

IPR Issues in collaborative research and technology transfer

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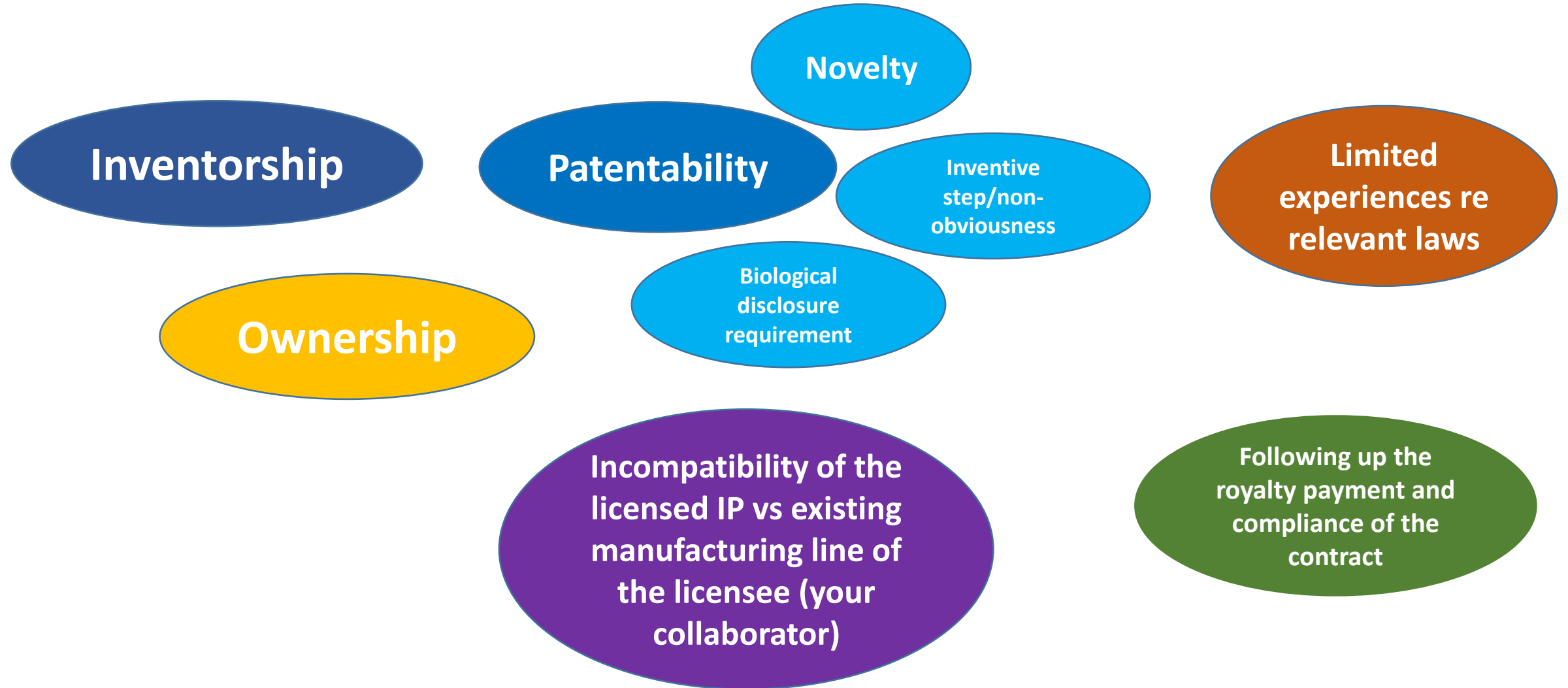
IP Policy Manager, Technology Licensing Office (TLO)

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What are common IPR issues in educational and research environment?



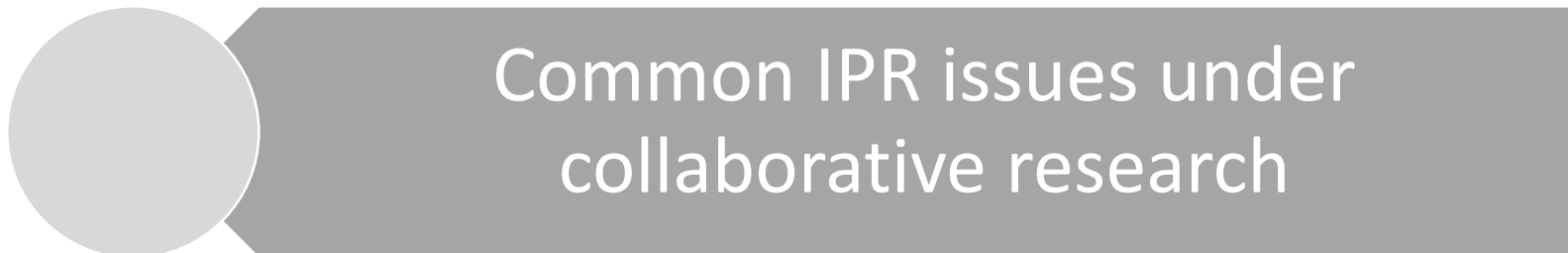
Selected common IPR issues in the educational and research environment



Points of Discussion

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Model of knowledge exchange and transfer

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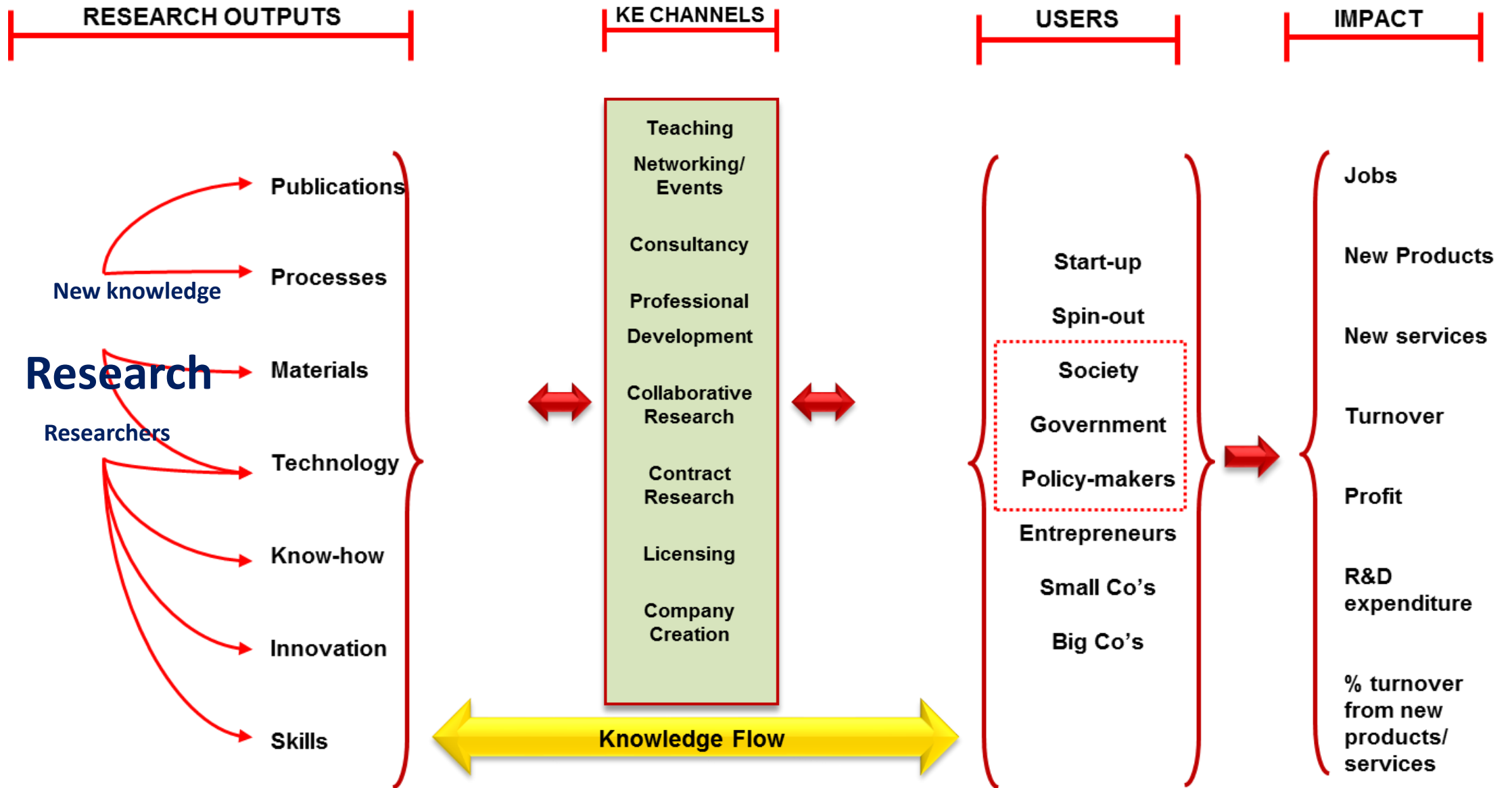
Common IPR issues under collaborative research

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NSTDA Case study

Model of Knowledge Exchange and Transfer

Model of Knowledge Exchange and Transfer



Common IPR issues under collaborative research

Value Chain of Collaborative Research

Pre-collaboration

Collaboration

Post-collaboration

Due diligence of your Research partner

Objective & goals

Project proposal: scope

Extension/
Completion/Termination of
the Contract

idea

Negotiation

Obligation

Monitoring

Next step

Technology-base

Institutional Policy

Roles and responsibility

Goes as planned?

IP-base

Any background IP?

IP Ownership, Management, & Benefit Sharing

Any improvement on the existing IP?

Any license needed?

NDA
MTA

Any foreground IP?

Collaborative
Research
Agreement

Service-base

Pre-collaborations

Research Agreements

- Are you or your research partner obligated to any sponsor of your research?
 - It is important to clear the ownership issue with your research sponsor (s).
- Any national law requirement/compliance?
 - E.g. The Thai Patent Act: a written prior consent from the joint owner for any commercialization of the jointly owned patent is required.
- What does your institutional IP Policy say?

Materials Transfer Agreements (MTAs), Confidentiality Agreements (CDAs)

Key issues: “obligation under the MTAs”

- Does your invention contain any 3rd party materials?
- Was your invention developed from the 3rd party confidential information?
- Do terms of any relevant MTAs or CDAs restrict any use of the materials, licensing, or commercialization of the invention?
 - MTAs for research use vs commercial use

Licensing Agreements: Is the invention already licensed ?

Collaborative Research

Collaboration

- Scope of the work -> Background IP and Foreground IP
- Management of any IP arising from the collaboration
 - IP relevant costs: Patent filing (national vs PCT), litigation, infringement
- Benefit Sharing: monitoring?

Post-Collaboration

- Monitoring the use of the licensed IP (if any)
- Any improvement of the existing IP?
- Treatment of the residual parts of the transferred materials after the agreement is over.

NSTDA Case Study

Case Study One: A license of the formula of Thai Economic Preservative for Rubber Sheet “BeThEPS”



BeTHEPS provides the same benefit of extending Shelf life by eliminating the coagulation and putrefaction problems. It does not have the detrimental side effects associated with ammonia and sodium sulfite.



Trade Secret: TS60MT00104

Title: Formula to extend shelf life of NR liquid for the purpose of rubber sheet production



**Trade Secret:
TS60MT00105**

Title: Process to prepare BeThEPS

Conventional way to preserve the natural rubber liquid

ammonia

บอแรกซ์

ฟอร์มัลดีไฮด์

sodium sulfite

โซเดียมคาร์บอเนต



Blue Moon Studio

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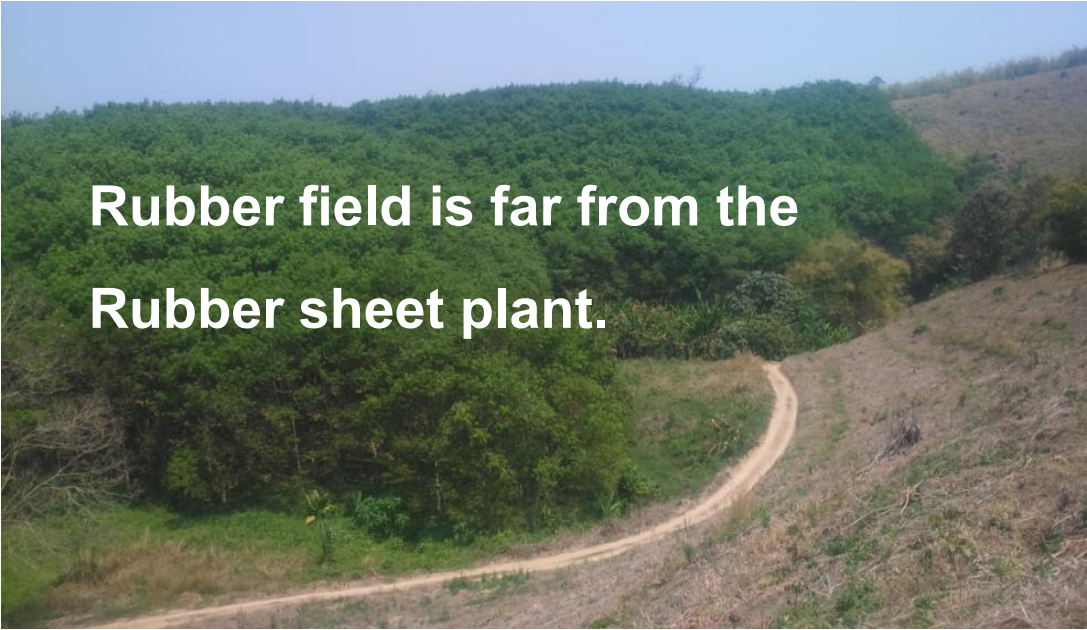
Rubber Sheet Production Process



Cause of the property loss before converting to a rubber sheet



Commuting issue



Rubber field is far from the Rubber sheet plant.

Limited production capability



Timeline: "BeThESP"



Technology Transfer



Licensee#2

Mar 2018

Seminar @
NAC2018

Licensee#1

Dec 2017

PR &
Marketing

Research
Finished

Field
Test

Licensee#3

April 2018

Licensee#4

May 2018

Technology
Awareness and
growing market
demand

Talk and Training for
user in different
location

Mechanism for Tech Transfer at NSTDA

NSTDA: National Research Centers

National Center for
Genetic Engineering
and Biotechnology



BIOTEC
a member of NSTDA

National Metal and
Materials Technology
Center



MTEC
a member of NSTDA

National Electronics
and Computer
Technology Center



NECTEC
a member of NSTDA

National
Nanotechnology
Center



NANOTEC
a member of NSTDA

NSTDA S&T Infrastructure

Promoting Innovation in Thai industries - Physical Hubs

Access to Infrastructure

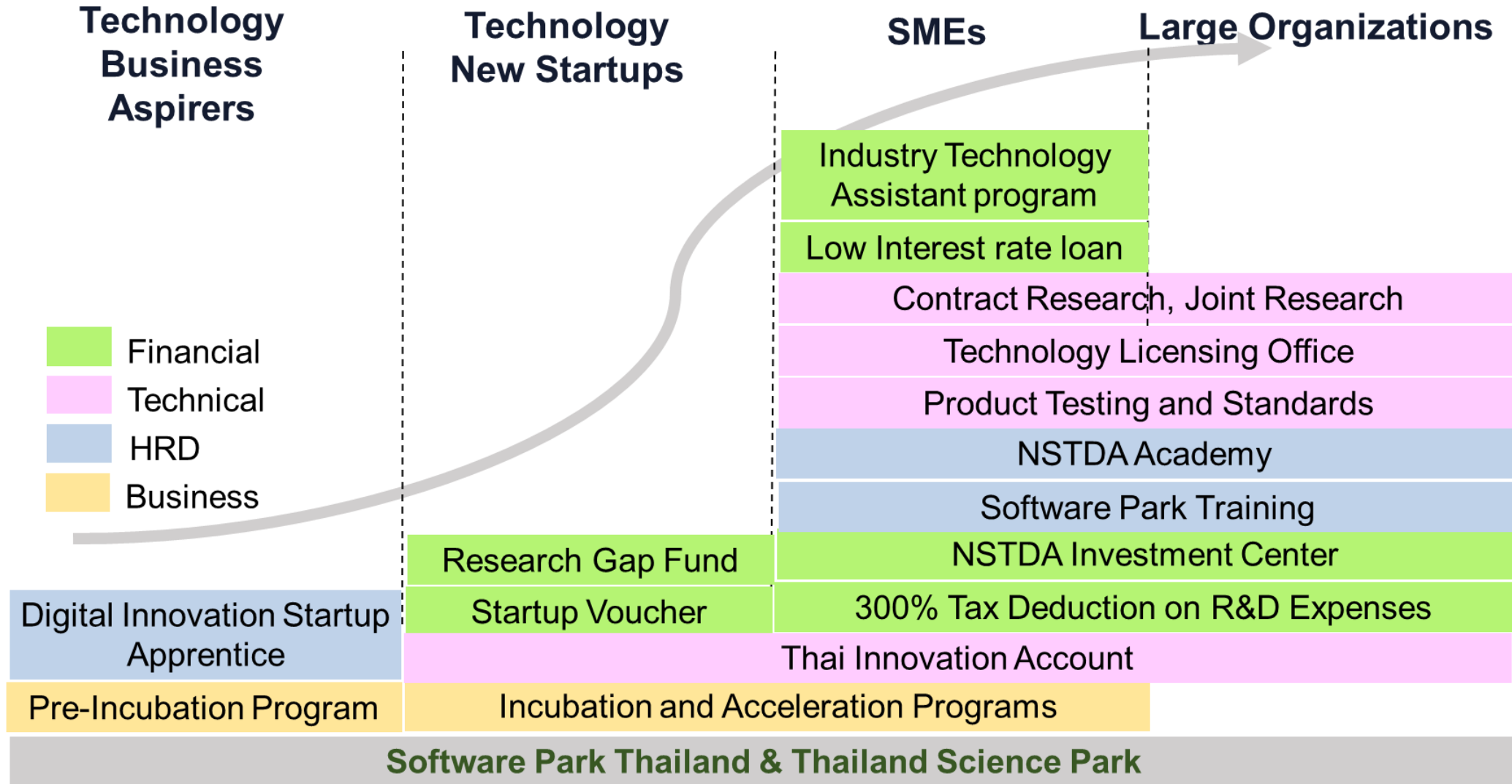
Access to Knowledge

Access to Capital

Access to R&D Network



NSTDA Supporting Mechanisms for STI & TTO



Technology Transfer

An in-wall Incubatee



Innovation of KEEEN Ltd.

Innovation: Bioremediation Agent to resolve the industrial waste treatment problem prior to discharge to nature.

Awards:

- **Awards from International Technology Expo 2012, Malaysia, May 2012**
 - Gold Medal
 - Excellent Biotechnology Innovation from Japan
 - Excellent Environment Innovation from China
- **Gold Medal from 8th Taipei International Invention Show and Technomart, Taiwan, September 2012**
- **Grand Prize 2012 from Asian Science Parks Association, October 2012**



Technology Transfer

An out-wall Incubatee



GIB: Green Innovative Biotechnology

Innovation: Natural ingredient Agricultural related products for plants and animals without chemical or Antibiotic



Year	Agencies	Activity	Result
2006-08	NSTDA/ITAP	Formulation, Product Development and testing	Commercilization Product
2014-15	NSTDA/BIC	Consultant on Operation, Organizational and Marketing	Effective Org structure and clearer marketing strategy and plan
2015	NSTDA/LIF	Business Model, Internationalization and Pitching workshop	Business model Revision with international mindset. Becoming effective presentation and
2015-16	NSTDA/BIC	Pitching on domesic and International competitions stages	Won reputable domestic and international Awards. Expanded market into China.

Take away messages

- “Trust” in your research partner is important
- Make sure you have your ideas/invention protected properly
- Ownership should be clear no matter you go for collaborative research, work for hire, or other forms of business transaction
- Check your institutional policy (IP policy, Conflict of Interest Policy, National IP laws)
- Seek for professional advice if needed



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