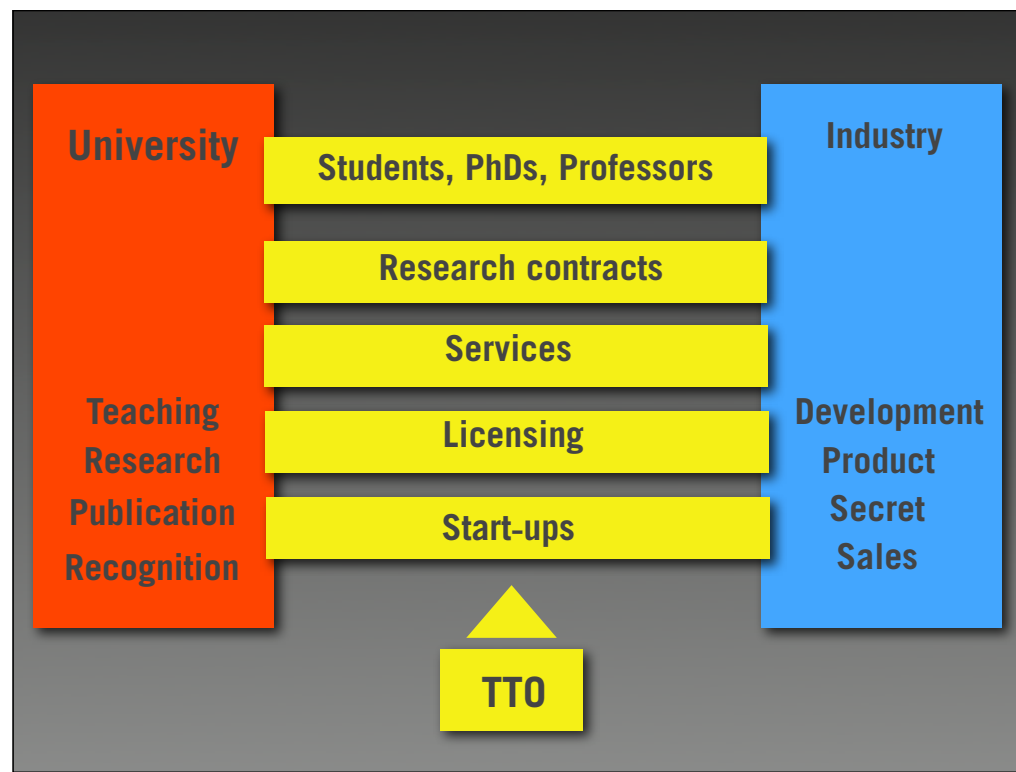


The Technology Transfer Office



Andrei Catana, EPFL-TTO, March 4th, 2014, Magurele



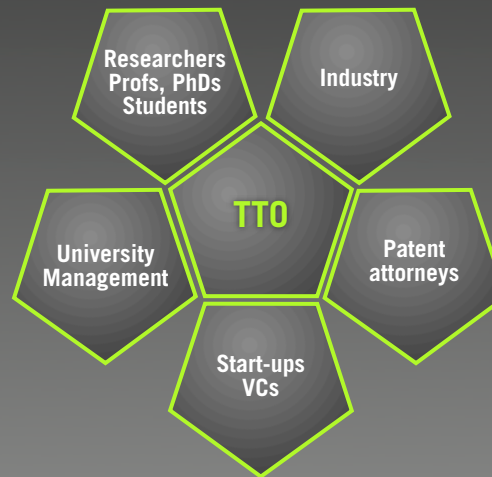
Continuous commitment and efforts

25 years !



- ♥ 2011 : proof-of-concept fund "Enable"
- ♥ 2010 : Innovation Square for R&D hubs of big companies
- ♥ 2008 : seed fund (Polytech Ventures)
- ♥ 2007 : revised research contracts policy & overhead policy
- ♥ 2005 : Innogrants
- ♥ 2004 : Vice-presidency for innovation and TT
- ♥ 2000 : first equity deals with start-ups
- ♥ 1999 : policy for remuneration of inventors and labs
- ♥ 1998 : creation of the TTO
- ♥ 1997 : coaching for start-ups
- ♥ 1995 : pre-seed funding for start-ups (FIT foundation)
- ♥ 1993 : creation of the Industrial Relation Office
- ♥ 1993 : legal personality, first IP strategy & licensing
- ♥ 1988 : policy for research contracts and partnerships
- ♥ 1986 : industrial liaison program (CAST)

TTO: the stakeholders



TTO staff : essential

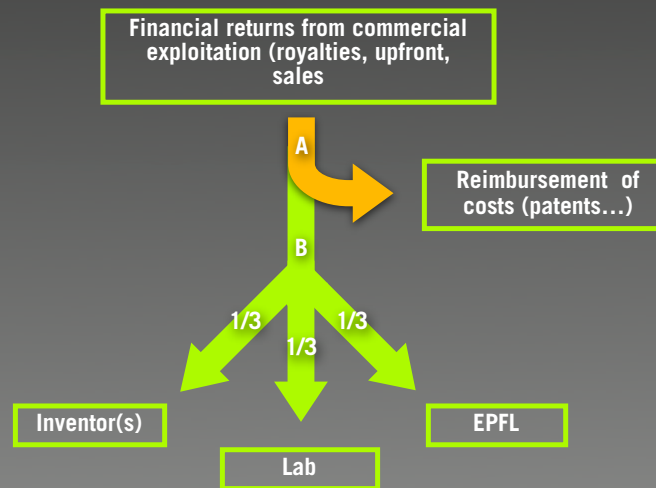


Stay close to the inventors !

Clear policies on ownership

- ♥ Institution owns IP generated by its employees
- ♥ Ownership policy for research contracts: inventions are transferred to ind. partner provided they are patented by ind. partner: a win-win solution

Motivation for inventors



TTO activities

- ♥ Contracts (research, service, etc)
- ♥ IP (evaluation, protection, management)
- ♥ Licensing and other TT agreements
- ♥ Distribution of revenues
- ♥ Interaction with start-ups
- ♥ TT accelerator: proof-of-concept, upgrading value
- ♥ TT policies (laws and regulations on TT)
- ♥ Teaching (raising awareness) <http://mintt.epfl.ch/>

Contracts

- ♥ Research contracts (collaboration)
- ♥ Service contracts (work for hire, use of equipment)
- ♥ Industrial grants (early stage evaluation)
- ♥ NDAs
- ♥ MTAs

Which types of contracts

Research contracts

- ♥ company has priority to protect interesting results
- ♥ IP ownership transferred to company if patent filed
- ♥ exclusivity for exploitation in a FOU
- ♥ backlicense to institution with sublicensing rights outside the FOU
- ♥ no secret results
- ♥ overhead 40%

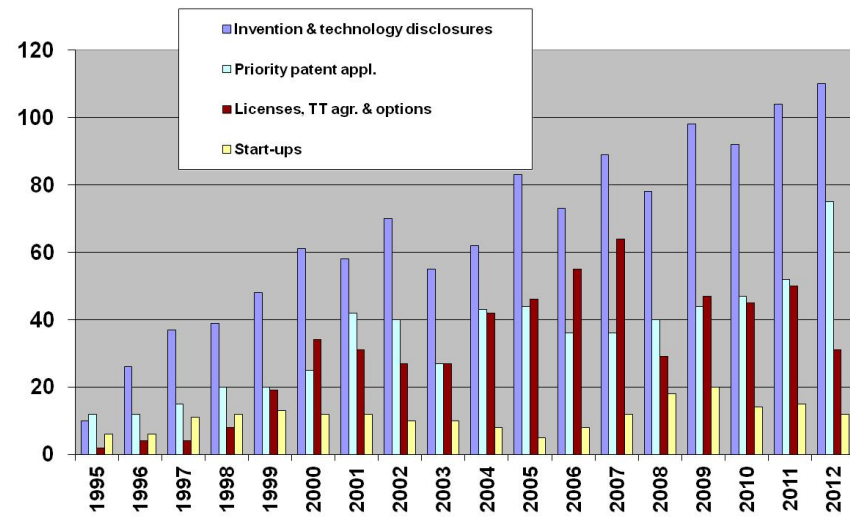
Tip: protect background IP before entering into collaboration

Service contracts

- ♥ all rights are transferred to company
- ♥ institution remains owner of methods and tools
- ♥ use and publications subject to prior approval
- ♥ high overhead (60%)

Technology Licensing @ EPFL

stats TTO-EPFL





Invention

Evaluation

Protection

Marketing

License

The invention disclosure

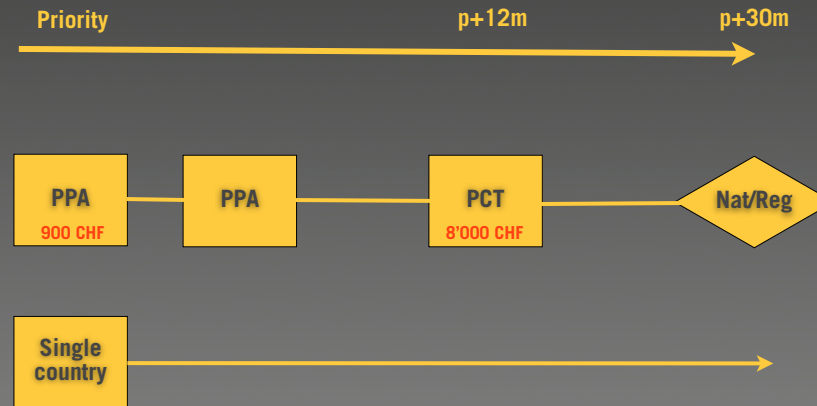
- ♥ Identifying the inventors & their inventive %
- ♥ Third party rights, contracts ?
- ♥ Principal dates
- ♥ Description of the invention
- ♥ Where lies the novelty ?
- ♥ Which applications ?
- ♥ Prior art (publications, patents)
- ♥ Potential partners, licensing opportunities
- ♥ http://tto.epfl.ch/invention_disclosure

Why patenting in university ?

- ♥ Attracting funding from industry (research contracts, licensing)
- ♥ Creating start-ups

**Leadership for patent filing and prosecution
should pass as soon as possible from
university to industry**

Patent filing strategies

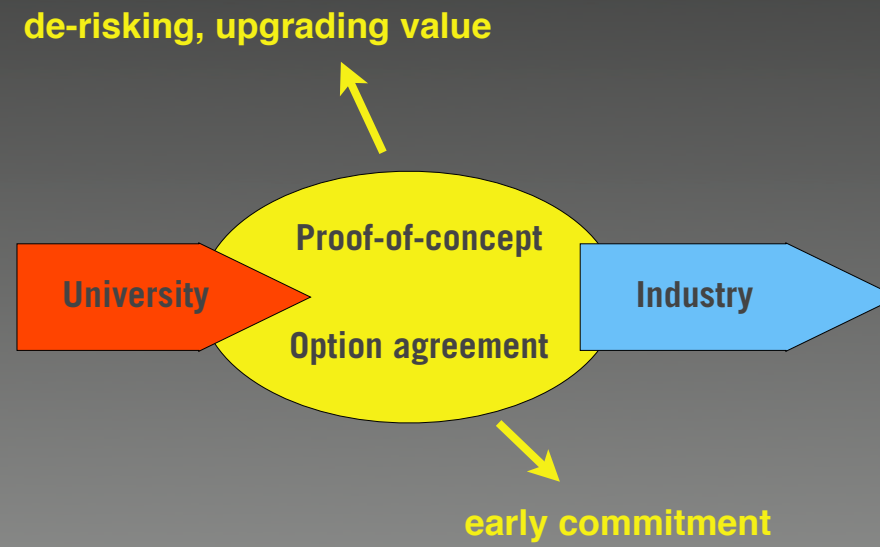


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Marketing : the tough part

- ♥ Start-up opportunity ?
- ♥ Invention description and IP status on web
 - ♥ EPFL, SWITT, Entreprise Europe Network
- ♥ Professors' network
- ♥ TTO network, consultants
- ♥ Patent databases
- ♥ Presentations at dedicated events (i.e. TechConnect)

ENABLE : an early stage accelerator



License

**Scope
Price**

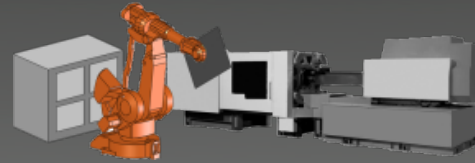


License: the scope

- ♥ Exclusive / non-exclusive / semi-exclusive
- ♥ By Field-of-Use
- ♥ Time-limited exclusivity
- ♥ Territory

Scope

♥ market sectors



License: the price

- ♥ reimbursement of patent costs
- ♥ up-front payment
- ♥ milestone payments
- ♥ royalties (on net sales)
- ♥ minimum annual royalty
- ♥ shares (start-up) - instead of up-front



Royalties

The 25% rule : « rule of thumb »

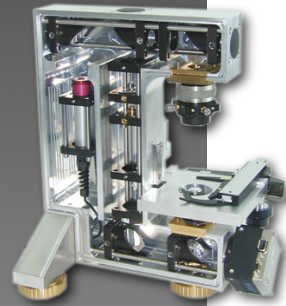
1. calculate profit
2. royalty = 25% of profit



Benchmarks (LES Nouvelles, AUTM surveys, etc.)

Royalties – benchmarks ?

Subsystem, improvement: $< 2 \%$



Living neuronal cells



Copyright 2003, TP-INTf, RPPI-TOA, Tynode Tec SA, Infos pierre.marquet@physiol.unil.ch

All you need is ...

- ♥ clear policies (ownership, remuneration, ...)
- ♥ credibility & trust
- ♥ stay close to the researchers
- ♥ IP expertise
- ♥ negotiation skills
- ♥ legal support
- ♥ passion !

The TTO should have answers to :

- ♥ is my idea/invention worth patenting ? software ?
- ♥ what do I need to prepare a patent application ?
- ♥ which patent strategy ?
- ♥ how can I establish a collaboration with a company (which contract, FOU, budget, legals, etc.) ?
- ♥ how can I enter into a license agreement ?
- ♥ how can I market my invention ?
- ♥ which are the next steps for my start-up project ?

To take home :

- ♥ Protect your inventions by filing patent applications
- ♥ Use the provisional EP or PCT filings in parallel with the romanian filings: this will enhance interest at a very modest cost increase
- ♥ Disclose and market (publications, website, etc.) your invention promptly after filing
- ♥ Do not prosecute your patent application beyond 30 months from the priority filing without commitment from an industrial partner
- ♥ Avoid filing patent applications in joint ownership

Many thanks for your attention !

