

Intellectual Property Management and Licensing - Policy Perspectives from Thailand

By

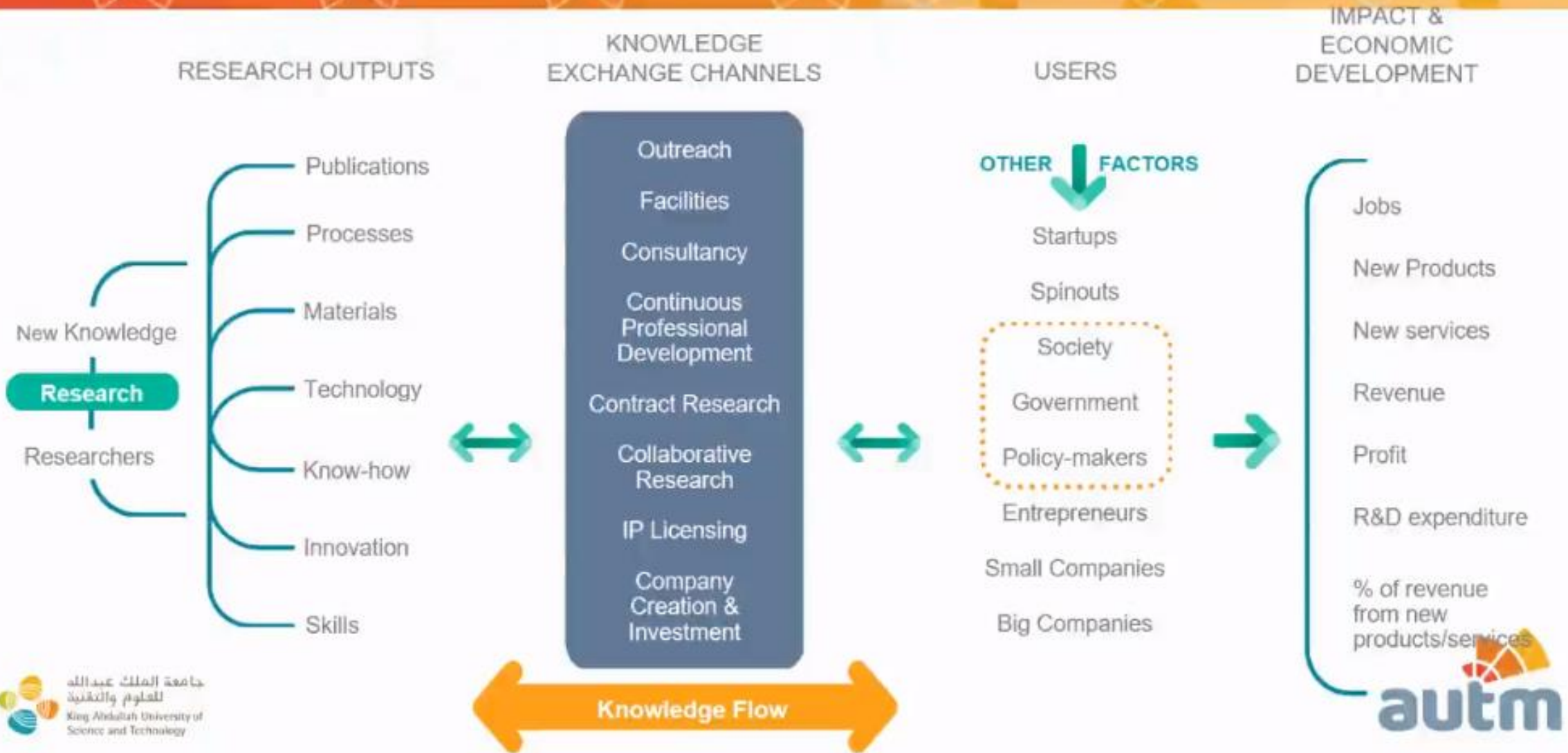
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Knowledge Exchange Model



Some Points to Note

- We are all part of the complex system
- Impact is actually a team effort
- We NEED external partner to make it happen
- Universities can help by optimizing the channels
- What are the ways to get the knowledge put to use?

Thailand R&D Spending (2017)

- Total R&D investment =155,143 million THB (\$ 4,848 Million)
- 1% of GDP.
- 20% from the government (30,000 million THB) and 80% from the private sectors.
 - 70 % goes to universities
 - 20% goes to government research institutes
 - 6% goes to state enterprises
 - 4% goes to Non-profit organizations

What are the ways to get the knowledge put to use?

- Currently, research money flows to universities, but intellectual properties were owned by the national funding agencies or jointly owned by the funding agencies and the universities.
- Universities can have the right to manage the IP, but they need to get a permission from the funding agencies on a case-by-case basis.
- Would the U.S. Bayh-Dole Type law help?

What is Bayh-Dole Act?

- The Bayh-Dole Act predominantly deals with ownership of inventions made with Federal funding.
- Providing **clarity of intellectual property ownership**, and **incentivizing the commercial development of intellectual property** for economic impact.
 - Specifically, **it allows companies, nonprofits, and universities to retain title to federally funded R&D inventions** to facilitate their further development.
 - It gave professors and lab teams **an enormous incentive to put to commercial use plans and ideas for inventions** that they had long ago shelved in their minds and offices.

Key Provisions of the U.S. Bayh-Dole Act

- **Ownership:**

- The **University is entitled to retain ownership of any inventions created as a result of federal funding**, unless the funding agency informs the University up front that the agency will retain title to inventions derived from the funded projects because of specifically identified “exceptional circumstances” (usually military).

- **Obligations of Ownership:**

- When a University innovator discloses the creation of an invention derived from federally funded research, the **University has two months from that date to disclose that information to the appropriate federal agency**. The University also must patent all inventions it elects to own and commercialize.

Key Provisions of the Bayh-Dole Act

- **March-In Rights**

- The **University must attempt to develop and commercialize the invention. If an attempt is not made**, the federal government retains the right to take control of the invention.
- The government also may take control of the invention for other reasons, such as a need to alleviate health (**catastrophic epidemic**) or safety concerns (**war**), if the EXCLUSIVE Licensee cannot significantly help the government cope with the catastrophic epidemic or war. This provision is referred to in the law as the government's "march-in" rights.

Key Provisions of the Bayh-Dole Act

- Guidance and Permission of Exclusivity:
 - When granting an exclusive license, the University must ensure that the invention will be “**manufactured substantially**” in the United States.
- Guidance:
 - The University must share a portion of the **royalties with the inventor(s)**.
 - Excess royalty revenue (after Inventor Distribution and out of pocket expense recovery) must **support research and education** on campus.

Thailand's initiatives to emulate the U.S. Bayh-dole Act

- The Cabinet acknowledged and approved the concept of the law in September 2018.
- The drafted law is now being reviewed the Council of the State of Thailand. The process has been continued for six months now. And there is a long way to go.

The key questions before the Committee at the Council of the State:

- Many funding agencies are very capable of managing IP, why should we want to shift this duty to the universities?
- Who are the eligible funding recipients?
 - Why should we give government research funding to the private sector?
- Coverage of the law:
 - patentable inventions vs. all kind of intellectual property
 - Invention disclosure vs. innovation intake form
 - Only scientscientific research or including social science

How can Universities help Optimizing the Knowledge Transfer?

- Universities TTOs often have limitations in terms of budgets and staffs (number of staffs and their capabilities)
- Determining which forms of intellectual property apply and how to secure legal protection for them can be complex.
 - Most institution have a patent-centric IP policy give emphasis on patent and copyright protection.
 - But Innovation is wider in scope than inventions. Most commonly created IP on campus are actually trade secret or know-how.

Some Policy Considerations:

- Strengthening TTOs (budget and capabilities)
- Providing sufficient translational research budget. Private sectors especially university spin-outs should be an eligible funding recipient.
- University TTO should be able to help putting research to use whether or not the outputs derive from a scientific research or social science, humanities and arts.