

## Grantsmanship Workshop

### Intellectual Property (IP) Protection, Management and Commercialization

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Key terms commonly used in the fields of technology transfer and IP management (adopted from *Intellectual Property Management in Health and Agricultural Innovation: A Handbook of Best Practices 2007* (eds. A Krattiger, RT Mahoney, L Nelsen, et al.). MIHR: Oxford, U.K., and PIPRA: Davis, U.S.A. and publications of the World Intellectual Property Organization).

**Assignment:** an intellectual property assignment is a permanent transfer of ownership of an intellectual property right, such as a patent, trade mark or copyright, from one party (the assignor) to another party (the assignee). Consequently, the assignee becomes the new owner of the intellectual property right.

**Claims:** the section of the patent that defines an invention (the technology that is the exclusive property of the patentee for the duration of the patent) and is legally enforceable; that is, the claims set the metes and bounds of the patent rights.

**Commercialization:** the process of taking an invention or discovery to the marketplace. It involves working the idea into a business plan, consideration of protection options, and determining how to market and distribute the finished product.

**Compulsory license:** a license granted by the State upon request to a third party that, through the license, is permitted to exploit a patented invention after the owner of the patent has refused to provide a voluntary license under acceptable conditions.

**Confidential disclosure agreement/confidentiality agreement/ nondisclosure agreement (NDA):** a legal document through which intellectual property can be disclosed by one party to another wherein the latter party is permitted to use the information for certain purposes, and only those purposes, that are stated in the agreement and agrees not to disclose the information to others.

**Copyright:** an exclusive right conferred by the government on the creator of a work to bar others from reproducing, adapting, distributing to the public, performing in public, or publicly displaying said work. Copyright does not protect an abstract idea; it protects only the concrete expression of an idea. Copyright describes a bundle of rights given to creators in relation to their literary and artistic works.

**Disclosure of origin:** a requirement imposed on patent applicants to disclose in patent applications the geographic origin of biological material on which the invention (subject of the patent application) is based.

**Exclusive license agreement:** a legal document licensing IP to another party for its exclusive use. Exclusively licensed patent rights cannot, within the scope or field of the exclusive license, be subsequently or simultaneously licensed to any other party.

**First to file:** a rule under which patent priority is determined. The rule gives priority to the party that first files a patent application for an invention, rather than to the party that is first to invent.

**First to invent:** a rule under which patent priority is determined by which inventor was the first to actually invent, rather than by who was the first to file a patent application. This is the rule followed in the United States. Compare to first to file.

**Freedom to operate:** the ability to undertake research and/or commercial development of a product without infringing the unlicensed intellectual or tangible property rights of others.

**Geographical indication:** a geographical indication is a sign used on goods that have a specific geographical origin and possess qualities or reputation that are due to their place of origin, for example, Ceylon Tea, French Champagne.

**Industrial design:** an industrial design refers to the aesthetic aspects or outward appearance of a product.

**Intellectual property (IP):** creative ideas and expressions of the human mind that have commercial value and are entitled to the legal protection of a property right. The major legal mechanisms for protecting intellectual property are copyrights, patents, and trademarks. IP rights enable owners to select who may access and use their intellectual property and to protect it from unauthorized use.

**Intellectual property management:** the means by which an institutionally owned IP portfolio is managed with regard to marketing, patenting, licensing, and administration.

**Invention:** the creation of a new technical idea and of the physical embodiment of the idea or the means to accomplish it. To be patentable, an invention must be novel, must have utility, and would not have been obvious to those possessing ordinary skill in the particular art of the invention.

**Inventive step (non-obviousness):** a condition for patentability, which means that the invention would not be obvious to someone with knowledge and experience in the technological field of the invention. Obviousness means a person with ordinary skill in a field of technology can readily deduce it from publicly available information (prior art).

**Joint inventors:** two or more inventors of a single invention who work together during the inventive process.

**Know-how:** information that enables a person to accomplish a particular task or to operate a particular device or process.

**Industrial property:** is a subset of intellectual property, referring to those types of intellectual property that have an industrial application. Specifically, it refers to patents, trademarks, designs, mask works, and plant breeders' rights.

**Infringement:** an invasion of an exclusive right of intellectual property. Infringement of a utility patent includes making, using, or selling a patented product or process without permission.

**License:** a grant of permission to use an IP right within a defined time, context, market line, or territory.

**Material transfer agreement (MTA):** a contract between the owner of a tangible material and a party seeking the right to use the material for research or other assessment purposes. The

material may be either patented or unpatented. Material transfer agreements tend to be shorter than license agreements. The purpose of an MTA is to document the transfer of the material and outline the terms of use, including identification of the research or assessment project, terms of confidentiality, publication, and liability. The main objective of concluding a material transfer agreement (MTA) is to regulate the exchange of tangible material to be used by the recipient for internal purposes. The material exchanged can take many forms, such as biological materials, chemical compounds, prototypes or even software.

**Neighboring rights (Related rights):** protect the legal interests of certain persons and legal entities that contribute to making works available to the public or that produce subject matter which, while not qualifying as works under the copyright systems of all countries, contains sufficient creativity or technical and organizational skill to justify recognition of a copyright-like property right. Traditionally, related rights have been granted to three categories of beneficiaries: performers; producers of sound recordings (also referred to as phonograms); and broadcasting organizations.

**Patent:** a grant by the government to an inventor of the right to exclude others from making, using, or selling his or her invention.

**Patent application:** a technical document that describes in detail an invention for which a patent is sought.

**Patent examination:** a process of review of a patent application, undertaken by a patent examiner, to determine whether the application complies with all statutory requirements for patentability.

**Patent Cooperation Treaty (PCT):** An international treaty that provides a mechanism through which an applicant can file a single application that, when certain requirements have been fulfilled, may then be pursued as a regular national filing in any of the PCT member nations. Sri Lanka is a Member of this treaty.

**Patent searching:** a process carried out by the patent examiner for checking the novelty of a patent application. The subsequent patent research report lists published items comprising both patent and nonpatent literature relevant to the subject of the invention.

**Prior art:** the existing body of technological information against which an invention is judged in order to determine whether it is novel and nonobvious and can thus be patented.

**Priority date:** the date of the first filing of a patent application that describes an invention in detail. Priority date, as well as patentability, with respect to novelty of invention, is determined in light of any relevant prior art existing at the time of filing. In other words, depending on the specific jurisdiction, if the invention was known or published previous to the priority date, the applicant will be unable to obtain a patent.

**Plant breeders' rights:** plant breeder's rights are used to protect new varieties of plants by giving exclusive commercial rights to market a new variety or its reproductive material.

**Process claim:** a claim of a patent that covers the method by which an invention is performed by defining the steps to be followed. This differs from a product claim or an apparatus claim, which covers the structure of a product.

**Product-by-process claim:** a patent claim through which a product is claimed by defining the process by which it is made. The product-by-process form of claim is most often used to define new chemical compounds, since many new chemicals, drugs, and pharmaceuticals can practicably be defined only by describing the process of making them.

**Public domain:** the status of an invention, creative work, commercial symbol, or any other creation that is not protected by some form of IP right. Items that have been determined to be in the public domain are available for copying and use by anyone.

**Spin-offs:** a spin-off refers to a separate company established in order to bring to the market technology developed by a parent organisation. It is deemed to be a valuable alternative to assignment or licensing-out technology.

**Trade-Related Aspects of Intellectual Property Rights (TRIPS):** An international agreement that was initiated under the forerunner of the World Trade Organization (WTO). The TRIPS Agreement is the most comprehensive multilateral agreement on Intellectual Property covering all IP instruments. It was the first IP rights accord to legitimize the patenting of living organisms. All WTO member countries have substantive TRIPS obligations.

**Unfair competition:** commercial conduct that the law views as unjust, providing a civil claim against a person who has been injured by the conduct.

**Royalty:** income derived from the sale or use of a licensed product or process.

**UPOV (the Convention of the International Union for the Protection of New Varieties of Plants):** an international treaty that guarantees to plant breeders in member nations national treatment and a right of priority. National plant variety protection statutes of member nations are brought into harmonization with the various UPOV provisions, for example, the requirements of distinctness, uniformity, stability, and novelty for new crop varieties.

**Trademark (brand):** a trademark is a sign capable of distinguishing the goods or services produced or provided by one enterprise from those of other enterprises. (1) A word, slogan, design, picture, or other symbol used to identify and distinguish goods. (2) Any identifying symbol, including a word, design, or shape of a product or container, that qualifies for legal status as a trademark, service mark, collective mark, certification mark, trade name, or trade dress. Trademarks identify one seller's goods and distinguish them from goods sold by others.

**Trade secret:** business information that is the subject of reasonable efforts to preserve confidentiality and has value because it is not generally known in the corresponding trade. Such confidential information is protected against those who gain access to it through improper methods or by a breach of confidence. Misappropriation of a trade secret is a type of unfair competition.

**Traditional knowledge:** tradition-based creations, innovations, literary, artistic or scientific works, performances and designs originating from or associated with a particular people or territory.

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