



Getting Inventions out of Academic Researchers

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FÉDÉRATION INTERNATIONALE DES CONSEILS
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Personally

- I know what was like before 1998 in Japan
- I know what has been like after 1999 in Japan
- I have a venture company to commercialize university inventions – 17 years old, still struggling
- I am a board member of UNITT (which corresponds to ATUM in the US)



Before starting

- Attorneys
 - In-house
 - Private practice
- Inventors
 - Employee
 - Private
 - **Academic – professors, assistants, students + joint research**
- Who is the client?
- Rough idea of what the invention is



Generally speaking at academic institutions

- The involvement of the management is weak at academic institutions
- While the number of professional research assistants (RA) and those who can help filing patent applications is increasing, nothing comparable to corporations is available
- As a patent attorney, you are expected to do everything yourself



Professors

- Expect no knowledge about patents
 - Bayh-Dole Act started in 1980 in the U.S.
 - In Japan, the TLO Act in 1998, an Act that corresponds to Bayh-Dole in 1999
- Know that a professor is the boss
- Know that a professor has a BIG ego
- Study the rules on dealing with professor made inventions
- Professors do publish, but is an academic paper sufficient for patenting?



Assistants and post docs

- Tricky – an assistant has to be nice to the professor and produce research results
- May fudge data - be prepared
- Expect that they would say something convenient
- May have to nail down to obtain necessary information



Students including graduate students!

- Students are not employees of a university
 - Different rules may apply
 - Any special arrangements?
 - Is a research assistant different?
- Generally easier to deal with



Joint research project with corporations

- Avoid getting caught between professor and corporate patent department
- Expect special secrecy rules





Thank you!

Anything else?

Questions?



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