

# **Patent Protection and Transfer of Technology in Biotech**

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# Disconnect between research and industry

## Common Environment of Generation of Biotech Inventions: (Spanish Case)



Research carried out in governmental / public centers



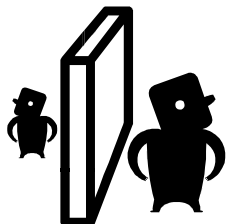
Fundings strongly dependent on number of publications



Researchers lacking knowledge and interest in IP matters



■ Offices of Technology Transfer under-dimensioned and needed of support (knowledge, resources...)



■ Researchers ignoring Offices of Technology Transfer or commercial interests and turning their backs on them

# Disconnect between research and industry



# Disconnect between research and industry: Solutions

## ALTERNATIVE VIEW

Select and organize at least some research lines directing them to Transfer of Technology



# Transfer of Technology. Basis and Advantages

- Facilitates that inventions turn into commercial products, that can be of use for the individuals they are designed for
- Helps to generate revenues that can be used for new research lines
- Enables to bear the costs of patents and clinical trials
- Often linked to a right of exclusivity in commercialization or manufacturing:
  - Trade secret on know-how
  - Patents



# Transfer of Technology: Keys for success



- Supply the Offices of Technology Transfer with enough knowledge and means for carrying out their work
- Assure a climate of confidence and co-working between the Office of Technology Transfer and the researchers
- Be sure that researchers know the basic requirements of patentability and trade secrets

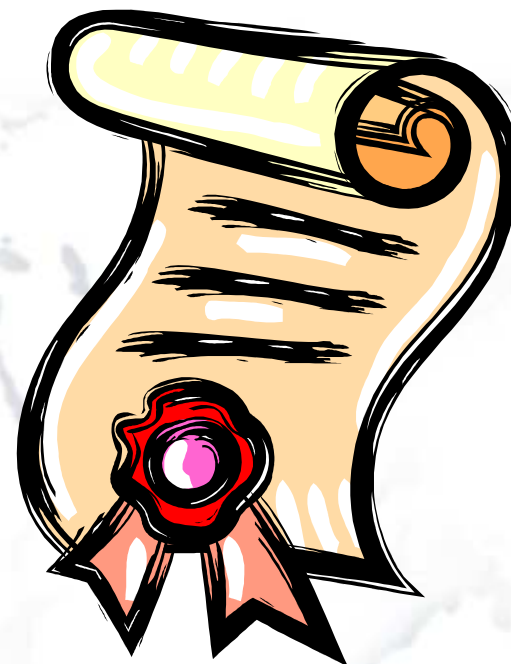
# Means of getting profit from a finding or development

- Improvement of cooperation Industry (Big Pharma) – Academia
- Transfer of know-how
- Patent Transferring or Licensing
- Spin – off companies
- Creation of departments for providing specific external services in the research center





- Having an invention
- Novelty
- Inventive Step
- Industrial applicability
- Clarity
- Sufficiency of disclosure



## Requirements for patenting. Novelty

- The invention must be different from anything else previously known, published or used. Thus:
  - Avoid publishing a scientific article before filing a patent application
  - Be careful with presentations in congresses and scientific meetings
  - Limit the information about the research projects published in the web sites of the research center

## Requirements for patenting. Inventive step

■ A patentable invention must not be obvious (not even obvious to try) for one skilled in the art. Thus:

■ Avoid publishing intermediate results that make obvious what the research group is trying to demonstrate before filing a patent application

■ Be careful with the information provided in abstracts for congresses and scientific meetings -> they might make obvious the applicability of the findings

■ Limit the information about the research projects published in the web sites of the research center

## Requirements for patenting. Application / Sufficient disclosure

- A patent application must have industrial applicability and enough information for the invention to be carried by one skilled in the art without undue burden. Thus :
  - Avoid trying to protect discoveries without giving them a practical application
  - Provide assays showing that the application works as claimed

## Requirements for patenting: Advice

**Don't be the worst enemy of your own invention!**



Source: <http://www.epo.org/learning-events/materials/inventors-handbook/sins.html>

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## *Thank you for your attention!*

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