

IP – A foundation for technology transfer

By Alan MacDougall, Partner of Mathys & Squire LLP, a firm of Patent and Trademark Attorneys with Offices in Cambridge, London, Reading, York and Manchester.

Universities, Colleges and Research Organisations are responsible for producing most of the UK's scientific research and they rely more and more on the technology transfer process to develop practical applications to exploit the results of that research.

There are many ways in which the technology transfer process can result in the commercial exploitation of academic research, such as through licensing agreements, joint ventures and spin-outs for bringing the new technology to market.

Many Universities and research organisations now have a dedicated Technology Transfer Office to help with this difficult process. Not all, however, choose to use these Technology Transfer Offices instead seeking venture capital funding or collaboration directly with commercial partners.

Regardless of the route chosen, care has to be taken to ensure that a fair deal is achieved for all concerned. Sometimes the deal can fail in



the gulf between a general idea of technology transfer and the detail of the lawyer's contract.

However, building the deal around Intellectual Property (IP)

can provide a way to identify and safeguard the technical aspects provided by each party and the rules for its use and the use of any new technology resulting

from the venture.

Uniquely, IP bridges the technical, business and legal worlds and can provide a flexible and comprehensive struc-

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ture for both technology transfer and technology collaboration agreements.

For those seeking to exploit their research through a joint venture or collaboration with a commercial partner, care should also be taken with regard to the different market positions of those concerned.

For example, joint owners of a patent may each be able to manufacture and sell the patented product without regard to the other.

However, this right may be of limited value to the researcher or University that has no manufacturing capability. You might think that is okay – as they will be able to license their rights to someone else to have the patented product manufactured.

Not so in some countries, where joint owners are not allowed to license without the consent of the co-owner. The agreement therefore has to deal with how each party will commercially exploit the technology in a way that is not detrimental to the other.

Where research has multiple applications, it may be a commercial necessity to estab-

lish relationships with multiple parties if the full benefit of the research is to be realised. This will require a strategic approach to your IP filing and licensing and one that will allow you to retain ownership of the IP in order to control the exploitation of the research in the different commercial markets.

This can be achieved through the strategic filing of multiple patent applications or through the filing of a number of divisional applications to provide different patents that will protect the different commercial applications. Whilst more expensive, this approach will provide the flexibility later of being able to assign the technology in some commercial areas (if desired) whilst being able to retain ownership, and therefore control, in others.

A good technology transfer agreement will deal with these and other issues and will provide a secure foundation that deals with the different natures of the parties involved and that will provide an open and trusting environment in which innovation can flourish and new technologies can be brought to market.

MATHYS&SQUIRE LLP is not just a firm of patent & trademark attorneys, but a firm of intellectual property experts.

We work by understanding not only your technology, but also your commercial objectives.

We use our experience to develop an IP strategy tailored to your business, using patents and other tools, to:

- Protect profit margins
- Create valuable assets
- Support revenue streams
- Manage IP risks

Where IP agreements are required, we can advise you on structures and royalty schemes. We are skilled in the drafting of IP agreements and in the analysis of drafts prepared by others. We have the expertise and experience to negotiate on your behalf.

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