 - Optimal exploitation (capacity to exploit)

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Code of Practice to manage Collaborative research

- Financial input
 - Relative contribution of the parties
 - Fair and reasonable incentivisation between all parties involved
 - Other input to the project (researchers, equipment, materials – in-kind contributions)
 - Impact on future research



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Code of Practice to manage Collaborative research

- Intellectual input
 - Nature and scope of the proposed collaboration
 - Level of intellectual input and effort from both sides
 - Relative ability of the partners to obtain, maintain and, where necessary, defend IP



Code of Practice to manage Collaborative research

- Capacity to exploit
 - Likely commercial applications of the IP, optimum exploitation route and partner(s) best positioned to execute it
 - Likely resources required to develop the results into commercial products or services
 - Stage of the research (closeness to market)
 - Scale and timeframe required for exploitation
 - Risk associated with taking a product to market

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Recommended opening positions

- 100% State Funded Research

IP arising from research fully funded by the State is owned by the PRO.



Recommended opening positions

- 100% Industry funded research

Industry...

- pays in full for the research
- participates in the project
- is the key exploitation partner



Industry owns
the IP

Industry...

- doesn't provide IP input
- doesn't lead the project



IP should be
negotiated
based on best
route and best
positioned partner
for exploitation



Recommended opening positions

- Collaborative research

Industry...

- provides significant part of the funding
- provides intellectual input
- best positioned to exploit IP



Industry owns the IP
Incentives to the
PRO

State is the primary financial contributor

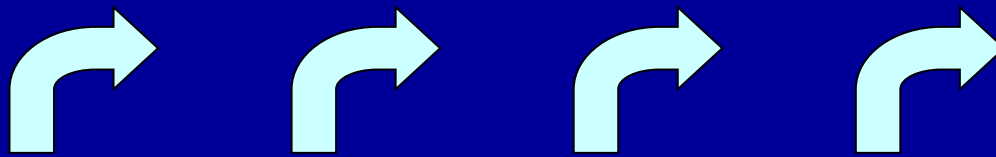


PRO owns the IP
Industrial partners
have right of access
PRO must maximise
exploitation of IP



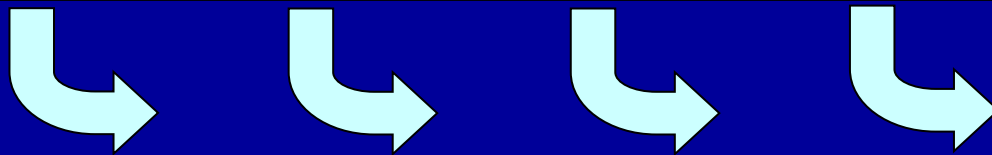
The dual approach

Focus on quality: mechanisms for identification of high potential ideas for customised support



IDEA

Focus on quantity: support all ideas



MARKET/COMPANY

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