jctt Jihočeské Univerzitní a Akademické centrum transferu technologií

How to deal with the results of applied research and development?

Guide for academics

University of South Bohemia in České Budějovice
České Budějovice 2013

A GERMAN BUSINESS
INNOVATION UNIVERSITY

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The purpose of this guide is to provide researchers from the University of South Bohemia in České Budějovice a basic orientation in the process of industrial property protection and the management of intangible assets within our institution in a concise and understandable way. The guide was developed as part of the „South Bohemian University and Academic Technology Transfer Centre“ activity, which is funded by the Operational Programme Research and Development for Innovation.

prof. RNDr. Tomáš Polívka, Ph.D.,
Vice-rector for Research and Development

Foreword by the Rector of University of South Bohemia in České Budějovice

Dear researchers,

The University of South Bohemia is striving to market the results of their research and development, thereby contributing to the development of business and the socio-economic growth of the society. That is why it is precisely the area of technology transfer that is becoming our priority axis for the University.

This is an opportunity to develop new technologies, products and job opportunities. This step naturally leads to enhancing the profile of our university within the framework of its competitiveness in the Czech Republic and by extension in Europe.

The Technology Transfer Office provides support in co-operation with both small and large companies, irrespective of their nationality. The office initiates and supports technology transfer by working professionally and effectively with researchers, firms and organizations.

By means of the guide for researchers, we would like to bring you closer to the essential elements of technology transfer at the University of South Bohemia in České Budějovice. I hope and firmly believe that the guide will answer your basic questions relating to the area of industrial legal protection as well as the related commercialization process. Exploiting the possibilities of making the results of your research visible in the form of a successful transfer means increasing the visibility of our university and last but not least improving the quality of life in our society.

prof. RNDr. Libor Grubhoffer, CSc.,
Rektor

STEP BY STEP

...or what the proper prodecure at the University is

The University of South Bohemia in České Budějovice, in addition to their core activities, i.e. providing education and carrying out research, is also becoming a source of information and new
knowledge that can be used in the commercial sector. These findings can not only contribute to the development of knowledge, but also to socio-economic development. The utilized research and development may also provide funds that will be subsequently used to further develop our university. The whole process of protection of industrial property and the subsequent commercial application of scientific knowledge can be divided into several connected activities. The process begins by identifying research information, which could be usable in practice. Then, ascertaining whether these findings have real commercial potential is verified through experts. This is followed by the decision on whether University of South Bohemia in České Budějovice as an employer will exercise their rights to the knowledge, or whether those rights can be exercised by the researcher as the originator of the knowledge. Finally, the protection of industrial property rights is ensured and an appropriate method of commercial application is determined.
In order to facilitate the transfer of research results into practice the Technology Transfer Office was created, which guides you through this process step by step.

Simpler establishment of contacts with the commercial sector

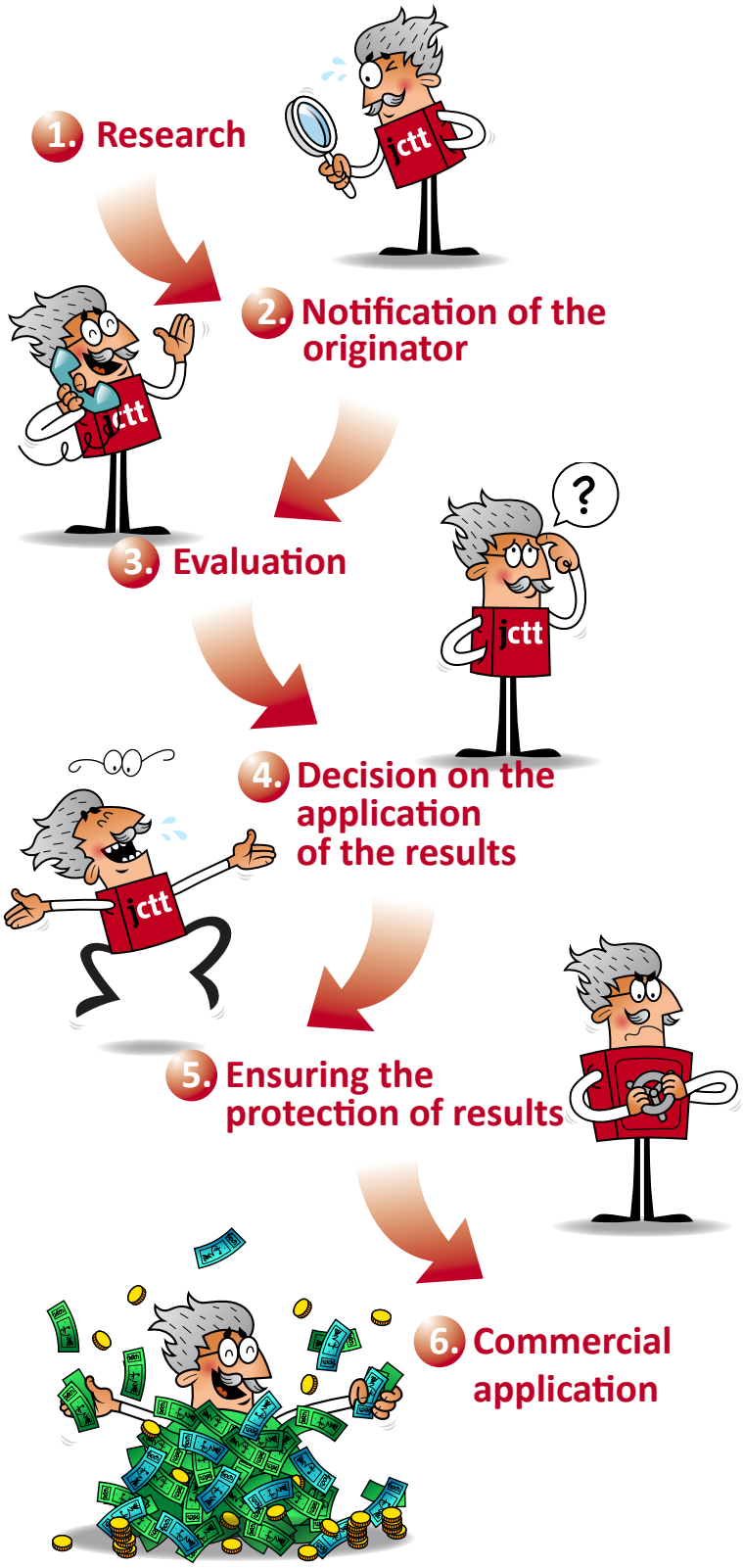
Transfer of technology contributes to social development

Efficient approach to the commercial application of scientific outputs

Presentation of the university and the scientific results of the individual faculties

„Money never starts ideas. It´s ideas that start the money.“

W. J. Cameron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3. Evaluation
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4. Decision on the application of the results
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5. Ensuring the protection of results
6. Commercial application

1. RESEARCH

... or new ideas, knowledge, results and technology

Scientific experiments and observations during research activities may often lead to inventions or technical solutions that are commercially applicable and can potentially bring profits not only to a university but also to their originator. If you believe that the results of your research have the potential to be applied in practice, contact the Technology Transfer Office through the technology scout who works at your faculty.
In the event that your faculty doesn't have a technology scout, do not hesitate to contact our Technology Transfer Office directly.

Technology scouts

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ALWAYS BEAR IN MIND

The results of research and development can be protected as industrial property only if they satisfy the condition of **novelty. Disclosure of the nature of your research and development results, for example in the form of a graduation thesis or dissertation or publishing them in a scientific article, means the loss of novelty and such a result cannot be protected anymore.**

One should consider the intellectual property protection of his/her work via the Technology Transfer Office before submitting a paper, graduation thesis or dissertation.

When deciding to publish the results of research and development it is necessary to remember and take into account the fact that the copyright protection applies, among other things, to literary works (texts) and works of art (pictures, graphs, photographs). Unlike industrial rights the copyright protects only the expression of scientific or research results in a form perceivable by human senses, therefore, not the results themselves. To ensure a balance between the protection of business opportunities and publication activities, it is recommended that the researcher in collaboration with the technology scout create a **publication plan** immediately after identifying results with possible commercial potential. Under this plan, it is determined when and how the information related to results with a possible commercial impact can be published in professional journals, made public at conferences or otherwise publicly presented or what type of information and in what form can be published immediately.

What is a technological scout?

A technological scout is an employee of the faculty and also a consultant working for the Technology Transfer Office, who in the process of the transfer of knowledge and understanding, systematically identifies and evaluates the results of research and development, which may be commercially exploitable. They help to effectively provide and implement professional services and the results of science and research of their faculty which they actively represent. They are trained in the protection of intellectual property and have practical experience of working with the commercial sphere.

2. NOTIFICATION OF THE ORIGINATOR

...or contact the Technology Transfer Office or a technology scout

If a result eligible for industrial legal protection was created by an employee - originator within the framework of a work assignment or other similar relation with University of South Bohemia in České Budějovice, the property rights of this result belong to University.

Each worker should notify in writing their immediate superiors and the staff of Technology Transfer Office about the creation of results eligible for industrial legal protection.
In conjunction with Technology Transfer Office they should then fill out the form ‚Notification of an originator / co-originator'.

That enables the employer to get acquainted with the results in their entirety. After the employer is properly informed, the **3 month** time limit commences, in which the employer is required to decide whether to enforce the right of the result eligible for industrial legal protection or not.
At the University of South Bohemia in the České Budějovice The Measures of the Rector on the Management of Intangible Assets (R249_2013) addresses this issue.

*The form **‚Notification of an originator / co-originator‘** is Annex 1 of The Meassures of the Rector on the Management of Intangible Assets. It can be obtained in both electronic and paper form from any technology scout directly in the Technology Transfer Office or on the University of South Bohemia in České Budějovice website:*
http://www.jctt.cz/vyzkumnici-ju/dokumenty-ke-stazeni/

Before starting any co-operation with other research institutions or private subjects it is necessary to pay sufficient attention to the management of intellectual property. Its rules will determine how and by whom the results of the joint research will be utilized. It is appropriate to conclude a co-operation agreement in which questions regarding ownership / co-ownership of the results of joint research and development will be answered, as well as, a way of sharing and further use of these results. In this way, unnecessary potential future disputes are avoided.
The legal and administrative services associated with the conclusion of co-operation agreements, are provided by Technology Transfer Office.

3. EVALUATION

...or evaluating the results within the framework of University

For industrial legal protection, only those results that have been assessed as commercially promising, should be chosen and their further development and implementation will be subject to a lower risk of failure compared with results that did not advance to the next phases.

Important factors in decision-making are primarily technological factors – these particularly concern **the novelty, the degree of innovation of the solutions as well as technology maturity.**

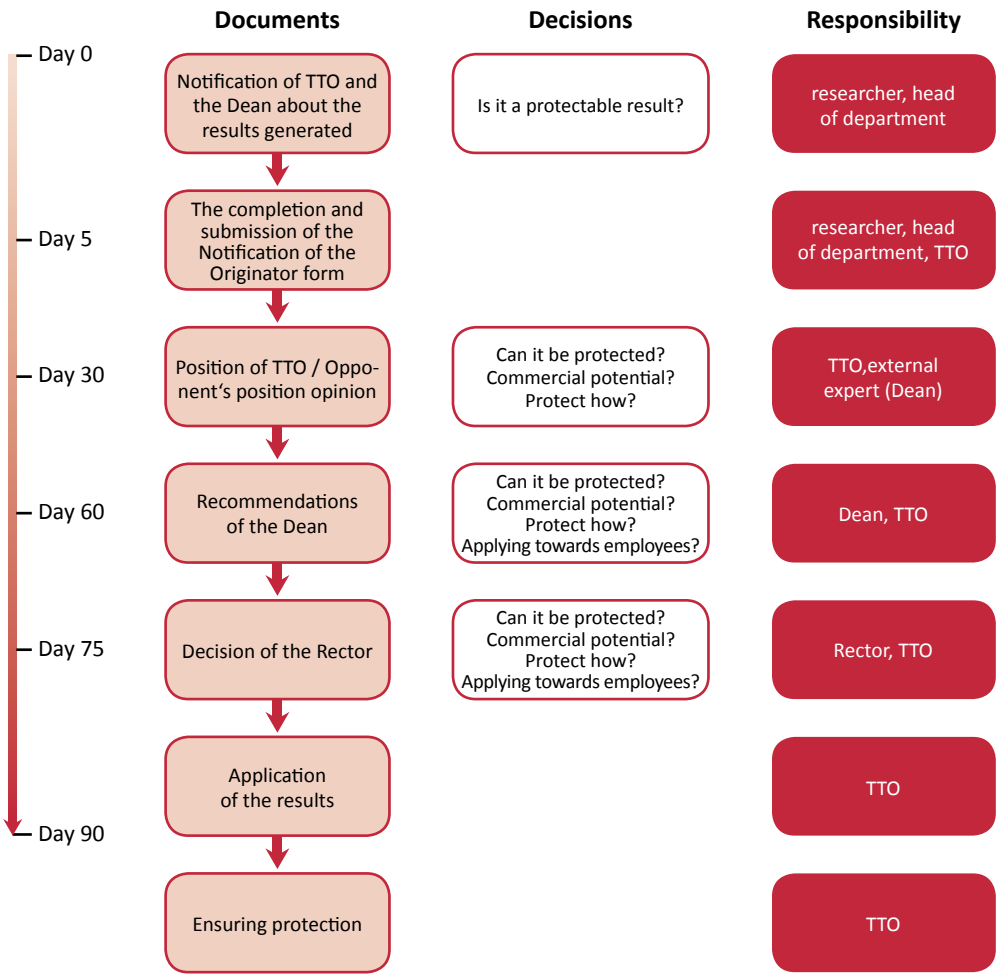
Other factors in the decision to initiate the process of industrial legal protection are market and economic factors. **Finding market potential with a sufficiently large market is a key factor for applying scientific results / technology into practice.**

Technology Transfer Office prepares a position for each notified result with possible commercial potential which includes the above-mentioned technological and economic and market factors, as well as recommended forms of industrial legal protection, an analysis of the financial level of difficulty for legal protection as well as a preliminary plan for the application of the results into practice.

This opinion is forwarded to both the researcher worker – originator of the results of research and development, the Dean of the relevant faculty and subsequently the Rector of the university to facilitate decisions on the application of the rights of the results.

Diagram of industrial legal protection for University of South Bohemia in České Budějovice

For the process of recognizing the opportunities and decisions on industrial legal protection, a unified plan has been created within University of South Bohemia in České Budějovice under which a timeline of processes is set, summarizing the key terms and important decision points.



(TTO – Technology Transfer Office)

4. DECISION ON THE APPLICATION OF THE RIGHTS OF THE RESULTS

...or what comes next

The Rector makes the decision on whether or not to exercise the rights to results of research and development, and does so not later than 3 months from the first written notification on the occurrence of the results.

If University decides to exercise its right, the employee loses the right to use the result. However, employees have the right to put their names as the originator of the result and the right to equitable remuneration.
The researcher / originator of the result shall be informed about this decision in writing through the completed form ‚Application of the results toward the originator/co-originators'. If the University does not exercise their right within three months, this right returns to the originator.

Originators always receive a one-time reasonable remuneration for the result to which University asserts their rights. According to The Meassures of the Rector on the Management of Intangible Assets (R249_2013) the amount of compensation is determined for each faculty by the Dean.

*The form **‚Application of the results toward the originator / co-originator'** is Annex 2 to The Meassures of the Rector on the Management of Intangible. Its sample can be obtained through any technology scout at Technology Transfer Office or at: http://www.jctt.cz/vyzkumnici-ju/dokumenty-ke-stazeni/*

5. SECURING THE PROTECTION OF RESULTS

... or how to choose the most appropriate form of protection

The appropriate form of protection of research and development results is decided on by the Rector, taking into account the position of Technology Transfer Office and the Dean of the relevant faculty. Based on the information you provided in the previous step and thanks to the materials supplied, workers of Technology Transfer Office begin to prepare a written application with continuous joint consultations. Furthermore they carry out a preliminary search, or examination on the basis of which it is determined whether someone else has already invented a similar science and research result. Proper protection of intellectual property is the most important condition that precedes consideration of the offer and the sale of scientific results/technology.

What can be protected?

Subjects of Industrial Property				
Technical solutions		Design solutions	Labeling rights	Other
Inventions	Utility models	Industrial designs	Trade marks Designation of origin Geographical indication	Plant varieties Animal breeds

*Industrial property is the results of intellectual activities which are **new and industrially usable**. These include inventions, utility models, industrial designs and protected trademarks. Protection of industrial property in the Czech Republic is implemented by registration and maintenance in the appropriate registry of the Industrial Property Office. For protection abroad, there are two options: a patent application may be filed separately for each selected country, or through one form, the acquisition of industrial property protection for multiple countries at a time.*

Ensuring the protection of results and consequently the industrial property of University of South Bohemia in České Budějovice is managed by Technology Transfer Office. The Office also advises on intellectual property protection including advice on copyright. It also offers the provision of basic research and mediation of patent searches.

***A patent** is an exclusive right to an invention that is new, is the result of inventive activity and can be used industrially. It gives its owner the exclusive right to prevent others from making, using, offering for sale, selling or importing a product or a process, arising out of the patented invention without the permission of the patent owner. A patent is a powerful business tool, allowing academic institutions to have exclusivity for a new product or process, develop a strong market position and gain additional revenue through licensing. Patents also represent territorial rights, which means that the invention is only protected in those countries or regions where patent protection was acquired.*

***The utility model** is the so-called „small patent", it is similar to a classic patent. A technical solution, which is its essence and is protected by it after the issuance of a certificate of registration, does not have to achieve the dimension of an invention. However, it is required that it goes beyond mere technical skills, that it not be just an external modification of a product and that it be industrially applicable. A utility model can not protect manufacturing processes.*

***The industrial model** is the appearance of a product or its parts specifically in the characteristics of lines, contours, colors, shape, texture or materials of the product itself or its ornamentation, which is eligible for protection if it is new and has individual character.*

***A trademark** is any sign capable of graphic representation, particularly words, including personal names, colors, drawings, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one person from those of others.*

6. COMMERCIAL APPLICATION

...or a good choice for another possible success

Depending on the form of commercial use, this stage varies. Commercial application of research and development results means primarily the sale or transfer of rights to the result, then it may concern the establishment of a new company, so-called spin - off firms, or establishing co-operation with a commercial firm for the further development of the results.

Patenting and the sale of a patent or license or know - how is one of the main methods of commercial application of research and development results. The biggest weakness of this model is the relatively weak link between research institutes, i.e. the originators of the result, and its users from the commercial sector.

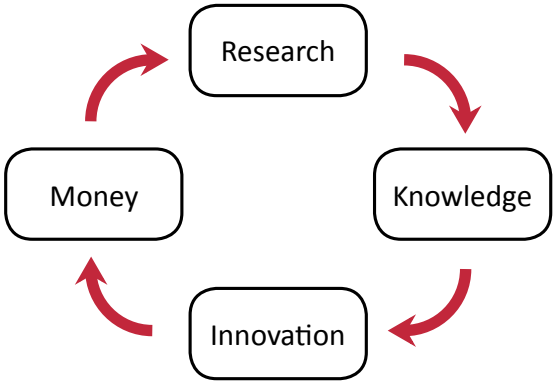
Establishment of spin - off companies is the most complex type of commercial application of research and development results. It carries a high risk of failure and it is first necessary to invest in the equity of the companies, but the promise of revenue is the greatest of all methods of commercial application.

Joint research - development projects with commercial entities are highly competitive and promising for university workplaces. They allow quick access to financial resources. Between staff from the research and the commercial sector, there is a strong link and researchers can quickly respond to market demand.

What is a spin - off company?

A spin - off is a company, which was separated from the parent organization and becomes an independent company, it is established for the purpose of commercial application of research and development created at the university. The university inserted its industrial property into an emerging company and acquires a stake in it, or provides a company a license. In most cases university employees contributed to the development of it. Sometimes in literature the term spin-out is used, it can be used as a synonym.

Technology Transfer Office, in cooperation with the originator, processes plans for the commercial application of the results and proposes a suitable form of application. The Office shall submit the developed plan to the Dean of the relevant faculty and subsequently, together with the opinion of the Dean, hand it over for approval to the Rector.
The Office holds talks with potential customers, actively searches for commercial partners for cooperation and promotes the research activity of the individual faculties.
Technology Transfer Office is also the contact point for companies interested in co-operation with University of South Bohemia in research and development, the use of laboratory capacity, contract research, licenses, expert consultations, etc.



Originators are rewarded for the commercial use of the results. The amount is determined as a percentage of net revenues according to the following criteria:

Net income	Amount of remuneration to the originators	Share of originator workplace	Share of Technology Transfer Office	Contribution to license fund
up to 100,000 CZK	70%	10%	10%	10%
up to 1 mil. CZK	55%	20%	15%	10%
over 1 mil. CZK	40%	34%	20%	6%

* Unused Technology Transfer Office allowances are transferred to the License Fund at the end of the year (if there are any).
** In the creation of the university license fund, these monetary means belong to the workplace of the originator.

CONTACTS

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