

# IP Management and Market Exploitation of Newly-developed Technologies *Dos and Don'ts*

TIPS Training Academy, Prague, 27.11.2013  
David Doerr

# During Preparation Phase (1)

## Do

### Formulate clear goals

*“...thus avoiding an all too common situation in Sino-foreign collaborations where the partners have wildly differing opinions on the nature as well as desired outcome of the collaborations, sometimes summarized by using the old Chinese saying ” (same bed, different dreams).”*

## Don't

### Repeat research

- Ensure avoidance of this by becoming familiar with state of the art in your field
- Patent search can help here

# During Preparation Phase (2)

## Do

### Choose your partner carefully

Define your criteria:

- Scientific excellence
- Communication skills
- Experience in international cooperation



## Don't

### Neglect partner selection process

- “Chance”, coincidence, or perceived country attractiveness should play no role in establishment of consortium/partnership
- Partnerships should be carefully planned and calculated

## During Preparation Phase (3)

### Do

#### Create a Background-Foreground map

- Visualisation helpful
  - Information, IP, know-how that each partner posses before cooperation (background)
  - Results to be generated in collaboration (foreground)
- Helps prevent conflicts related to IP issues, esp. ownership of results



### Don't

#### Leave the issue of access rights to projects results unclear

- Background
- Foreground

# During Negotiations Phase (1)

## Do

Detailed negotiation before signing agreement/contract

- Who's in charge?
- How much will the R&D cost? Who will pay for what?
- Who has right of use/application? Who has ownership?



## Don't

Sign agreements/contracts before all questions have been answered.

- All partners must understand implications of contract and agree to all terms
- All partners must accept ownership agreements and chosen path of commercialisation

## During Negotiations Phase (2)

### Do

Include substantive content in the confidentiality clause

- Commercialisation of results often depends strongly on the confidentiality of R&D process
- Vague formulations can lose their authority over time



### Don't

Rush into an agreement

- Instead: make sure all bases are covered with clear language understood by all parties (esp. regarding IP)
- Don't assume amendments to agreement can be easily added once collaboration has already begun.

# During Negotiations Phase (3)

## Do

Prepare a plan for protection of knowledge generated

- Who may obtain protection?
- Who will saddle the costs of protection?

## Don't

Take anything for granted

- It is important to understand everything in the agreement
- Don't risk leaving anything that could be important unconsidered
- If something is not clearly stated in black and white, it may be extremely difficult to prove your own interpretation later.

# During Execution Phase (1)

## Do

Coordinate the responsibility of each partner

When situations arise which are not covered in agreements/contracts, project leader needs to exercise strong coordination.

## Don't

Mix the processes of R&D and commercialisation

- Cooperation takes place at two levels and have two different characters. These should be viewed and treated independently in order to avoid unnecessary disputes/problems.



## During Execution Phase (2)

### Do

#### Build your relationships

- “tested” relationship can be a valuable asset in a collaborative project/venture
- Effort in encouraging personal relationships between all principles can prove to be time well invested when difficulties arise
- This facilitates good collaboration



### Don't

#### Be discouraged by poor communication

- Differences in corporate and national cultures (incl. languages) are bound to cause some communication issues/problems
- Accept the fact that there are differences and try to learn/understand them better – also in regard to IP
- Make sure you understand national rules for public records

# Moving Towards Commercialisation (1)

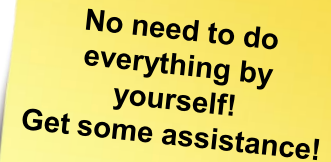
## Market Research – “Home Grown”

- quick environmental scan: What’s new, current and changed in the market since we commenced our project?
- Basic steps:
  - Look through patents for your technology area
  - Look at technologies being developed at the national labs and research universities.
  - Look at enterprises, large and small, in the appropriate industry. Look at current product lines, revenues and R&D
  - SWOT analysis on your technology

# Moving Towards Commercialisation (2)

## Plan to commercialise an innovative technology yourself?

- Lots of assistance for free or for a nominal charge
  - Research non-profits
  - Governmental agencies
  - EEN



No need to do  
everything by  
yourself!  
Get some assistance!

## Don't want to commercialise the technology yourself?

- Find a company/investor interested in doing so:
  - hone in the technology's capabilities as concisely as possible
  - Develop understanding of the relevant industrial sectors and markets (e.g. size, structure, players, level of competition, typical technologies and industry issues not yet solved)
  - Research current product line(s), product/market segmentation, revenues, R&D budgets, industry, level of innovation



***Vielen Dank für Ihre  
Aufmerksamkeit***