

# Knowledge Transfer in the Biotechnology R&D Sector - *Best Practice*

Networks as Knowledge – Biotechnology Networks in the Atlantic Area  
Galway, 25<sup>th</sup> August 2011

Ruairi Friel, PhD MBA  
Commercialisation Executive  
Ignite TTO, NUI Galway

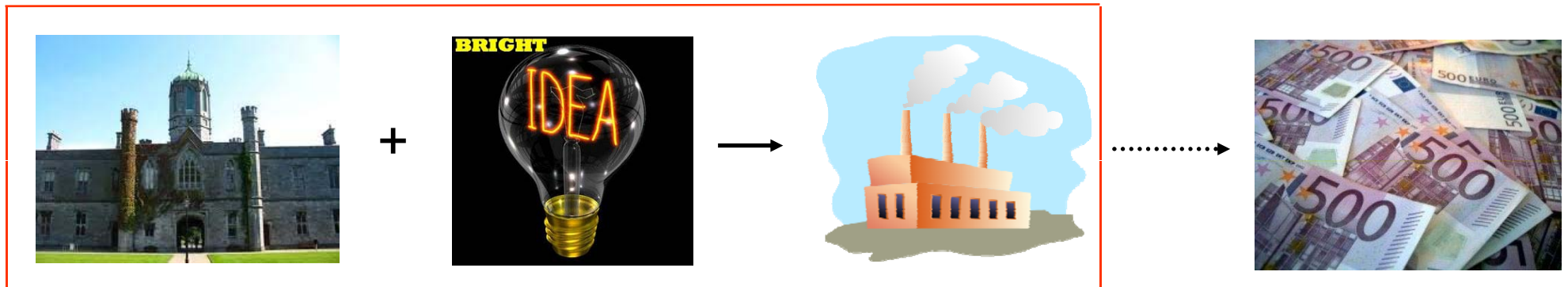


NUI Galway  
OÉ Gaillimh

Ignite Technology Transfer NUI Galway

# Agenda

- Overview of TTO NUI Galway
- Intellectual Property (IP) Fundamentals
- Consortium Case-Studies – *best practice*



# Why does NUI Galway manage IP?

- IP management is an essential part of effective knowledge transfer
  - Irish Council for Science, Technology and Innovation (ICSTI) has set out two National Codes of Practice on IP management
  - The seven Irish funding agencies (SFI, EI, Forfas, HEA, HRB, IRCSET and IDA) have set out Guidelines and Requirements for Managing Research Generated Intellectual Property
- Benefits:
  - Effective knowledge transfer
    - Transfer of knowledge for social, quality of life and wealth generation purposes
    - Using others IP – ensure we do not infringe other peoples IP
    - Income
    - Staff recruitment and retention – [www.nuigalway.ie/tto](http://www.nuigalway.ie/tto)



# TTO Strategy

## TTO Mission Statement

**"To be an International Leader in the Commercialisation of Research and other Knowledge-Intensive Activity for the benefit of NUI Galway, the Economy and Society"**

- Manage University IP – commercialisation and enterprise development
- Encourage the establishment of spin-out companies and support a Campus Company Programme
- Build on new business partnerships with investors, angels and management teams for NUIG
- Manage the Incubation and Bio-incubation Facilities
- Establish partnerships with industry
- Facilitate inter-institutional co-operation – research and technology development
- Deliver policy, processes, guidelines and skills development for researchers and stakeholders



# How does TTO NUIG manage IP?

## Research

## Technology Transfer



- Training IP basics/IP management
- Negotiating research agreements
- Material Transfer Agreements

- Identifying/evaluating new invention disclosures
- Initial patent applications and copyrights
- Managing confidentiality & non-disclosure agreements

- Option rights?
- Identifying licensees
- Negotiating license agreements

- Evaluating new company creation
- Managing new company creation
- Post-deal management



# What is Intellectual Property (IP)?

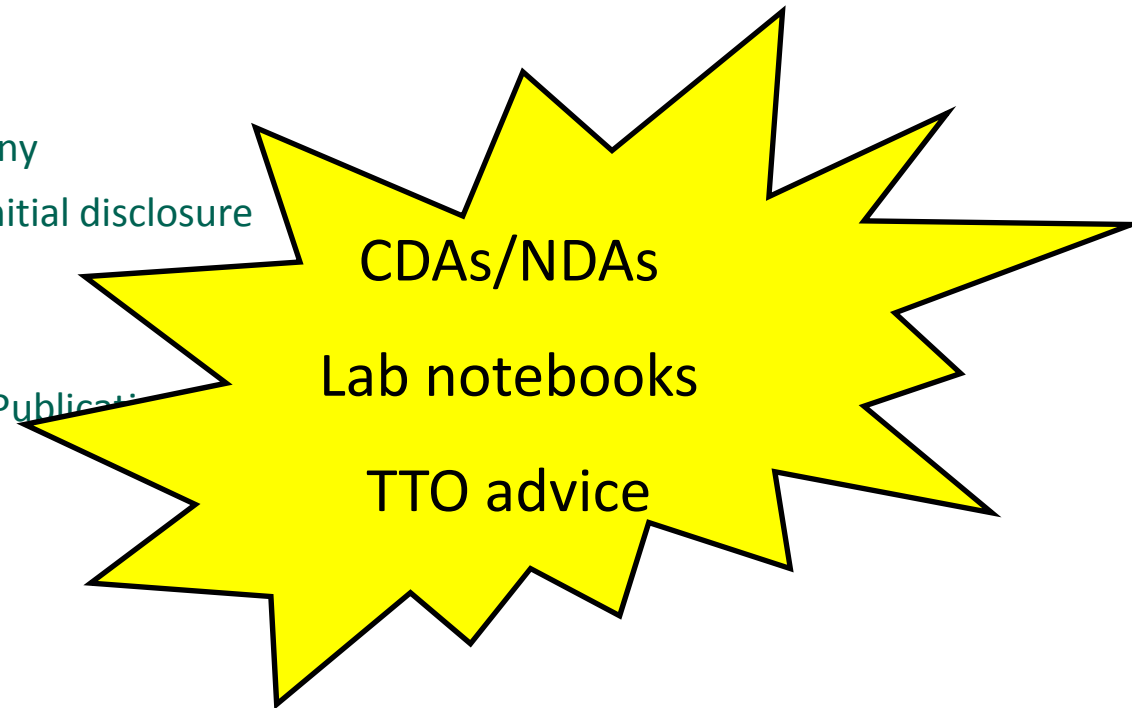
## Intellectual Property:

- is a legal entitlement in relation to a creation of the mind or other tangible/intangible matter
- used to describe protection around a product of the intellect that has some commercial value
- examples include:
  - Music, books, artwork
  - Product names, logos, slogans
  - Inventions that qualify for patent protection
  - Information that is kept secret and is not commonly known
- IP allows its holder to exert exclusive rights of use in relation to the specific subject matter
- Biotech: patents, know-how/trade secrets



# How to kill a patent/know-how before you start....

- Disclosure – inventions need to be novel!!
  - Publishing (article, abstract, web)
  - Presentation
  - Oral disclosure e.g. talking to a company
  - Unless in the US – 1 year grace from initial disclosure
- Patent/Publish timing
  - Commercial stage of development vs Publication
- Inadequate record keeping
  - US: *first to invent*
  - Rest of World: *first to file*



# Industry-Academia Consortium – *best practice*

1 industry SME – 1 academic partner



Multiple MNCs – Multiple SMEs – Multiple Academic Partners

- *No one size fits all*
  - General guidelines to promote success



## Industry-Academia Consortium – *best practice*

- Consortium agreement
  - Research agreement: *research to be done (workpackages etc.)*
  - IP agreement: *how to protect and commercialise outputs*
- Clear understanding of what outputs expected from industry and academia e.g. products, patents, papers, know-how



# IP agreement

- Register of background IP (introduced IP and restrictions around use)
- Scenario mapping
  - Patenting – process for IDFs; process for patent filing; single inventor? multiple inventors? academic inventors? Academic-industry inventors? Industry inventors? [JOMA]; Dropped patents?
  - Publishing – any leakage of IP? review by partners?
  - Commercialisation – Options to industry (triggering points?); field specific? Exclusive/non-exclusive? Workpackage specific? Lapsed options? Licensing principles agreed, not specific terms



# Questions?

[www.nuigalway.ie/tto](http://www.nuigalway.ie/tto)

[ruairi.friel@nuigalway.ie](mailto:ruairi.friel@nuigalway.ie)

+353 91 49 5826



NUI Galway  
OÉ Gaillimh

Ignite Technology Transfer NUI Galway