

# EXPECTATIONS: Inventors' Participation in the Patenting and Commercialization Activities

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Source: extract from Best Practices handbook, BIC project

Active participation of the researcher-inventors is crucial for successful technology transfer – the inventors cannot just give over the research completely and have nothing to do with the subsequent protection and commercialization steps. The enthusiasm and cooperation by inventors may even be a criteria of selection for starting the patenting and commercialization activities.

In the other extreme, the researchers might be heavily involved for years with the company developing a product based on the biomarker invention. While the subvention of commercial companies by taxpayers' money (i.e., work performed at the public sector for free) is not allowable, continuing support for the optimization, troubleshooting and clinical evidence building for the new biomarker assay can be arranged in the form of paid contract research when agreed with the research team.

## Best practices:

- Although patenting and commercialization of an invention is to the major extent carried out by the organization's TTO and the external professionals appointed by the TTO, the inventors are expected to collaborate and give expert help to a reasonable extent in order to assist in protecting and commercializing the invention. The compensation paid by the university in the different steps of patent protecting and commercialization steps (as well as the share of potential future license and sales net revenues) is to cover all such endeavours so that separate fees do not need to be paid.
- The compensations paid at the different phases as well as the principle of sharing of the net income received as license or sales revenues need to be clearly specified in the organizations' guideline for inventions. The different phases of payments and the minimum sums to be paid may be in part dictated by national laws.
- The inventors' contribution to the patenting of the invention may comprise e.g.: The inventors undertake e.g. to review the documents, provide additional calculations or results (where feasible), provide argumentation for the benefits of their invention, and sign the declaration and assignment documents required by the patent authorities and agents.
- The inventors contribution to the commercialization of the invention may comprise e.g.: Participation in the scientific discussions with the industrial parties e.g. by giving presentations and reporting the results; running specimen panels provided by the companies; and active sharing of any new contact and potential partner information

with the TTO.

- The inventors need also undertake to maintain secrecy and not to give to any third party information concerning the invention while the patent protection and commercialization activities are ongoing. However, in the academia, publishing the results is typically allowed after a patent application has been filed.
- A large share of the licensees of the university-born inventions are current or former collaboration partners, emphasizing the role of the inventors in finding the best fitting commercialization partners for their inventions.
- If the university decides not to continue the protection or commercialization of the invention, the inventors may be offered the possibility to reclaim the rejected invention with terms that can be negotiated separately.