

IP Plan Workshop

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NGen and Intellectual Property

- All projects must have an IP Plan.
- Projects what Intellectual Property you foresee being generated during the project.
- Sets how you and your partners intend to manage, protect, and exploit that Intellectual Property from the project.
- NGen IP Staff are here to
 - Support applicants to develop good IP Plans
 - Provide IP Education/Guidance
 - Maintain an IP Registry
- The IP Plan is a critical component of the project and requires negotiations. Clear alignment up front will make for a strong Collaborative project.
- All approved projects will need a Collaboration Agreement.

Protecting IP and Preserving Patentability

Prior to discussions which may involve the sharing of IP with (potential) project partners, make sure that you are protected.

Background IP

- file a patent application if you haven't already
- put a non-disclosure agreement in place to protect confidential information
- trade secrets should not be shared unless absolutely necessary

Foreground IP

- inventorship determines ownership, unless defined differently in a contract. (E.g., Collaboration Agreement)

Patent/Prior Art Search

How do you know what parts of the project will likely produce new foreground IP or if the project really advances the state-of-the-art?

- conduct a prior art search
 - patents
 - literature
 - competitor/similar products
- benefits
 - avoid reinventing the wheel
 - identify freedom to operate issues early
 - find other partners
- Free patent searching tools
 - Google Patents - <https://patents.google.com/>
 - Patent Lens - <https://www.lens.org/>
 - Espacenet - <https://worldwide.espacenet.com/>

What is Intellectual Property ?

- Know how
- Trade Secrets
- Ideas
- Drawings
- Data
- Copyright
- Trademarks
- Industrial Designs
- Patents
- Confidential Information.

What needs to be in your IP Plan

- high level description of how each company handles IP
- has a freedom to operate analysis been completed?
 - Remember that FTO should likely be included in your risk register.
- a list of the Background IP each company is bringing to the project, and who in the consortium will need access to complete their part of the project
- a list of the Foreground IP you expect from the project, who will own it, and how you intend to protect it.
- how you will share or license the Foreground IP
- how each company will exploit/commercialize the IP

Step One - Ensure Project Alignment and Focus

- Market Opportunity
 - Customers
 - Competitors
 - Geographic scope
- Outline the solution/ approach
 - overall
 - by each portion/component
 - discuss and identify where you think the innovations, technical or performance advances are going to occur
- outline each consortium members role in the project
- what benefits do each of the members expect from the project
 - strategic business intentions
 - technical advances and how they intend to use going forward

Step Two -Identify IP, Ownership, and Licensing

- make a list of the Background IP relevant to the project
- Background IP ONLY needs to be shared with other project members IF it is required by another team member:
 - to carry out their role in the project, and / or
 - to exploit their foreground IP after the project

Background IP for the Project and Access WITHIN Project Consortium

No.	Background IP: pre-existing IP that helps identify the existence of the new IP to carry out the Project.	What part of the Project does it relate to?	Who is the Owner? (Lead or partner, please list full name)	What type of IP is it? (know-how, trade secret, patent pending or granted, copyright, industrial design, trademarks, etc.)	Who needs access DURING the Project? What kind of access/licenses are there?	Who needs POST Project access for commercialization or research purposes? What kind of access/licenses are there?
#1						
#2						
#3						

Step Two -Identify IP, Ownership, and Licensing

- Using the solution/approach outline from step one you now can make a list expected foreground IP
- New IP falls out naturally in the parts which are challenging or unknown
- This table is your best guess

Expected Foreground IP for the Project and Ownership and Access **WITHIN** Project Consortium

No.	Expected Foreground IP: new IP arising from the Project.	What part of the Project does it relate to?	Who is the Owner? (Lead or partner, please list full name)	What type of IP is it? (know-how, trade secret, patent pending or granted, copyright, industrial design patent, trademarks, etc.)	Is it an improvement of Background IP? And if so, which one? Is a license for that Background IP required to practice the new Foreground IP?	Who needs access DURING the Project? What kind of access/licenses are there?	Who needs POST Project access for commercialization or research purposes? What kind of access/licenses are there?
#1							
#2							
#3							

Step Three – Commercialization and Ecosystem Leverage

- define your ideal partners;
 - market development - new customers, applications, markets, geographies
 - potential suppliers and other technology partners
 - researcher development - continue to develop the technology further with other research partners
- using your ideal partner definitions and the market work from step one define types of organizations and markets which you intend to pursue and ones you do not.
- If you think it would be useful, you can review NGen member list to create a list of potential companies that foreground IP owners may be interested in negotiating licenses with.

No.	Expected Foreground IP (Copy the same IP from the above table)	Markets you intend to Commercialize in (Your key Markets. For example, Marine, Automotive, Aerospace etc.)	Countries you intend to Commercialize in your key markets (For example, North/South America, Europe etc.)	Markets you do NOT intend to Commercialize in (non-competitive markets)	Other types of or specific NGen members which would be considered for a license negotiation			Other types of or specific NGen members which would <u>NOT</u> be considered for a license negotiation (direct/indirect competitors)		
					Potential Customers	Potential Suppliers	Potential Joint Development/Research Partners	Potential Customers	Potential Suppliers	Potential Joint Development/Research Partners
#1										

Draft the Plan

- combine all the information and summarize the discussions from all three steps together into a document
- at the application stage the IP plan does not require that all license terms and details have been decided, but should include a high-level understanding and a list of items requiring resolution that will be addressed in the final IP plan should the application be approved
- the IP plan will form a basis for the collaboration agreement between consortium members

NGen IP Plan Myth – Share all IP with Project Consortium

- In order to have a truly collaborative project everyone needs to participate and achieve something at the end. It is expected that each party will have access to what they need to commercialize their new product, process, or development after the end of the project, and to continue to improve their technology beyond.
- License/access beyond the project is not expected to be royalty free.
- Collaboration agreement must have licensing terms both during and after the project.
 - *Recognition of the right of each participant access to, on fair, reasonable and non-discriminatory terms and subject to relevant competitive issues, all Foreground IP arising from the project, at least for internal R&D purposes; and,*
 - *If Background IP is required for exploitation of the results of the projects Foreground IP access, Background IP for participants must be negotiated in a fair, reasonable, and non-discriminatory terms.*

NGen IP Plan Myth – You have to share all your IP with the Global Innovation Cluster ecosystem

- Help project participants realize potential opportunities and advantages that can be created by sharing their IP, but only when it makes sense.
- Companies will not be forced to disclose sensitive information or to license to their competitors, instead the goal is to help companies find other non-competitive applications and companies to license to.
- By licensing IP you can potentially strengthen your IP by:
 - adoption of your technology across more applications and markets
 - additional revenue that can be re-invested back into your organization
 - creating partners rather than adversaries which may wish to weaken or design around your patents
 - developing relationships with companies which can lead to further joint development activities

Tips

- a [Project IP Plan Guide for Applicants](#) and a template for the [tables](#) are both available on our website in the project info and guide section
- Before getting started you can read the [NGen Intellectual Property Strategy](#) (also available in the project info and guide section)
- work with your partners to develop the Project IP Plan
- earlier the better

- NGen allows for funding for patent costs for SME's to protect the foreground IP generated by the project to be claimed as eligible expenses. See relevant [financial guide](#) for your project stream for details.
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- If you have questions, require additional information, or want to request a meeting or an additional workshop. Please email
 - ai@ngen.ca