OPTEON

Philip Mendes

Workshop	# The Basics for IP Professionals
	For Tech Transfer Offices For Research Offices
Level	**Basic**
Duration	**half day, or one day, or two consecutive half days, or 2 days**
Program	A detailed description of the workshop program is below.
How this workshop helps IP professionals	This intense and comprehensive skills development workshop has been designed for those that are new (or near-new) to the operations of a research office or tech transfer office and need to accelerate their learning of the basic skills and agreements used in those offices. It is also a useful refresher for more experienced IP professionals. Importantly, the unique needs and perspective of universities and research institutes are kept in focus. Common points of tension in university / research institute / industry partner relationships are covered, as well as ways to overcome these points of tension, while still meeting the needs of each.
Customisation	The content of this workshop can be changed and customised to enable specific learning objectives to be achieved.
Presenter	Philip Mendes
Delivery style	Interactive workshop style. Emphasis on discussion, participants asking questions, contributing their comments, and sharing their experiences. We find that this interactive workshop style keeps participants alert and achieves a more effective learning and skills building outcome.
Materials	Each participant receives a set of bound workshop materials which will be an ongoing reference resource.
Certificate of Completion	A Certificate of Completion is provided to each participant.

BASICS FOR IP PROFESSIONALS - *Skills, Tools, and Know How*

This workshop is always customised so that the ultimate program that is presented meets the specific learning objectives of the organisation that engages us.

The intended audience is new or "newish" staff of Research Offices and Tech Transfer Offices.

Below is a description of each module which can be included in a customised program.

Some modules have a short version or a slightly longer version, as indicated.

Please select the modules that you would like included in the program that you want delivered. The duration of the workshop can be a half day, one day, two consecutive half days, or two days.

If you like, we can have a discussion with you about your intended audience and the learning objectives that you seek to achieve, and we can then prepare a customised program for you.

We can also send you examples of customised programs we have presented to other organisations.

Duration			
Short	**Long**	**Intellectual Property**	
30		**Why do we protect and commercialise intellectual property**	Why commercialise? The motivation for entrepreneurship in research. The benefits of commercialisation to the community. Economic benefits to the nation, to the institution, and to the researcher.
30	60	**What is Intellectual Property?**	An overview of the different types of intellectual property, and what they protect, including: patents, copyright (including software), designs, trademarks, plant breeders' rights, eligible layout rights, and confidential information. Who is an inventor. Who is a contributor.
30		**The Patent Process**	Patent processes: priority date, provisional applications, PCT applications, national phase, pitfalls of patenting too early, the timing of patent applications. Choices to be made in the patent application process and the factors that influence them.
30		**Choosing whether to protect IP by patenting, or by trade secret**	IP Protection strategies. Pros and cons of patenting. When patenting should be considered. When protection strategies other than patenting should be considered. Factors influencing the choice.
30		**Achieving both the academic publication objective as well as the IP protection and commercialisation objective**	The importance of achieving the academic publication objective, and why it must be achieved. The importance of achieving the IP protection objective, and the commercialisation objective, and why it must be achieved. Strategies to ensure that each objective can be achieved without sacrificing the achievement of the other.
		Evaluating Technology	

30	45	**Evaluating Technology for Commercialisation**	Criteria for assessing a technology candidate, and whether it warrants commercialisation effort, including patentability, novelty, etc, the state of the research, IP ownership, assessment of the market including market need, market size, etc
	45	**Practical exercise: Assessing the commercialisation prospects of a hypothetical parcel of IP**	Presentation of an Invention Assessment Tool for a hypothetical parcel of IP. Allocation of participants to small groups. The factors influencing commercialisation identified. Each group assesses the commercialisation prospects of the hypothetical project, and reaches a consensus on whether the project is a candidate for commercialisation effort and resources, and why.
	20	**Practical Exercise Report Back and analysis**	Report back on practical exercise, and discussion of the factors influencing the selection of commercialisation projects.
		IP Ownership	
30	60	**Traps for the unwary: the implications of joint ownership**	Joint ownership of IP suggests that the joint owners have equal and mutual rights over the jointly owned IP. But that is not the case. A joint owner that lacks the capacity to manufacture and sell (like a university, research institute, or start-up) will be disadvantaged compared to the joint owner that has that capacity. Why you must know the joint ownership laws that operate in those countries (not just your own country) where you have patents, and the impact of unharmonised joint ownership laws.
30	45	**Traps for the unwary: rights of first refusal**	Rights of first refusal, options to license and options to negotiate. Are they legally valid? Laws in your country and US considered. Potential liabilities to be aware of. Bargaining implications to be mindful of.
30	45	**IP ownership defects and fixing them**	Common due diligence IP ownership and rights defects. Recognising them, and how to solve them. Collaborators, contractors, students, visiting scientists and other joint owners. Anticipating due diligence defects and fixing them. Implications and impact of due diligence defects not fixed.
		Agreements	
20		**How far can you go in making disclosures without a Confidentiality Agreement?**	A potential licensee or investor will not sign a Confidentiality Agreement at the outset. They need to know about the innovation before they make the decision to submit to obligations of confidentiality. To what extent can you make disclosures without a confidentiality agreement to get them interested enough to sign to one?
30		**What you must know about Confidentiality Agreements**	Keeping Confidentiality Agreements uncontentious. The essential terms of a Confidentiality Agreement that must be understood. Common terms. Common traps and pitfalls.
30		**What you must know about Material Transfer Agreements**	The essential terms of a Material Transfer Agreement. Common terms. Common traps and pitfalls. Strategies and approaches to dealing with Material Transfer Agreements. The controversial issues in MTA's, including the ownership of New IP arising under the MTA, and how to deal with them.
30	60	**What you must know about Research Agreements**	The essential terms of a Research Agreement. Common terms. Common traps and pitfalls. Strategies and approach to dealing with Research Agreements. Models for the ownership of IP. Issues that are recurrent problems and how to solve them. Management of technical risk.
30		**What you must know about Research Agreement Schedules**	Preparing Schedule 1: Research Program; Schedule 2: Research Funds; Schedule 3, Milestones. The legal principle of Certainty that Schedules must meet. How to ensure certainty so that Research Agreement will not be avoid.

		Commercialisation	
30		**The Commercialisation Window**	The window of opportunity to commercialise IP. When it opens. When it shuts. The criteria for each. Maximising the commercialisation window opportunity.
30		**Strategies to find commercial partners and licensees**	Strategies to identify potential commercial partners including potential licensees. Where "deal opportunities" come from. How researchers find potential commercial partners.
	60	**Commercialisation Pathways: Assignment v Licensing v Start Up companies**	Description of the four principal commercialisation pathways and pros and cons of particular pathways: Assignment of IP, licensing IP, Start Up companies formed as venture capital investment vehicles, and start up companies formed by entrepreneurs. Factors influencing the selection of one pathway versus another.
60	90	**What you must know about licensing IP**	The essential terms of a license Agreement. Parties. Field. Territory. Grant of Rights. Access to Improvements. Sublicensing. Reserving research rights. Applying for and Managing Patents. Prosecution of Infringers. Confidentiality. Publications. Financial Terms. Up front payments. Milestone payments. Different types of royalty structures. Royalties where product infringes a patent. Know how royalties. Royalties of sales, on sub-license income. Etc. Risk Provisions. Indemnities. Warranties. Diligence Obligations. Termination. Assignment. Dispute Resolution. Governing Law (which should not be controversial).
60	90	**What you must know about Start-Up companies**	The essentials of start-up companies. How investors structure their investment for shares. Milestones. Tranches. Investors' preferential share rights and how they work. Investors' anti-dilution rights and how they work. Governance of a start-up company. Veto matters. Investor exits, trade sale and IPO. Share and Option schemes.