

UTEN / GE Workshop #3
From the Laboratory to the Market Place:
Obtaining Strong Patents for Technology Transfer and
Commercialization
Tecminho – May 3-5, 2009

The University Technology Enterprise Network (UTEN) in collaboration with General Electric and the International Partnerships Program of the Science and Technology Foundation (FCT) held the third of a series of UTEN workshops scheduled throughout 2009. Workshop #3, From the Laboratory to the Market Place: Obtaining Strong Patents for Technology Transfer and Commercialization, was hosted by Tecminho, University of Minho (Guimarães), May 3-5, 2009.

The workshop focused on the necessary working knowledge from a legal perspective of important issues in the preparation and prosecution of patent applications, including patentability, patent searches, preparation of strong and enforceable patent applications, claim and specification drafting, invalidity, infringement, and licensing. It also addressed the roles of inventors and other persons involved in the creation of new technology, such as technology transfer professionals, to assure the development of the needed legal protection for a successful product.

The main topics were:

- Why a Strong Patent is Required: What Happens During Patent Litigation
- From Conception to Filing: Patentable Subject Matter and Preparation of a Strong Patent
- Hands-on Patentability Search Workshop
- From Filing to Issuance: Prosecuting a Strong Patent
- Hands-on Claim Drafting Workshop
- Case Study: Forensic Evaluation of the Prosecution of a Portuguese Patent
- Avoiding Fatal Errors While Prosecuting a Strong Patent: Inventorship, Duty of Disclosure, and Information Disclosure Statements
- Licensing Considerations When Commercializing a Strong Patent

To learn more about forthcoming and past UTEN workshops please refer to http://www.mctes.pt/archive/doc/UTEN_2.pdf .

Executive Summary of Participants' Assessments of Workshop #3

To improve future workshops, UTEN staff administered an electronic survey to solicit feedback from participants. Twenty-three of 29 potential workshop participants answered the survey. About half of the respondents were university officials in technology transfer offices or GAPIs, with smaller numbers of government officials and post-doctoral students.

Table I on the following page summarizes participants' opinions about this workshop. Three-fourths (75%) of the respondents said the sessions on the first day were extremely or quite useful and another 19% said they were useful. On the second day, more than 86% of respondents said the sessions were extremely or quite useful and nearly everyone else said they were useful. Approximately one in three (32%) of the participants said their expectations had been far exceeded or exceeded, and 68% said their expectations had been met. No one said the workshop did not meet his/her expectations. Seventy percent of those who attended were interested in attending a more advanced training session on selected workshop topics.

All of the respondents strongly agreed or agreed that the presenters were well prepared and experienced, encouraged everyone to ask questions and express their ideas, were accessible to participants during the workshop, and increased their knowledge and competencies. Nearly everyone said the presenters communicated useful information and seemed genuinely interested in teaching in the workshop.

In terms of improving their own skills, 21% of the workshop participants thought the workshop was extremely useful while 49% thought it was very useful and 26% felt it was useful.

In summary, individuals who responded to the survey about the UTEN | GE (Tecminho) workshop were very positive about all aspects of the event.

Detailed Response Information for Workshop #3

Respondents

Overall, 23 of 29 potential respondents provided information, with nearly everyone providing complete responses. About half of the respondents were university officials in technology transfer offices or GAPIs, with smaller numbers of government officials and post-doctoral students.

Almost half had 7-10 years of experience and another one-third had six or fewer years of experience. One quarter of the respondents were attorneys/lawyers by training.

Table I. Summary of Participants' Views About UTEN / GE Workshop

Please rate each of the major sessions during each day of the workshop					
	Extremely Useful	Quite Useful	Useful	Somewhat Useful	Not At All Useful
1st Day	33%	42%	19%	6%	0%
2nd Day	48%	38%	13%	1%	0%
How would you rate this workshop (compared to your expectations)?					
	Far Exceeded	Exceeded	Met	Did Not Meet	Was Very Disappointing
	5%	27%	68%	0%	0%
Would you be interested in attending a more advanced training session on the same topics?					
	Yes	Maybe	No		
	70%	30%	0%		
In terms of improving your own skills, how useful was the workshop?					
	Extremely Useful	Quite Useful	Useful	Somewhat Useful	Not At All Useful
	21%	49%	26%	4%	0%

Please indicate your level of agreement or disagreement with each of the following statements about the presenters as a group. The presenters...	Strongly Agree	Agree	Neutral	Disagree	Strongly Disagree
communicated useful information effectively.	39%	57%	4%	0	0
were well prepared and experienced.	74%	26%	0%	0	0
seemed genuinely interested in teaching in the workshop.	57%	39%	4%	0	0
encouraged everyone to ask questions, disagree, and express their ideas.	65%	35%	0%	0	0
were accessible to participants during the workshop.	61%	39%	0%	0	0
have increased my knowledge and competence in the subjects of this workshop.	41%	59%	0%	0	0

Sessions

Evaluations for sessions on both days of the workshop were very favorable. Three-fourths (75%) of the respondents said the sessions on the first day were extremely or quite useful and another 19% said they were useful. On the second day, more than 85% of respondents said the sessions were extremely or quite useful and nearly everyone else said they were useful. The four highest rated panels were: (a) Licensing Consideration When Commercializing a Strong Patent; (b) Avoiding Fatal Errors While Prosecuting a Strong Patent: Inventorship, Duty of Disclosure, and Information Disclosure Statements; (c) From Conception to Filing: Patentable Subject Matter and Preparation of a Strong Patent; and (d) From Filing to Issuance: Prosecuting a Strong Patent. The lowest rated session was the Hands-on Patentability Search Workshop.

General Characteristics of the Workshop

All or nearly all (95%) of respondents felt using cases was a good method of presenting information, the information will prove helpful in their jobs, the structure of presentations was good, the workshop provided new information, the training is something they would recommend to colleagues, and the workshop helped them to strengthen their technology transfer capabilities. About 90% of respondents thought the workshop objectives were clearly stated and the workshop was the correct length of time.

General Characteristics of Presenters

All of the respondents strongly agreed or agreed that the presenters were well prepared and experienced, encouraged everyone to ask questions and express their ideas, were accessible to participants during the workshop, and increased their knowledge and competencies. Nearly everyone said the presenters communicated useful information and seemed genuinely interested in teaching in the workshop.

Expectations, Skills, and Personal Benefits

Two questions solicited information about how the workshop might benefit individuals through skill development/enhancement. Respondents were asked to rate the workshop on a 1 to 10 scale along the following dimensions: professional value to you, value to your department/university, value to your company/organization, and educational or economic value to Portugal. Respondents were asked to provide a rating for each of the four dimensions in terms of timeframes: immediate; long-term. Uniformly the workshop was considered more valuable for the long-term than for the immediate future—on each dimension (professional value, value to your department, etc.) respondents ranked the long-term dimension higher than the immediate dimension. In terms of the four dimensions, respondents felt the workshop was most useful for its value to their departments/universities.

In terms of improving their own skills, 21% of the workshop participants thought the workshop was extremely useful while 49% thought it was very useful and 26% felt it was useful. By category of information, respondents thought the most useful information had

been presented on (a) internal procedures for protection of inventions to ensure a strong patent; (b) errors to avoid in patent drafting and patent filing; and (c) licensing (pre-production vs. post-production). The least useful information was the US patent system/IP litigation.

Most and Least Useful Aspects of Workshop/How It Could Be More Useful

Fourteen participants provided comments about the most useful aspect(s) of the workshop. There was no pattern. Seven participants provided comments about the “least useful” aspects of the workshop. Two individuals mentioned the patent search module.

Ten participants provided comments about how the workshop could have been more useful. Comments included:

Considering the complexity of the subjects treated, more length of time could had been used

Interaction and group work

More focused, more hands-on (working groups)

More practicalities about licensing

Discussing the patent system conception and how to model incentives

Perhaps a more involved exercise on writing a patent application

Future Training Sessions

Participants left the workshop with a very positive impression. Approximately one in three (32%) of the participants said their expectations had been far exceeded or exceeded, and 68% said their expectations had been met. No one said the workshop did not meet his/her expectations. Seventy percent reported that they were interested in attending a more advanced training session on selected workshop topics. All other participants said they might be interested in attending a more advanced training session.

Participants identified a variety of subjects as their priority for a future training session:

Writing and protecting stronger patents

License agreements; Claim drafting;

Licensing and claim drafting focusing on Portuguese legislation

How to finetune a patent system from an economic point of view

Determine % royalties

Other topics that respondents would like to see considered for future workshops are:

Promotion of Young Entrepreneurship, Industry/Academy relationships: how to promote it efficiently,....

Commercialization strategies

Patent Negotiation; Commercializing IP (The US perspective)

IP valuation; licensing; negotiation

Market evaluation

Early stage technology evaluation

Additional Comments About the UTEN | GE Workshop

A final question solicited other comments. Only a handful of respondents provided opinions, and most were complimentary of UTEN and the workshop. Other pertinent comments are provided below:

Deep focus / interaction and group work

Better preparation (earlier dissemination), better selection/uniformity of knowledge of participants

In addition, participants' comments are presented in the following appendix for:

- Workshop expectations
- How the workshop will benefit employers
- How the workshop will benefit Portugal

Appendix

Select Participants' Comments About Their Workshop Expectations

Participants provided the following comments in explaining how well the workshop had met their expectations. All are verbatim from the survey responses.

Positive Comments

I knew already from other participations that the quality level were high, but we could recognize here more than a couple of presentations of EXCELLENT Quality

Improved my knowledge in the area and allowed to network

It allowed [me] to increase my knowledge about US procedures for protection of inventions and the main aspects to take in consideration in order to ensure a strong patent.

As usual with UTEN workshops, speakers were very knowledgeable, professional, committed, accessible.

It was extremely diligent and useful. For me, it was the best!

Was my first time. Very useful.

Other Comment

A bit too general in some topics while too thorough on others

Select Participants' Comments About How the Workshop Will Benefit Their Employer

Positive Comments

By having increased the competences of its collaborators

Knowledge and network

Some new ideas for stronger patents

Through the application of the skills acquired by me and through the possibility of sharing the knowledge with co-workers

Better knowledge on managing patents.

Improve its capability to commercialize Portuguese technologies in US.

My feed-back may help my employer decide more soundly on what policies to pursue in matters related to IP and technology transfer

By giving me the opportunity to learn more about this issue and applying it in my job.

More knowledge

Better and stronger patents

Knowledge concerning the patenting process

Select Participants' Comments About How the Workshop Will Benefit Portugal

Positive Comments

By increasing the number of better skilled professionals

Helps Portugal to become more competitive

By adding value to the institutions the country will obviously profit

Allows building a stronger operational network in technology transfer in the country

Maybe it will improve TT from Universities to companies maximizing return on public R&D

Trained, competent TTOs can make a difference in creating economic impact out of university-based research. Likewise for people that belong to structures of governance that have to make decisions on the issues dealt with at the workshop

More efficiency to protect and license technologies and knowledge