



TT Guideline No.3 IP Portfolio Management – continuation and discontinuation of patents

RCSI DEVELOPING HEALTHCARE LEADERS WHO MAKE A DIFFERENCE WORLDWIDE

Introduction and Scope

- RCSI has an existing IP portfolio of 22 patents (at time of writing, April 2015) many of which are at national phase and going through an expensive examination process
- Most universities nationally and internationally do not continue to support patents past national phase unless a licensee/commercial partner has been identified and an agreement executed (and in this case the commercial partner covers costs)
- The purpose of this document is to provide clarity to RCSI inventors on the factors that will be involved in making a decision to continue a patent at each of the decision making steps in the patent filing process after initial filing, PCT and national phase. It will also facilitate in the short term in making decisions on the existing portfolio.
- A separate document will be prepared on IDF triage and making a decision on whether to make an initial filing
- The main factors to be considered are:
 - Technology development status
 - Availability of research funding
 - Patent viability and strength
 - Commercial potential and feedback
 - PI engagement and commitment to the commercialisation process
 - Industry engagement/commercialisation status

Technology Development Status

- A technology must be able to be developed to the point where there is sufficient data to prove the concept and interest a partner in further development of a technology within a reasonable timeframe
- Preclinical data within one year of filing is a requirement for continuation through PCT
- Time to market– market readiness and acceptance will factor into the decision as it affects the commercialisation time in the patent lifecycle



Availability of Research Funding

- Funding must be available to generate sufficient data to prove the concept and interest a partner in further development of a technology
- The existence of commercialisation funding eg EI/TIDA/Wellcome translation award based on the IP will strengthen this position
- Funding history and the availability to acquire/ requirement for additional funding will be taken into account
- Funding from commercial sources will have the highest impact
- Where IP has been entered into an industry project as BGIP feedback will be sought from them on IP continuation
- If funding is not available to develop the technology further this will negatively impact the patent continuation decision

Patent Strength

- The ability to commercialise a technology will be affected by the ability to obtain a patent with sufficiently broad and commercially relevant claims. An assessment will be performed of:
 - The search report and cited prior art
 - The nature of the claims: product vs process
 - The scope of claims and their commercial relevance
 - Freedom to operate and known barriers to commercialisation

Commercial Potential

- Factors that will be used to assess commercial potential include:
 - Competitive analysis
 - Addressable market
 - Ability to commercialise in Ireland or internationally based on type of company that might be a potential licensee or co development partner
- Feedback from industry will be sought on the following:
 - Value of technology generally to market
 - Specific feedback from companies that they might be interested in licensing/co-developing a technology
 - Data required for a licensing package
- An EI commercial case feasibility may be a good way of obtaining this information



RCSI

PI Engagement

- A PI must be engaged in supporting the commercialisation process, support necessary includes:
 - Applying for commercialisation grant funding
 - Responding in a timely fashion to patent actions
 - Providing the necessary information to help the innovation team to prepare marketing materials and identify companies of interest
 - Being available for meetings and calls with potential industry partners
- In some cases a responsive point of contact in the group for commercialisation/industry engagement may be appropriate
- A track record of this activity will be an influencing factor

Industry Engagement / Commercialisation Status

- The commercialisation status of the technology will be taken into account (examples: technology under review, company expressed interest, optioned to company)
- If the IP is entered as background to an industry project this will have a positive impact on its continuation, feedback may be sought from the industry partner.
- If an agreement has been concluded with a company to develop the technology the patent will be continued