Getting Inventions out of Academic Researchers

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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?