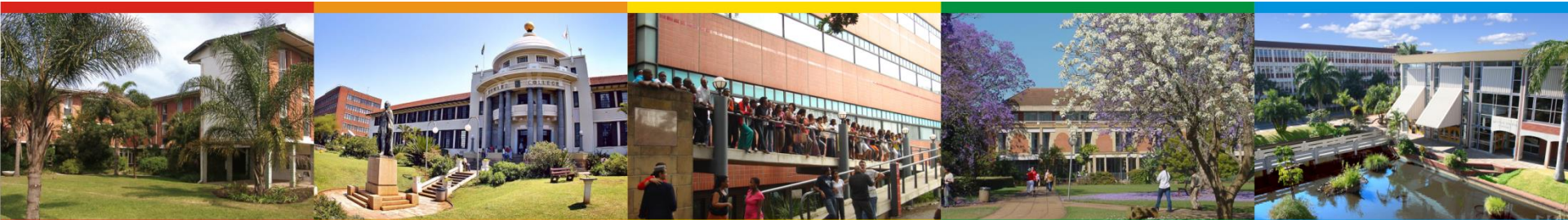




UNIVERSITY OF TM
KWAZULU-NATAL

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Protection of UKZN Intellectual Property (IP) and Negotiation of IP Clauses



EDGEWOOD CAMPUS

HOWARD COLLEGE CAMPUS

NELSON R MANDELA SCHOOL OF MEDICINE

PIETERMARITZBURG CAMPUS

WESTVILLE CAMPUS

INSPIRING GREATNESS

Introduction: UKZN InQubate

Who is UKZN InQubate?

- A portfolio under the DVC Research with two units: Research Financial Services (“RFS) and Intellectual Property and Commercialisation (‘IPC’).An Intellectual Property and Technology Transfer Office which was formed in accordance with the IPR Act.

What is the function of IPC ?

- Identify, evaluate, protecting and marketing selected intellectual property (such as inventions) as well as project management activities.
- Assist UKZN inventors by developing strategies to commercialise technologies.

NEW LAW

Intellectual Property Rights from Publicly Financed Research and Development Act No:51 of 2008 (**IPR Act**)

Came into force on 2 August 2010



Who does the IPR Act Apply to???

- All IP emanating from publicly financed research and development
AFTER August 2010

BUT

- **Excludes** – copyrighted works such as thesis, dissertation, article, handbook etc). Therefore, the UKZN IP policy will apply.

Overview of IPR Act

- Effective in RSA as of 2 August 2010.
- Object: ensure that IP from publicly financed R&D is identified, protected, utilised and commercialised for the benefit of the people of SA.
- Establishes a National Intellectual Property Management Office – NIPMO.
- Obliges statutory protection of publicly financed IP, where applicable.
- Requires acceptable commercialisation of publicly financed IP.
- Allows for state intervention where publicly financed IP is not being commercialised, adequately or at all.
- Provides for ownership of Public, Co-Owned & Privately owned IP.

What is Intellectual Property (“IP”)

- A work or invention that is the result of ***creation of the mind*** from independent thought.
- Intellectual Property includes:
 - Patents
 - Registered Designs
 - Copyright
 - Trade Marks
 - Know-how
- Intellectual Property (IP) Law protects the products of the intellect which are capable of commercial exploitation.



Disclosure, Protection, and Commercialization of IP

WHY.....?

Why Disclose your IP?

- To obtain expert and support services from IPC.
- Assessment for potential protection and/or market potential
- Commercialisation prospect
- Obligation under the IPR Act



Why Protect your IP?

- To gain protected rights and full monopoly (up to 20yrs) over commercially eligible IP.
- Rights Monopoly and Publication for knowledge and further development.
- If protectable and commercially viable, InQubate bears costs in respect thereof.
- Publication can always take place in peer reviewed journal/presentations once protection priority is secured.

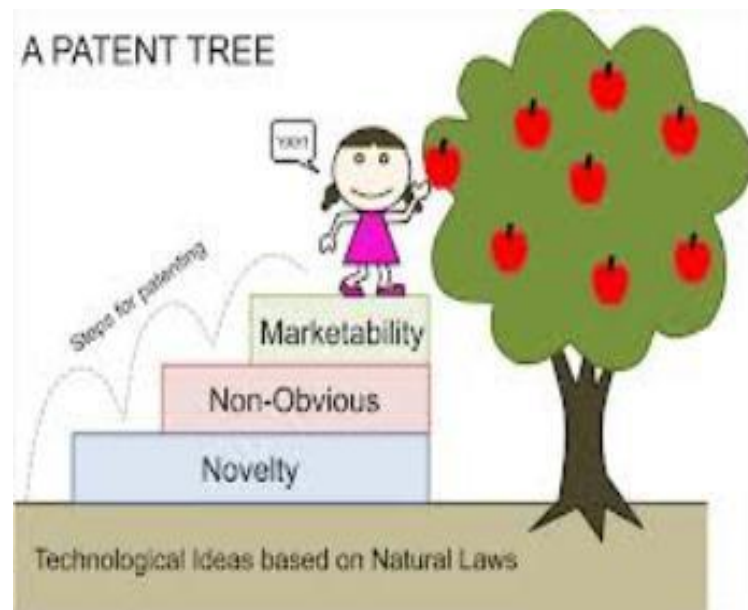
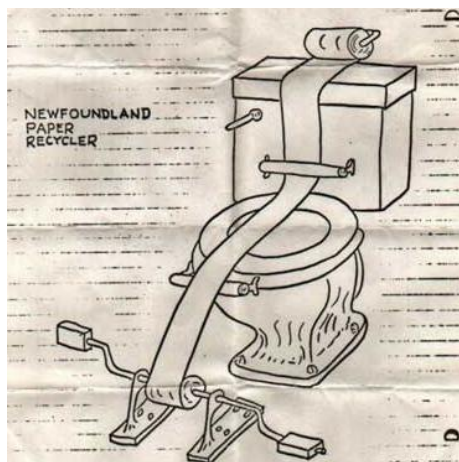
PATENTS

Patents





- Protect ideas in industrially realisable form.
- A patent can protect a new product, a new process or a new use of a product.

Requirements for protection:

- New
- Not obvious
- Capable of being applied in the trade



Patenting Procedure at UKZN InQubate

STEP	TIME	NOTE
1 Patent Search 	<ul style="list-style-type: none">• Prior art search• 2-4 weeks	All information available to the public in any form before a given date that might be relevant to a patent's claims of originality
2 Provisional Patent 	<ul style="list-style-type: none">• Initial Filing• Priority Date• 3 - 6 weeks	Establishes an early filing date, but which does not mature into an issued patent unless the applicant files a regular patent application within one year
3 File PCT application 	<ul style="list-style-type: none">• Patent Cooperation Treaty (PCT)• International searching authority• Patentability Opinion• 12 Months	PCT provides a unified procedure for filing patent applications to protect inventions in each of its contracting countries
4 Foreign Filings 	<ul style="list-style-type: none">• Target Countries• Granted Patents• 30Months	It is upto the owner of the patented invention to choose a viable form of exploitation of the patent. <ul style="list-style-type: none">• Licensing• Sale• Direct commercialisation• Do nothing (depending on your IP strategy)
5 Patent Expires	<ul style="list-style-type: none">• Annual renewal Costs• 20Years	

IP in a Product

BOTTLE CAP

Could be protected by a patent or by design rights.

FORMULATION

Protected by both patent and know-how.

BOTTLE

Protected by registered design.



GAVISCON

ADVANCE, THE LOGO AND THE COLOURS are all registered trade marks.

LABEL DESIGN AND INSTRUCTIONS

Protected by copyright.

HOW DO YOU BENEFIT

MONETARY BENEFITS

- In compliance with the IPR Act, UKZN enters into appropriate **benefit sharing agreements** with the IP Creators at UKZN.
- UKZN shall devise a fair and effective benefit sharing policy which will apply to the division of the proceeds of the exploitation of any Intellectual Property.
- Such benefit sharing may include the creator's School or College, UKZN InQubate and/or UKZN.

NON-MONETARY BENEFITS

- These benefits may accrue through the Commercialisation of Intellectual Property.
- Examples of non-monetary benefits are shares or equity in spin-off companies, receipt of free or reduced rate services or free products or equipment being received by UKZN/UKZN-InQubate.

HOW TO NEGOTIATE WITH NATIONAL AND INTERNATIONAL COLLABORATORS IN RESPECT OF IP

Main questions to be answered:

1. Who is funding the research?
2. If the other party is co-funding-to what extent? Full cost?
3. If Full Cost then the other party can own the IP.

What about IP ownership with national and international collaborators:

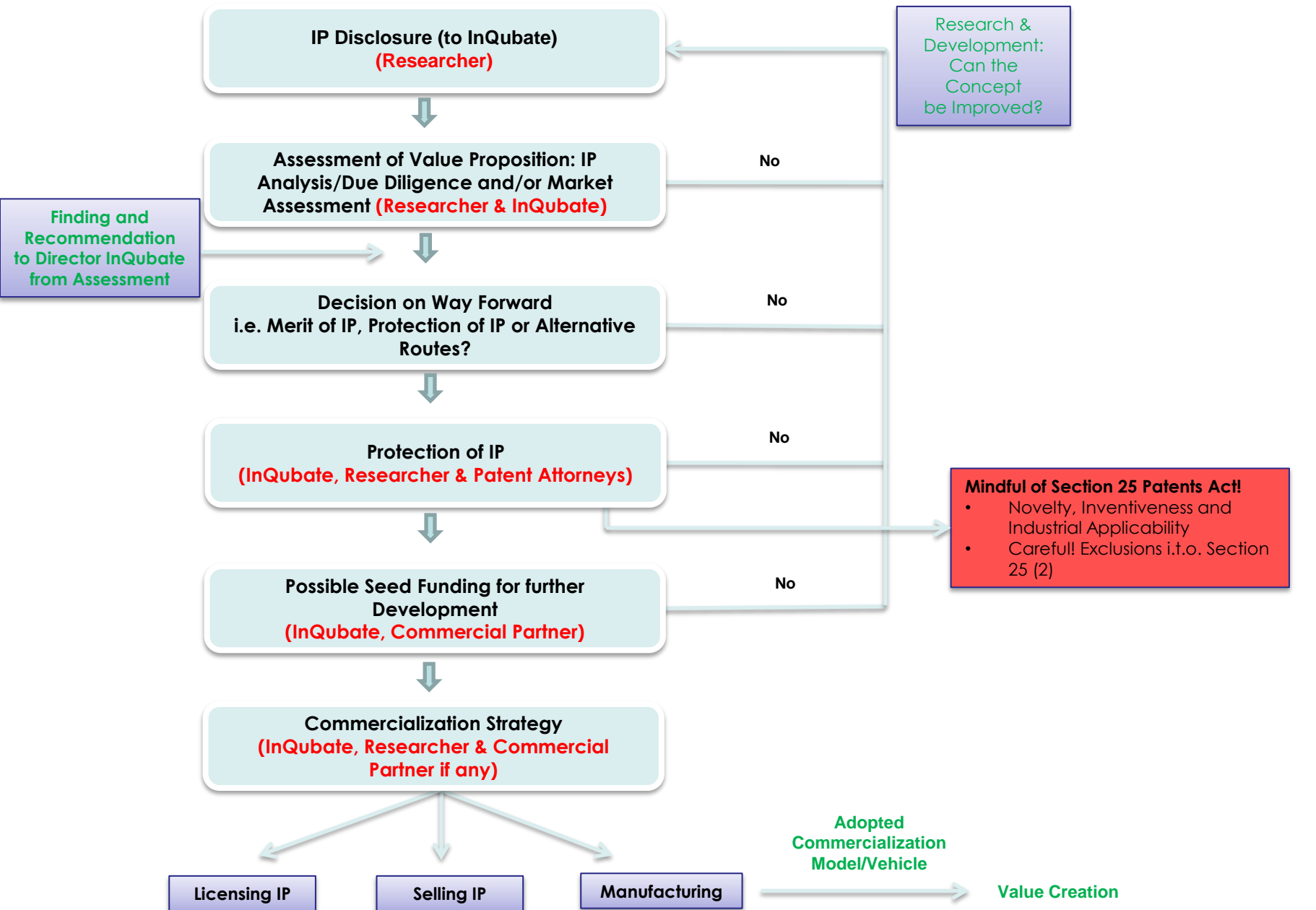
Reference to the Intellectual Property Rights from Publicly Financed Research and Development Act, 2008.

- Section 11-Conditions for IP transactions
- Section 12-Restrictions on offshore IP transactions
- Section 15-Co-operation between private entities or organisations and institutions

If you do not co-operate...what happens???

- The state has “walk in” rights to a “non-exclusive, royalty-free right to exploit the IP”;
- If approval should have been obtained for an IP transaction but was not, IP transaction and Agreements relating thereto are void from the start

UKZN InQubate-Technology Transfer Process



QUESTIONS

If you have any questions on any aspect of today's presentation, please do not hesitate to contact:

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