

S E M I N A R

The Association of European Science & Technology Transfer Professionals

# SCIENCE BASED INTELLECTUAL PROPERTY MANAGEMENT

*Thursday 6 November &  
Friday 7 November 2003*

EUROPA HOTEL  
BOLOGNA  
ITALY



## INTRODUCTION

ASTP invites you to Bologna, host of the oldest university in the world. We are proud to present you a seminar programme on Science Based Intellectual Property Management with expert speakers from Europe and the US. For the first time we also offer an *Introductory course* on Intellectual Property- and Patent Rights for those who have recently started their profession on the interface between Science and Industry.

Bologna is located in the Emilia-Romagna province, an excellent region for innovative start-ups, awarded as 'Region of Excellence' in 2001 and renowned of its delicious Italian spices and tasty dishes. The city offers the right ambiance to share world class expertise on IPR between University and Industry among speakers and participants. We are looking forward to meeting you in Bologna!

### Thursday 6 November

Registration desk open from 08.30

PLENARY: 09.00 – 10.30

OPENING & WELCOME	
09.00	<b>Paul van Grevenstein</b> , President of ASTP, Opening
09.05	<b>Pier Ugo Calzolari</b> , Magnifico Rettore University of Bologna, Italy, Welcome
09.15	<b>Jan de Wit</b> , Staff Director Technology AKZO-Nobel and Professor Research Strategy & Management KUN, The Netherlands Integrating Science based IPR in an Industrial Technology Development Strategy <i>Forum Discussion</i>

10.30 – 11.00 BREAK

PARALLEL: 11.00 – 12.30

INTRODUCTION TO INTELLECTUAL PROPERTY RIGHTS	CAPTURING IP - A	CAPTURING IP - B
<p style="text-align: center;"><i>Moderator Danielle Berneman</i></p> <p><b>Sue Scott</b>, Consultant Abel &amp; Imray United Kingdom</p> <p><b>Todd Juneau</b>, partner Nath &amp; Associates, US</p> <p>Intellectual Property Rights exist in many forms. This session will address the global framework and major assets such as patent right, trademark right and copyright.</p>	<p style="text-align: center;"><i>Moderator Rudy Dekeyser</i></p> <p><b>William Bird</b>, European Patent and Trade Mark Attorney Bird Goën &amp; co, Belgium</p> <p>Publications, conference presentations and poster sessions are everyday occurrences in an academic environment. Each such disclosure can threaten the ability to obtain a patent. This session will address questions such as:</p> <ul style="list-style-type: none"> <li>- When does an article become a publication?</li> <li>- How public is electronically available information?</li> <li>- How closed is a meeting?</li> <li>- Are slides used during oral presentations publications?</li> <li>- How about a poster ?</li> <li>- When is a thesis a disclosure ?</li> </ul> <p>Creating your own prior art is one way to destroy your IP position. A second way is thoughtless contract drafting. Second part of the session will comment on common IP destroying pitfalls in non-disclosure agreements, material transfer agreements, research contracts and others.</p>	<p style="text-align: center;"><i>Moderator Jon Wulff Petersen</i></p> <p><b>Conny Bogentoft</b>, Managing Director Karolinska Innovations, Sweden</p> <p>Technology auditing is a systematic review of the intellectual property (IP) being generated at an institution and a method of identifying innovations of commercial value. Auditing involves:</p> <ul style="list-style-type: none"> <li>- Identifying research groups with commercially applicable research</li> <li>- Identifying where inventive steps have been made and where a strong patent position can be secured</li> <li>- Assessing preliminary commercial value, freedom to operate, market analysis</li> <li>- Formulating ideas on commercialisation strategy.</li> </ul> <p>This session will reflect on approaches to auditing and its value.</p>

12.30 – 14.00 LUNCH



PARALLEL: 14.00 – 15.15

INTRODUCTION TO PATENT RIGHTS PART 1	MANAGING IP ONCE IT WALKS THROUGH TO THE DOOR - A	MANAGING IP ONCE IT WALKS THROUGH TO THE DOOR - B
<p><i>Moderator Danielle Berneman</i>  <b>Sue Scott</b>, Consultant Abel &amp; Imray, United Kingdom  <b>Todd Juneau</b>, partner Nath &amp; Associates, US</p> <p>Patent rights are pivotal in the commercialization of high value products. In globo, an invention has to be novel, non-obvious and industrially applicable to be patentable. Using clarifying examples, this session will introduce the basic concepts of novelty, inventive step and utility.</p>	<p><i>Moderator Rudy Dekeyser</i>  <b>Alison Campbell</b>, Director IP MRC-Technology, United Kingdom</p> <p>Inventorship is one of the muddiest concepts of the patent law. This session will present advice on how to deal with inventors, how to determine inventorship and how to assure that title to inventions is assigned correctly to the institution. The use of incentives to inventors and their collaborators will also be discussed in simple and more complex situations.  <b>Antonio Maschio</b>, Partner D. Young &amp; Co, London, United Kingdom</p> <p>The globalisation of research often results in inventions and the related joint ownership can be a complicated process. This session will comment on the potential pitfalls and will articulate good practices.</p>	<p><i>Moderator Jon Wulff Petersen</i>  <b>Peter Koefoed</b>, CEO &amp; European Patent Attorney Inspicos, Denmark</p> <p>There is a world of difference between filing a patent application and building an intellectual property right portfolio. This session will address questions such as: when to patent, publish or protect information as a trade secret? How to build freedom-to-operate? Which strategies can be followed to bundle technologies into a proprietary platform?</p>

15.15 – 15.45 BREAK  
 PARALLEL: 15.45 – 17.00

INTRODUCTION TO PATENT RIGHTS PART 2	APPRAISING TECHNOLOGIES Ensuring the strongest possible patent protection	THE TECHNOLOGY TRANSFER DEATH SPIRAL AND WAYS TO RECOVER BEFORE YOU CRASH
<p><i>Moderator Danielle Berneman</i>  <b>Sue Scott</b>, Consultant Abel &amp; Imray, United Kingdom  <b>Todd Juneau</b>, partner Nath &amp; Associates, US</p> <p>Obtaining patent rights requires:</p> <ul style="list-style-type: none"> <li>- disclosure of the invention in such a way that the inventive step can be reproduced by one 'skilled in the art'</li> <li>- demonstrating utility – giving results and examples</li> </ul> <p>This session asks when an invention is sufficiently disclosed and the trade off between this requirement and the need to give examples and specific information, experimental results etc to prove utility. Are there basic rules in drafting claims, and is it safe to leave these decisions to patent agents alone?</p>	<p><i>Moderator Gábor Lamm</i>  <b>Tim Barnes</b>, Managing Director &amp; Co-founder Lodestone Innovation Partners Ltd, London, United Kingdom  <b>Christian Kilger</b>, Managing Director IPAL, Germany</p> <p>The speakers will explore approaches to build an efficient decision making process for the triage of patent applications: how to separate the wheat from the chaff in an expanding patent portfolio? The speakers will also provide strategies for optimal patent filing, maintenance and prosecution. Issues presented will include priority filings, broad geographical protection at minimal cost, fast tracks to granting and methods to extend patent life.</p>	<p><i>Moderator Jeff Skinner</i>  <b>Robert S. MacWright</b>, Executive Director University of Virginia Patent Foundation, US</p> <p>As a TTO matures, its patent portfolio tends to expand and managers have less time to spend on each project. They also have less time to appraise new technologies, and tend to patent more 'just to be safe'. This, of course results in vicious spirals of even larger portfolios and even less time to spend on each project. The speaker will describe this spiral, its warning signals and ways of escaping it.</p>

17.00 – 18.30 COCKTAIL  
 18.45 SOCIAL PROGRAMME (OPTIONAL)

## Friday 7 November

PLENARY: 09.00 – 10.30

DIRTY LITTLE TRICKS IN LICENSING
<p><i>Moderator Jeff Skinner</i>  <b>Robert S. MacWright</b>, Executive Director University of Virginia Patent Foundation, US</p> <p>This session is all about negotiation tactics and the games people play when they are negotiating with you. Deliberately light-hearted, the session will help you to recognize when you are being manipulated and undermined, and tell you how to foil such ploys.</p>





10.30 – 11.00 BREAK  
PARALLEL: 11.00 – 12.30

INTRODUCTION TO PATENT RIGHTS PART 3	ADDING VALUE TO IP - A, PART 1 Adding value through well-structured License agreements	ADDING VALUE TO IP - B, PART 1 BUSINESS MODELS
<p><i>Moderator Paul van Grevenstein</i> <b>Sue Scott</b>, Consultant Abel &amp; Imray, United Kingdom <b>Todd Juneau</b>, partner Nath &amp; Associates, US</p> <p>The patent system is not globally harmonized. This session will explain important particularities of the European and the US system, such as the grace-period, the first-to-invent versus first-to-file principle, the interference procedure and the opposition procedure.</p>	<p><i>Moderator Jon Wulff Petersen</i> <b>Mark Anderson</b>, Anderson &amp; Company, United Kingdom</p> <p>To create a win-win situation for both licensor and licensee, the negotiation and the language of a license agreement has to be well thought-out. This session will deal with major issues in license agreements. Topics that will be addressed are:</p> <ul style="list-style-type: none"> <li>- carving up fields, territories and products;</li> <li>- grant clauses-pitfalls and opportunities;</li> <li>- performance obligations - do they really bite;</li> <li>- payment structures - tricks of the trade;</li> <li>- IPR management who does it, who pays for it;</li> <li>- liability and indemnity - will they stand in court;</li> <li>- boilerplate terms - why some of them matter.</li> </ul>	<p><i>Moderator Gábor Lamm</i> <b>Larry Steranka</b>, Associate Director for Licensing, Harvard University's Office for Technology and Trademark Licensing, US</p> <p>A growing tech transfer office is confronted with a palette of inventions ranging from research tools to products and from novel drug targets to software. The diverse types of inventions and IP have to be placed in quite different market environments and their commercialisation therefore requires a combination of generic and tailor-made approaches. In this session the participants will be provided with proven models to commercialise generic technologies and with models to commercialise research tools.</p>

12.30 – 14.00 LUNCH  
PARALLEL: 14.00 – 15.15

INTRODUCTION TO PATENT RIGHTS PART 4	ADDING VALUE TO IP – A, PART 2 To enforce or not to enforce	ADDING VALUE TO IP – B, PART 2 Business models
<p><i>Moderator Paul van Grevenstein</i> <b>Sue Scott</b>, Consultant Abel &amp; Imray, United Kingdom <b>Todd Juneau</b>, partner Nath &amp; Associates, US</p> <p>What to do if you observe that a third party is exploiting your patented invention without the necessary licenses? This session will provide insight in concepts such as infringement, doctrine-of-equivalence and methods to enforce your IP.</p>	<p><i>Moderator Rudy Dekeyser</i> <b>Remco de Ranitz</b>, Attorney at Law Arnold &amp; Siedsma, the Netherlands</p> <p>The interpretation of patent language is not always as black and white as one wishes. This session deals with questions such as:</p> <ul style="list-style-type: none"> <li>- When can you use the experimental use exemption to escape infringement?</li> <li>- When do others start infringing your patent: only when they start to sell it or as soon as they use or develop it (e.g. for clinical trials)?</li> <li>- Can you enforce IP when the patent is still pending?</li> <li>- What are the key differences between the major territories (US, EU, Japan)?</li> <li>- How far can you stretch the doctrine-of-equivalence to establish the line between infringement and non-infringement.</li> </ul>	<p><i>Moderator Gábor Lamm</i> <b>Martin Raditsch</b>, Head of Business Development, EMBL-EM GmbH, Germany <b>Vincent Rijckaert</b>, Patent Officer IMEC, Belgium</p> <p>In line with the first part of the session on adding value to IP, the speakers of this session will provide the audience with models to commercialise:</p> <ul style="list-style-type: none"> <li>- medical devices</li> <li>- bio-informatics derived IP</li> <li>- specifically software tools</li> <li>- databases</li> <li>- LIMS</li> </ul>

15.15 – 15.30 BREAK  
PLENARY: 15.30-16.45

Bundling Technology: a useful role for a TTO or a waste of time ?
<p style="text-align: center;"><i>Moderator Jeff Skinner</i> –</p> <p><b>Alison Campbell - Robert MacWright</b></p> <p>Should we put time and effort into 'bundling' technologies ? that is identifying complementary technologies (sometimes in other institutions) and combining them into a single 'package' for onward licensing? The idea seems sensible on the face of it – the whole can be worth more than the sum of its parts. Structured as a formal, but hopefully entertaining debate, Robert MacWright and Alison Campbell argue for and against TTO's getting into the business of technology bundling.</p>

16.45 RECEPTION & CLOSURE



## SOCIAL PROGRAMME

**Wednesday, 5 November 2003**  
**Visit to ASTER and guided tour through Bologna**

On Wednesday afternoon an optional programme will be offered to ASTER, the Technology Transfer consortium of the four universities of Emilia-Romagna together with Regional Government and National Research Centres. Directly after this visit we will return to the city centre and walk along the highlights of Bologna. The optional tour starts at Hotel Europa at 13.30 and ends at the Emilia Romagna Region Building with an informal cocktail.



**Wednesday, 5 November 2003**  
**Welcome cocktail at ASTER**  
**for all participants**

The Wednesday afternoon preceding the two-day seminar, a cocktail will be offered by ASTER. The Regional Minister of Productive Activities, Economic Development and Telematic Plan will welcome all delegates of the conference at the Emilia Romagna Region Building at 18.00. We warmly invite you to have a first acquaintance with each other while enjoying a glass of Italian wine or other joys of 'la Bella Italia'.



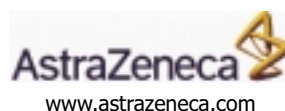
**Thursday, 6 November 2003**  
**Joint dinner**

On Thursday evening you are invited to join us for a dinner. Bologna is famous because of its delicious food. While enjoying a typical Italian dinner there will be plenty of time for conversation and exchange of experiences.



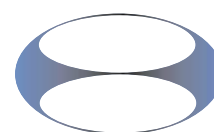
*Hotel Europa, conference venue*

**This conference is sponsored by**



## GENERAL INFORMATION

- Date** (Wednesday 5 November), Thursday 6 November & Friday 7 November 2003
- Conference Venue** Hotel Europa, Via c. Boldrini 11, 40121 Bologna, Italy
- Language** English
- Registration** All participants who wish to attend the conference must register in advance. Please note that formal registration only takes place after receipt of the registration fee. Participants are requested to complete the enclosed Registration Form and return it to Science Alliance or register digital at the ASTP-website [www.astp.net](http://www.astp.net) (left button Events etc.). Each participant should use a separate form. A letter of confirmation will be sent to you upon receipt of the registration form. The capacity of the conference will be limited. Registrations will be handled in order of receipt.
- Registration Fee** The registration fee for participation in the conference is € 1095 for Non-ASTP members and € 795 for ASTP members (excl. 19 % VAT). The registration fee includes admittance to the conference as well as extended conference documents, lunches and refreshments. **The fee must be paid in advance to participate.**
- ASTP Membership** If you would like to register for this conference as an ASTP member and are currently not a member, we kindly ask you to return the attached and completed *ASTP Membership Application Form* or apply for the membership via the website [www.astp.net](http://www.astp.net). As soon as your membership is accepted, you will receive an adapted invoice for the conference and a separate invoice for the ASTP membership fee.
- Payment** All payments must be made in € (EURO) and free of all bank and other charges. No personal or company cheques are accepted.
- Cancellation** In case you are unable to attend, a substitute delegate is welcome at no extra charge if he/she carries a letter of authorization from the original participant. Should you cancel before October 15th 2003, an administration fee of € 95 will be charged. Please note that no refunds are possible after October 15th 2003.
- Accommodation** We advise you to take care of hotel reservations and flight accommodations in time. Information on hotel reservation-services is available at the backside of the registration form.
- Insurance** The conference organisers do not accept any liability for personal injuries or for loss of and/or damage to personal belongings of the conference participants, either during or as a result of the conference. Please check the validity of your insurance.
- Organisation** The conference is a joint production of ASTP and Science Alliance. Science Alliance is responsible for all logistics of the conference.
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