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Property Office



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WORLD
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ORGANIZATION

IP Marketing

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Diagnostic Phase

Prior to any step



Diagnostic phase : Assessing transferability readiness

- Original,
- Differentiated
- Supported by solid evidence
- Targeting an unmet market or an active market.
- Patented with freedom to operate
 - At least a patent demand (still able to be extended) explicitly covering the invention in the domain
 - A granted patent covering the main markets still alive for 5 years (or more depending on the field)
- Marketed by a team able to identify potential « buyers » and to negotiate a relevant agreement

IP Due Diligence


- Inventory
 - List of patents
 - Ownership / Employment agreements / inventors list
 - Discovery files (Labs book)
- Worldwide Patent status by territory
 - Pending / Issued
 - Live / abandoned
 - Maintenance fees
 - Pending IP disputes

Must be reasonable and in line with the aim of the licensing project and market potential

- Patentability
 - Innovative aspects (Bibliography /A&X)
 - Scope and Strength coverage of IP Portfolio
MUST COVER THE INVENTION !
 - Whether IP covers any of your competitors products
- Freedom to operate
 - Carefully checking prior art for product(s) of interest (Not in IT/electronics)

Best patent for monetisation

- Breakthrough innovation according to scientists
- New application targeting a mature known market
- Critical patent(s) with respect to Freedom to operate
- Invention highly cited by third parties (Generality)
- Invention citing various fields as prior art (Originality)
- Invention inducing process/manufacturing cost reduction
- Complementary patent (thicket)
- Mines field is better than a single family.



Predictive indicators

Preparation of the licensing files : check list

- Field (s)
- Possible application (s)
- Differentiation
 - Existing products
 - Under development
- IP
 - Scope and Strength
 - Worldwide status
 - Freedom to operate
- Development stage
- Efficacy / Safety
- What is lacking ?
- Steps to be achieved prior to launch (means and budget)
- Type of collaboration (licensing, sale, partnership)
- Exclusivity
- Restriction (geographical / application)
- Financial aspects
- How much it is worth ?
- Contact

Marketing of the invention (I)

Non confidential teaser

- Widely released
- English
- 2 pages (5 minutes)
- Basic language, understandable by any « naïve » party
- No oversale / No price
- Reassure the future partner by showing your professionalism
- No confidential information
- One for each application

Marketing of the invention (II)

Confidential dossier

- Demonstrating the interest of your invention by providing proof of evidence reports
 - Solid data, no cheat.
 - Must confirm the claims listed in the non confidential teaser
- Content :
 - More detailed
 - No « holes »
 - Demonstrative data
 - Anticipating the questions
 - No know how

Marketing of the invention (III)

- Spreading the information (teaser):
 - Worldwide
 - Velocity is critical (pending patents)
 - Internet (quick, easy, low cost)
- Updating your information about the market and about the most relevant targets

The entire world must **RAPIDLY** be aware of the availability of your invention for Licensing

Evaluation of the Teaser by potential licensee

- Playing at MonteCarlo
- Overloaded by proposals
- Not enough time to seriously evaluate them
- Difficult when early stage (no POC)
- NIH vs Proudly Found Elsewhere
- Careful reading of their letter

Tech Transfer Management Key factors of success

Tech transfer General recommendations

- Do not initiate any Tech Transfer without the support of a licensing professional

Chess games vs Tech transfer

- Success means PREPARATION (90% home work) and TEAM work
- Main pitfalls can be properly managed by a well prepared team, organization and supportive decision maker

Preparing yourself and your organisation

- Build a team
 - Coordinator : trained project manager
 - Licensing manager : negotiation
 - Advisers/team members
(Technical, Legal, IP, Finance, Tax, local adviser)

Minimum

Decision maker

- Well defined mandate
 - Not participating to the negotiation
 - Positive and constructive
- Budget (experts, IP costs, trips, consultants)
 - Be aware about the process duration (6 to 12 months)

Selecting the project leader

- Inventor (pros & cons)
- Professional skills
 - Understand science, IP, Business & Legal aspects
 - Has an extensive internal network
 - Cross cultural awareness
 - Talent when dealing with people
- Partnership spirit
 - Capture the underlying motivation of the 2 parties
 - Treat partners as equals.
 - Great ability to benchmark

Selecting the project leader

- Open to other person's point of view(s)
- Flexible, creative, able to anticipate
- pragmatic
- Repair the relationship when needed
- Possible « Funeral Director »
- Will manage a task force to prepare and implement the partnership
- **Must be trained**
- **Must closely work with Licensing manager**

Main pitfalls and tricks to speed-up the tech transfer process

- ❖ Preparation is Key.
- ❖ Well defined expectations
 - ❖ Type of partner, of deal,
 - ❖ Cash, royalties,
 -
- ❖ Any shortcut or unprepared options usually leads to failure

Identification of potential buyers/licensees

Identification of potential buyers/Licensees

- Anticipate the potential applications
- Taking into account patent coverage and other restrictive issues
- Solid files... not dream or weak files to support the invention
- Broad vs narrow targetting ?
- A valuable invention is new AND « positively » differentiated
- Two methods to be combined :
 - Traditional one
 - Patent analysis by new tools

Classical identification of potential buyers

- 1. Publicly available information of publicly-traded companies.
- 2. Online and subscription database services for the relevant market or products.
- 3. Trade publications.
- 4. Trade and technology exhibitions, fairs and shows.
- 5. Technology licensing offices of research-based universities and publicly-funded research and development institutions.
- 6. Relevant government ministries, departments and agencies.
- 7. Professional and business magazines, journals and publications concerning the relevant products and markets.
- 8. Professional and business associations.(Licensing Executive Society, AUTM...)
- 9. Technology exchanges.
- 10. Innovation centers.
- 11. Patent information services.
- 13. Brokers

Potential buyer identification by patent mapping

- New powerful approach
- Principle :
 - taking advantage of the patent databases to position your invention among all the existing ones (topographical map)
 - Identification of all players developing similar concepts
 - Interesting identification of potential partners not operating in the field of the invention
- Requirements :
 - Specific software (Thomson reuters or Questel)
 - Trained users
 - Specifications of the invention must be carefully defined (key descriptors)



Innovation space navigation tool

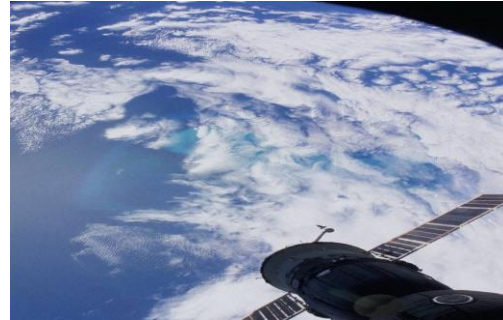
SECTOR

FIELD

COMPANY

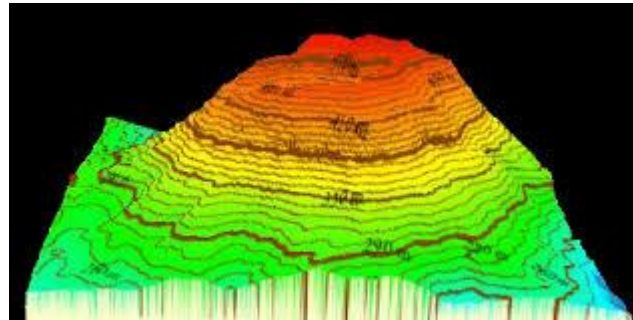
DEPARTMENT

RESEARCHER



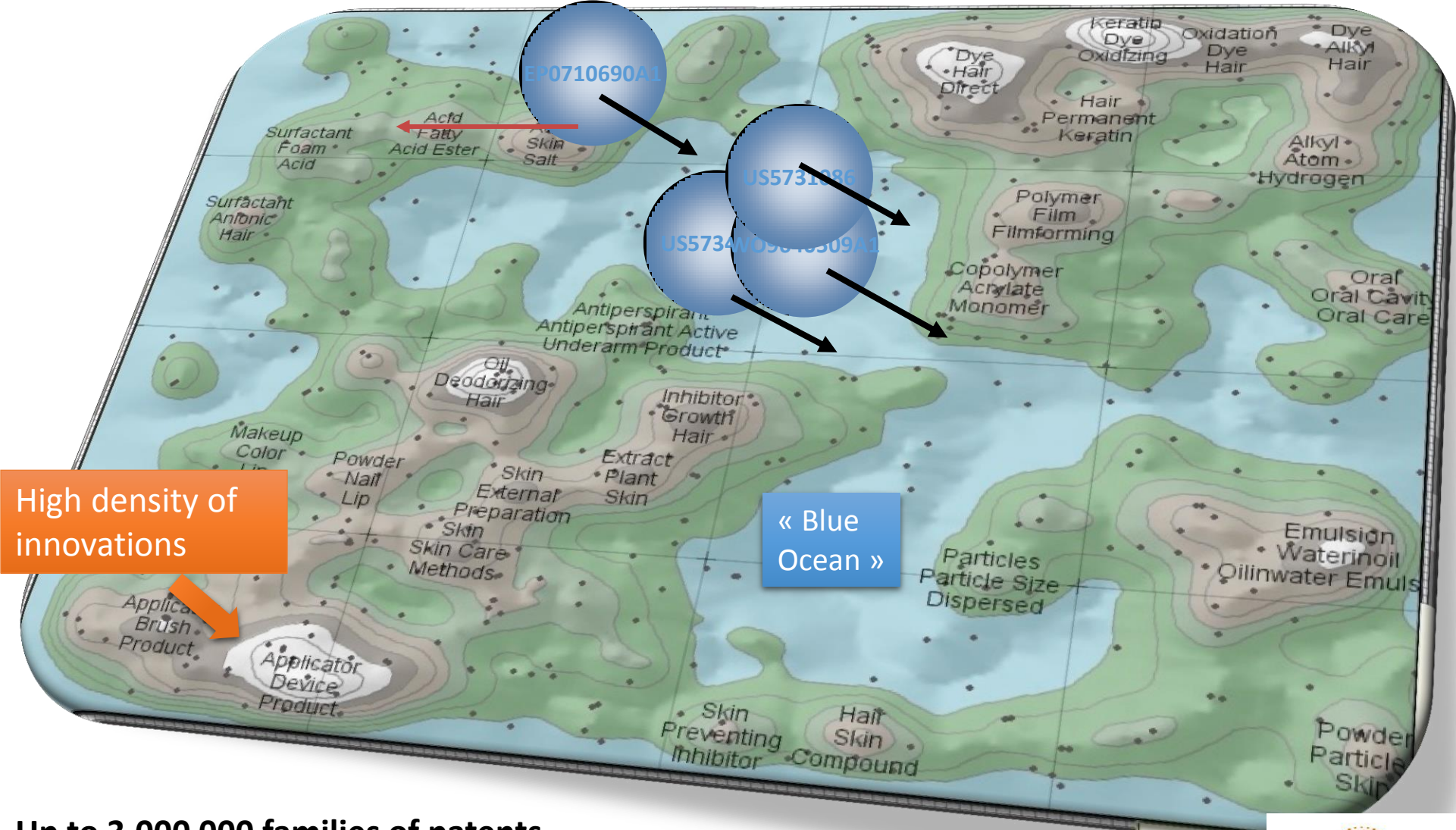
- **Google Earth**
65 M patents

Zoom



Looking for the haystack
not for the needle !

Thomson Innovation IP landscape



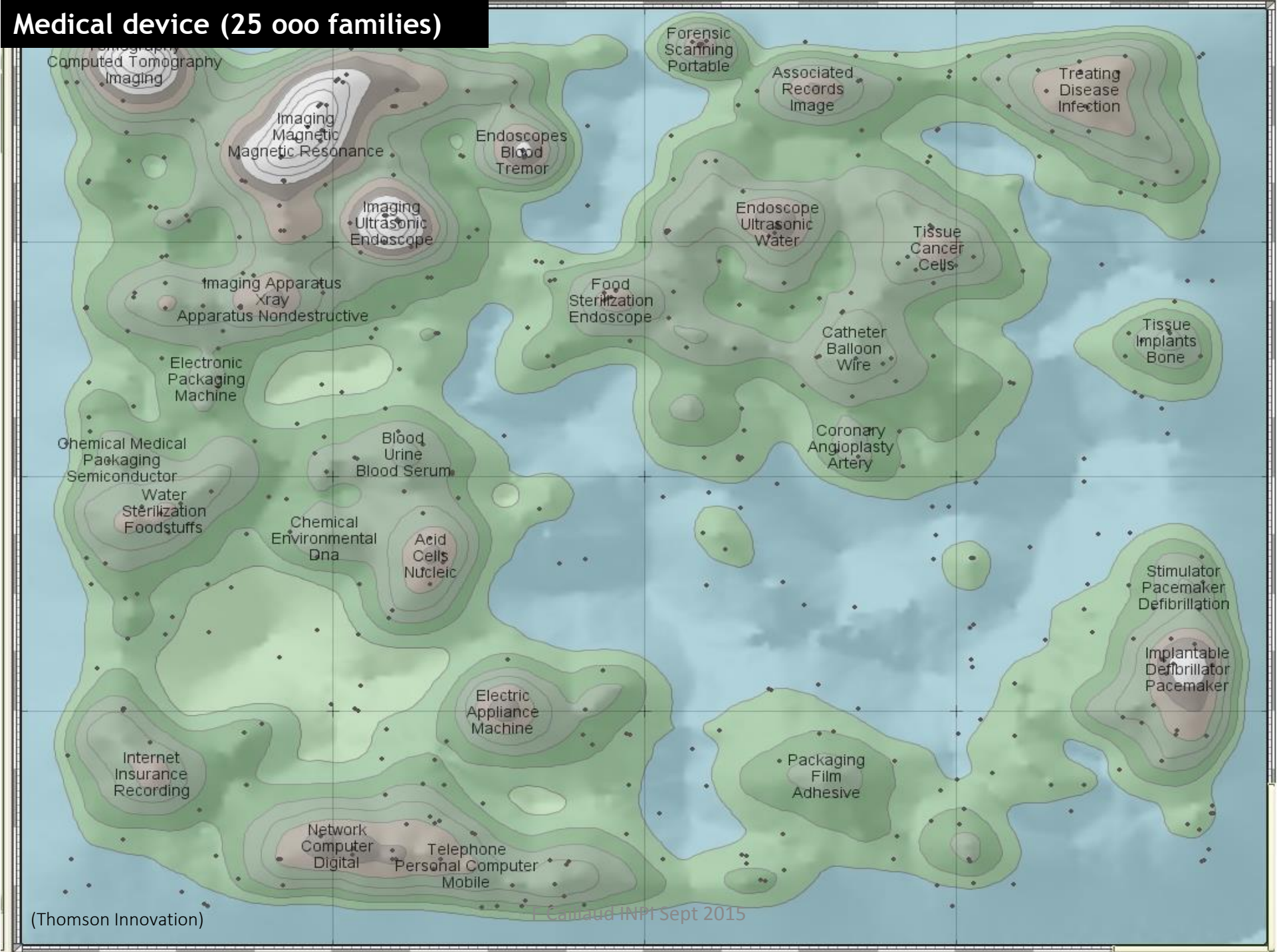
High density of innovations

« Blue Ocean »

Up to 3.000 000 families of patents

F Caillaud INPI Sept 2015

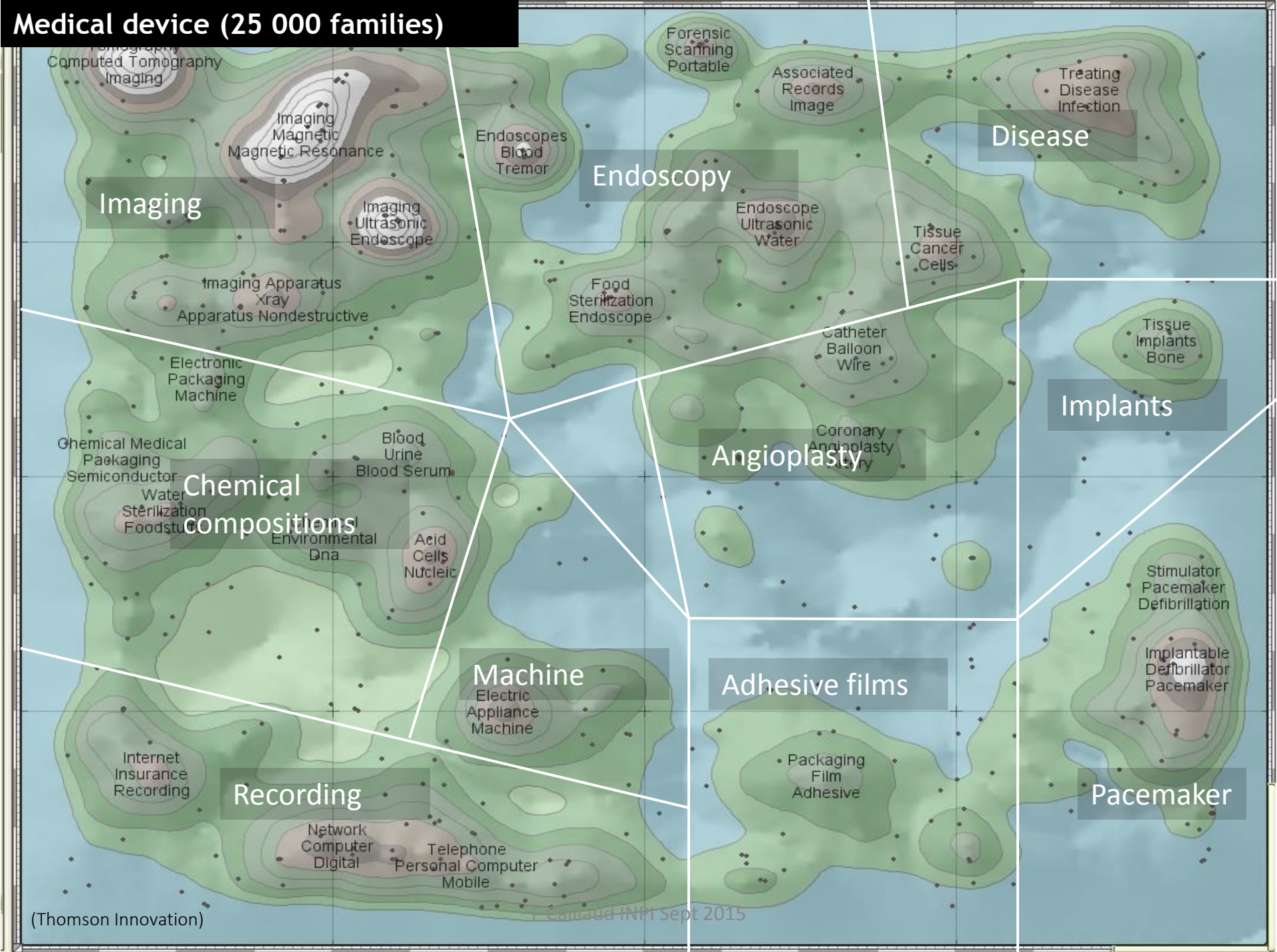
Medical device (25 000 families)



(Thomson Innovation)

Canada INPI Sept 2015

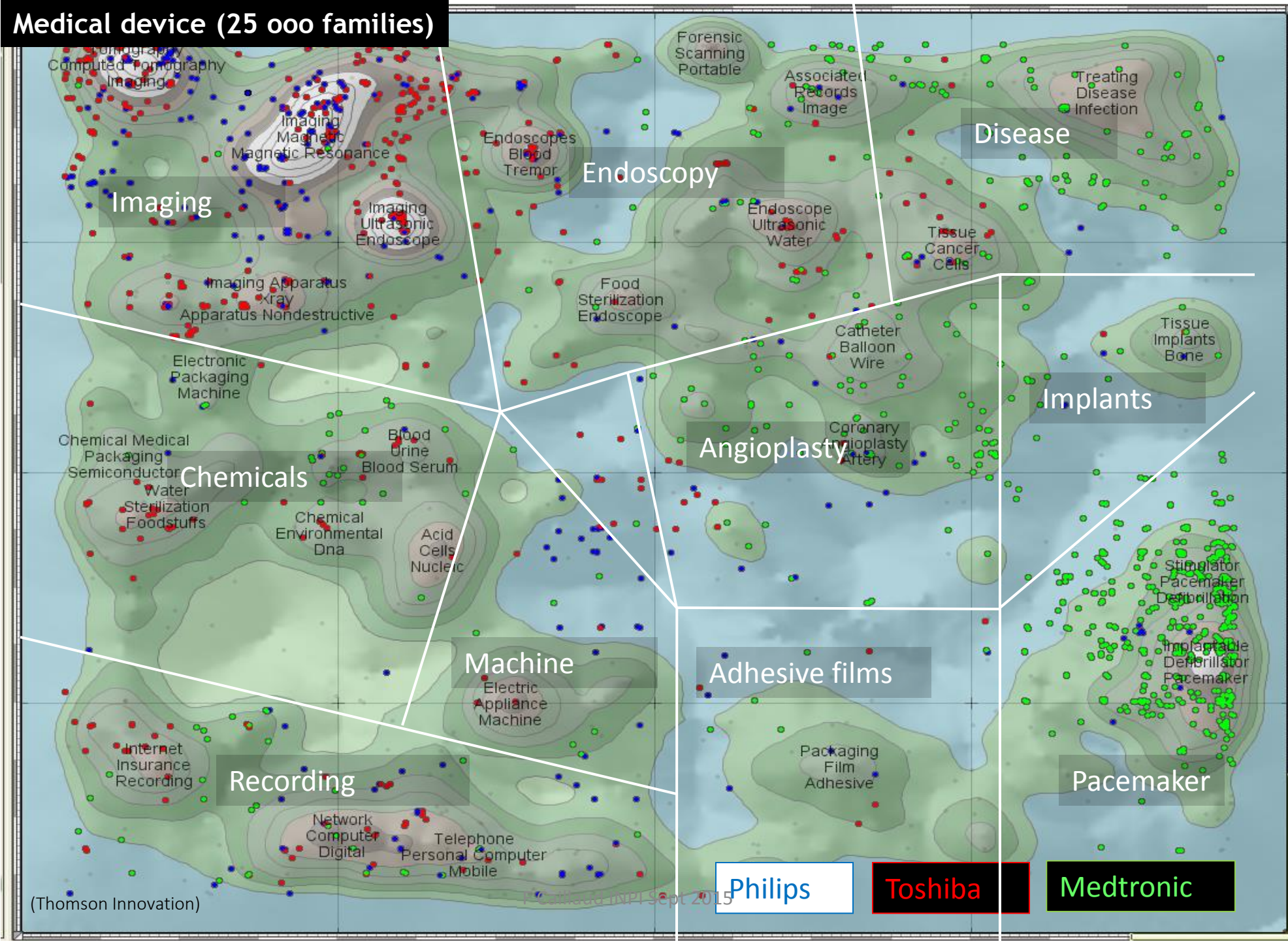
Medical device (25 000 families)



(Thomson Innovation)

Canada INPI Sept 2015

Medical device (25 000 families)



(Thomson Innovation)

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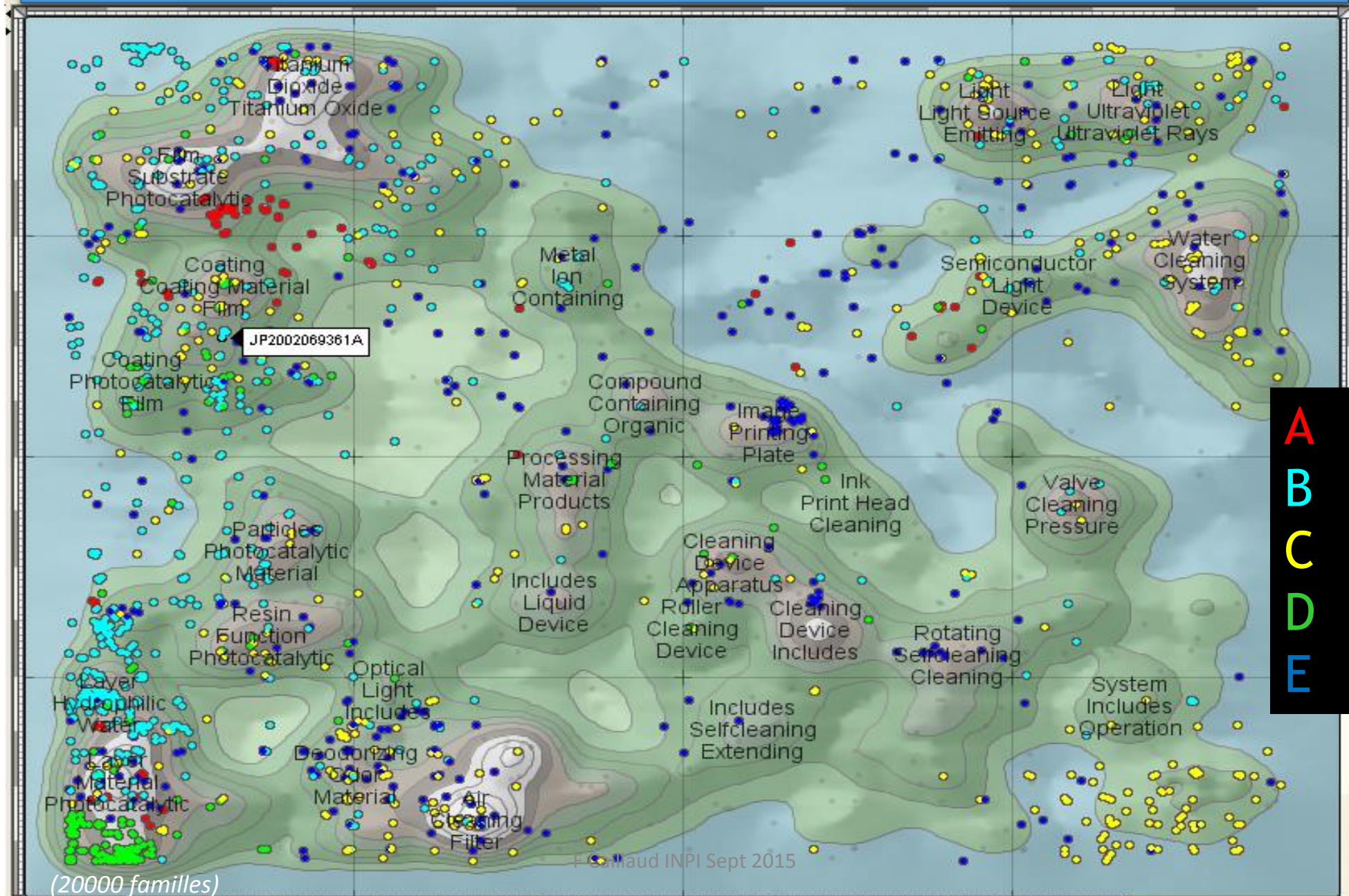
Philips

Toshiba

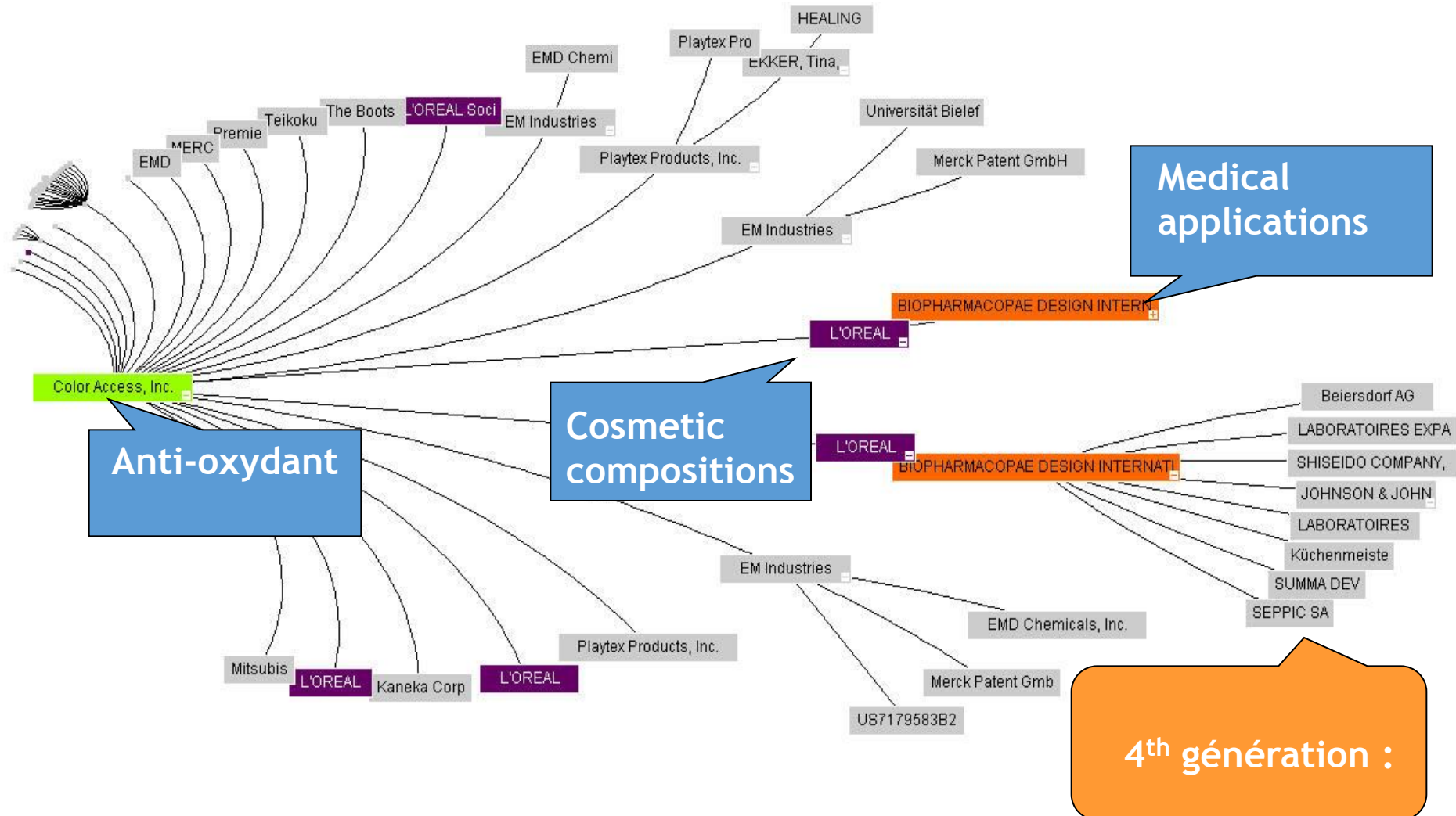
Medtronic

CARTE D'ETAT-MAJOR

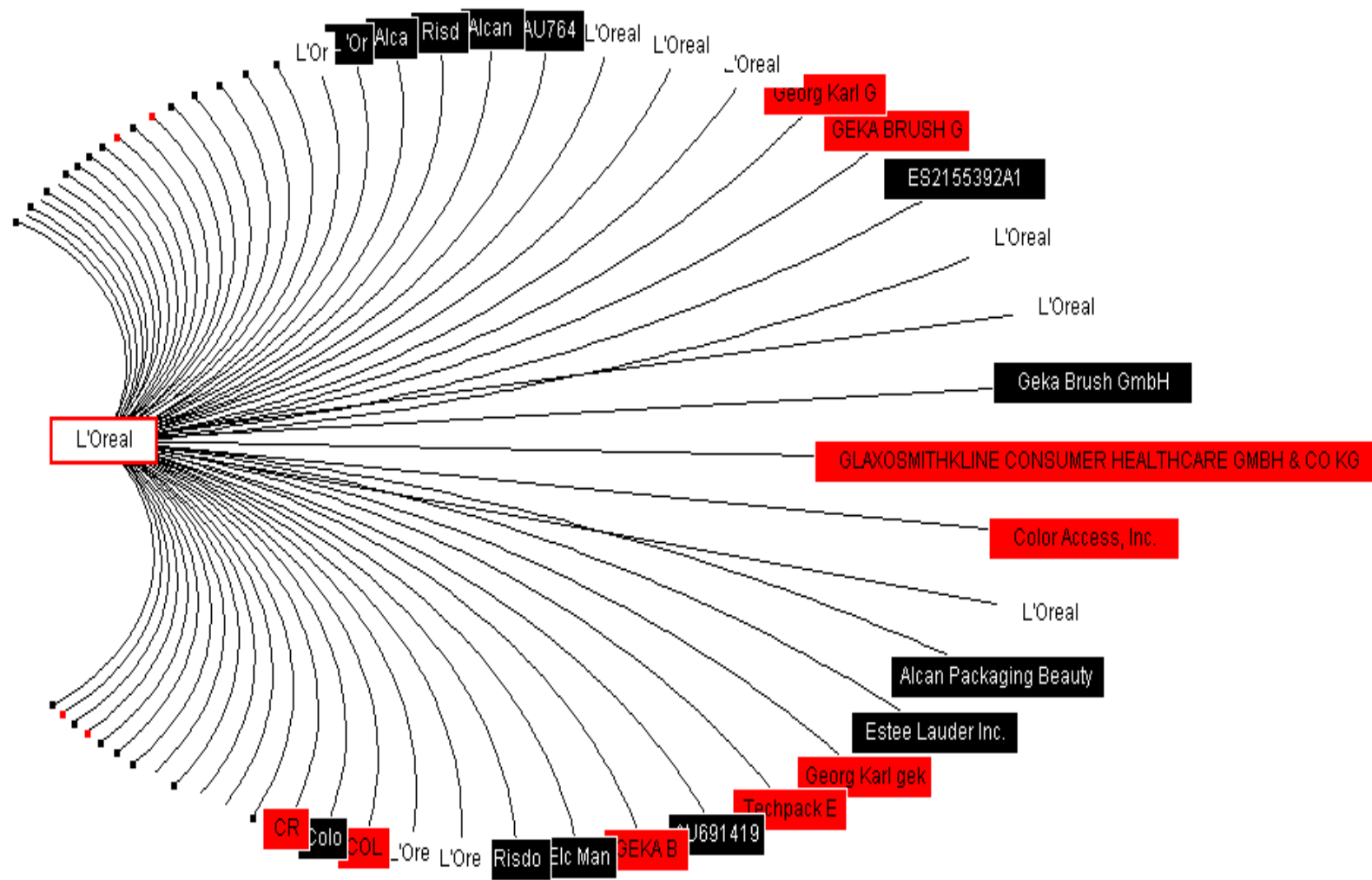
ORDNANCE MAP



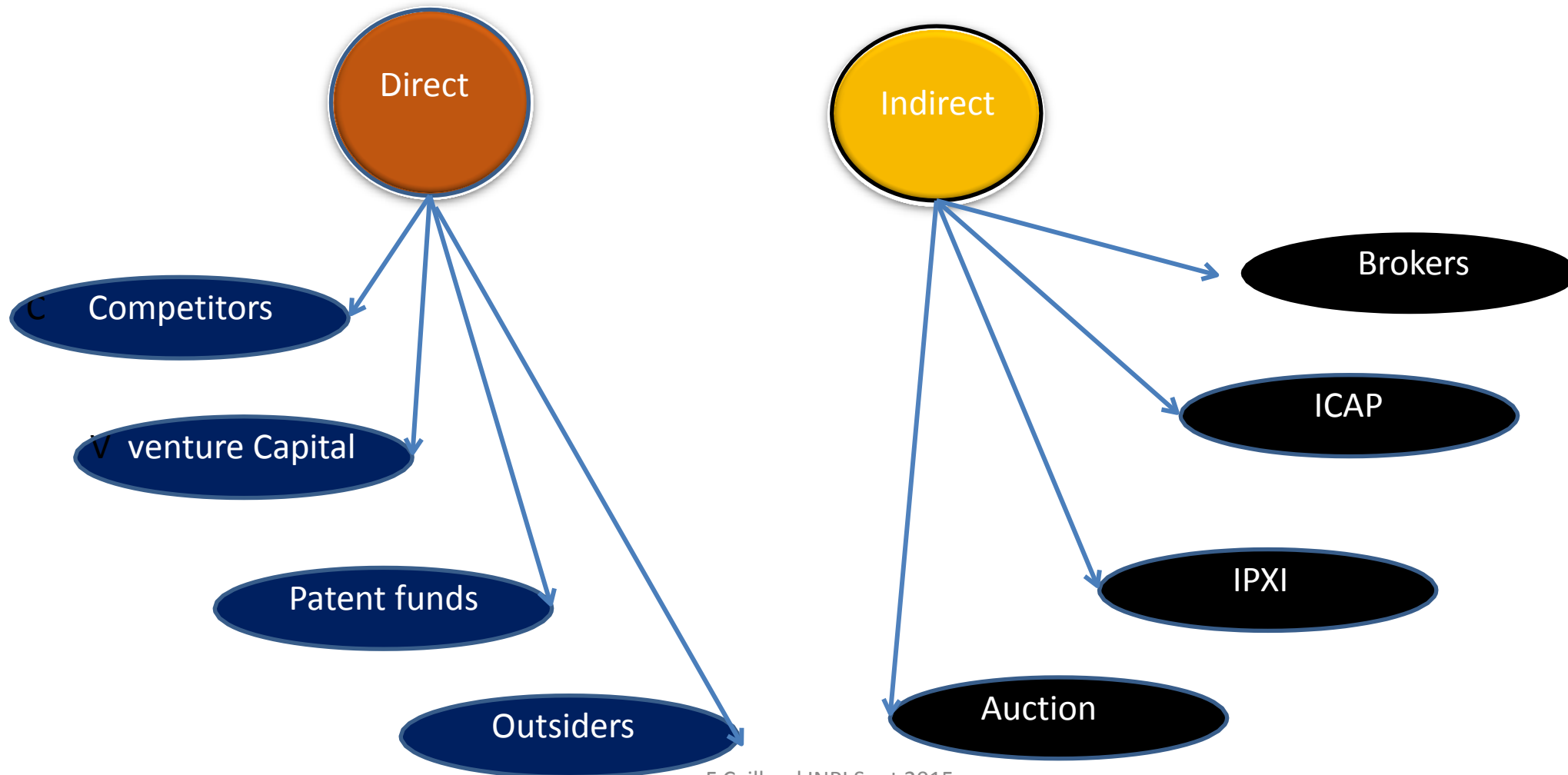
Citation tree



X or Y citation in EP search report

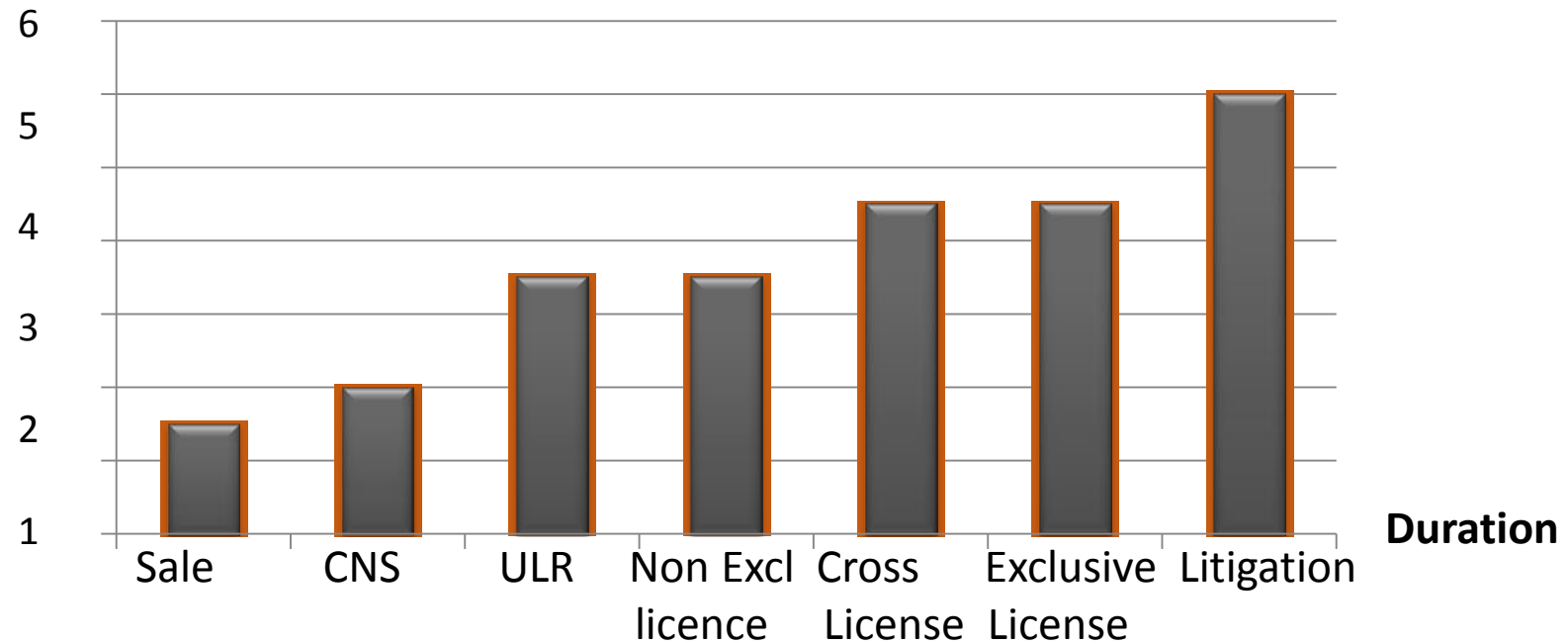


Commercialization Channels



Selecting the most adequate type of deal : Options

Level of support



CNS : Covenant Not to Sue
ULR : Unit License Right

Gap analysis

- Set-up a list of potential licensees
- Contact them and manage their feed-back in parallel (not step by step)
- Collect additional data (business, people, expertise, reputation...) to set up a profile of each candidate
- Describe how each candidate meets (or not) critical success factors
- Risk identification (marketing strength, level of internal commitment of top and operational management, conflict of interest, relative importance of the licence, cultural gap, partner profile, quality of management and relationship)
- Discuss each candidate with project team
- Get an independent view
- Rank them

Selection of the best potential partner

- Highly motivated
- Cultural fit
 - Quality of the plan of action
 - Duration, means
 - Financial and non financial offered compensation
 - Market Strength
 - Improvements
 - No similar internal product or R&D program
 - Quality of the first contact
 - CDA « fight »
 - Reputation and profile of the partner

Selection process Summary

- Partner must bring :
 - value,
 - strength,
 - Suitable motivated resources
 - cultural compatibility
- Trust and information flow are of paramount importance

Managing a successful relationship with potential buyer/ licensee

Preparing the negotiation with potential partner

- Home work must be achieved
 - Anticipate their questions.
 - Define your expectations for each topic. Always prepare an alternative option.
 - List of « arguments » to better enforce your proposal
 - Definition and ranking of your needs and alternative options
 - Deal breakers
 - Get the mandate from your top management
 - A fair value of the technology must be defined but only disclosed when you have a reasonable understanding of the market potential .
 - Be sure that they come with the right to negotiate.
 - Define the role of each member or your team
 - Send them an agenda and ask for the list of attendees (incl. Titles)

Having dinner the day before

- To make contact
- To lower pressure on your shoulders
- To have « private » conversations
- Carefully monitor your scientists
- Reassure the other party

Negotiation tricks

- Only one leader during the negotiation process.
Team ready to support
- « Message » to reassure the other party about your intentions.
- Start by discussing technical issues (always easier)
- Anticipate conflict by providing your solutions
- Take the initiative to send the first draft of contract
- Reciprocal respect always comes from a challenging but constructive confrontation
- Do not leave with unanswered questions

Negotiation tricks

- Play with the win / win motto (smile / cool)
- Define the room to negotiate that you have asap
- Regularly repeat your understanding of the discussions and conclusions
- Only feasible compromise(s)
- Written summary (paper board)

Take home summary

- Professionalism is critical (chess game)
- Preparation (home team work) is Key (90%)
- IP strength is always a must
- Partner must be in line with your expectations
- Reciprocal respect
- Do not leave any unanswered question
- Improvements
- Licensees must be regularly checked.