

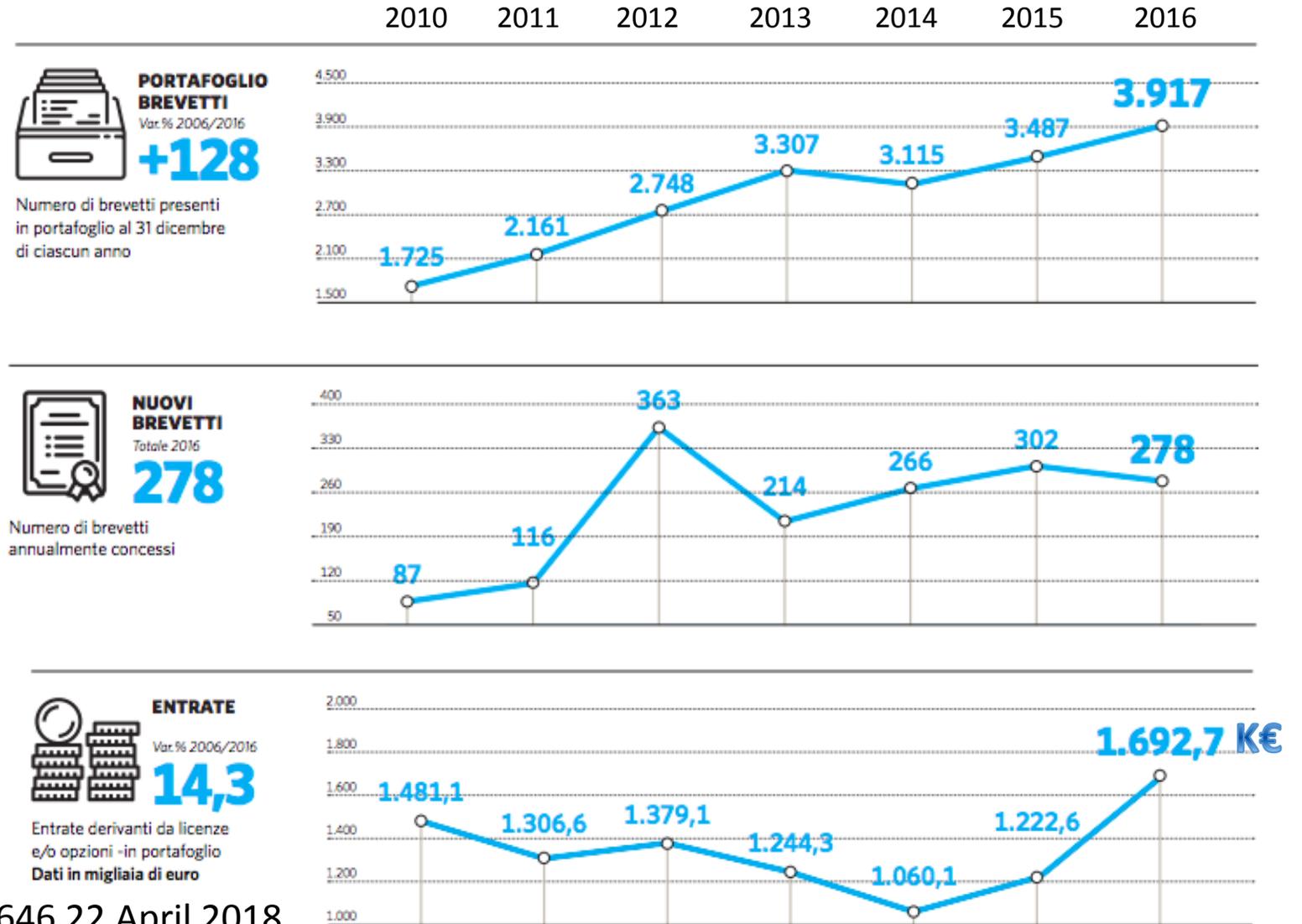
# IP strategies



**ANNALISA BALLOI, INNOVATION PROMOTER @POLIMI**

# SOME IMPORTANT DATA ON ITALIAN IP

(From Netval Survey 2018 - **NETVAL - Italian Network of Technology Transfer Offices of Universities and Public Research Organizations**)

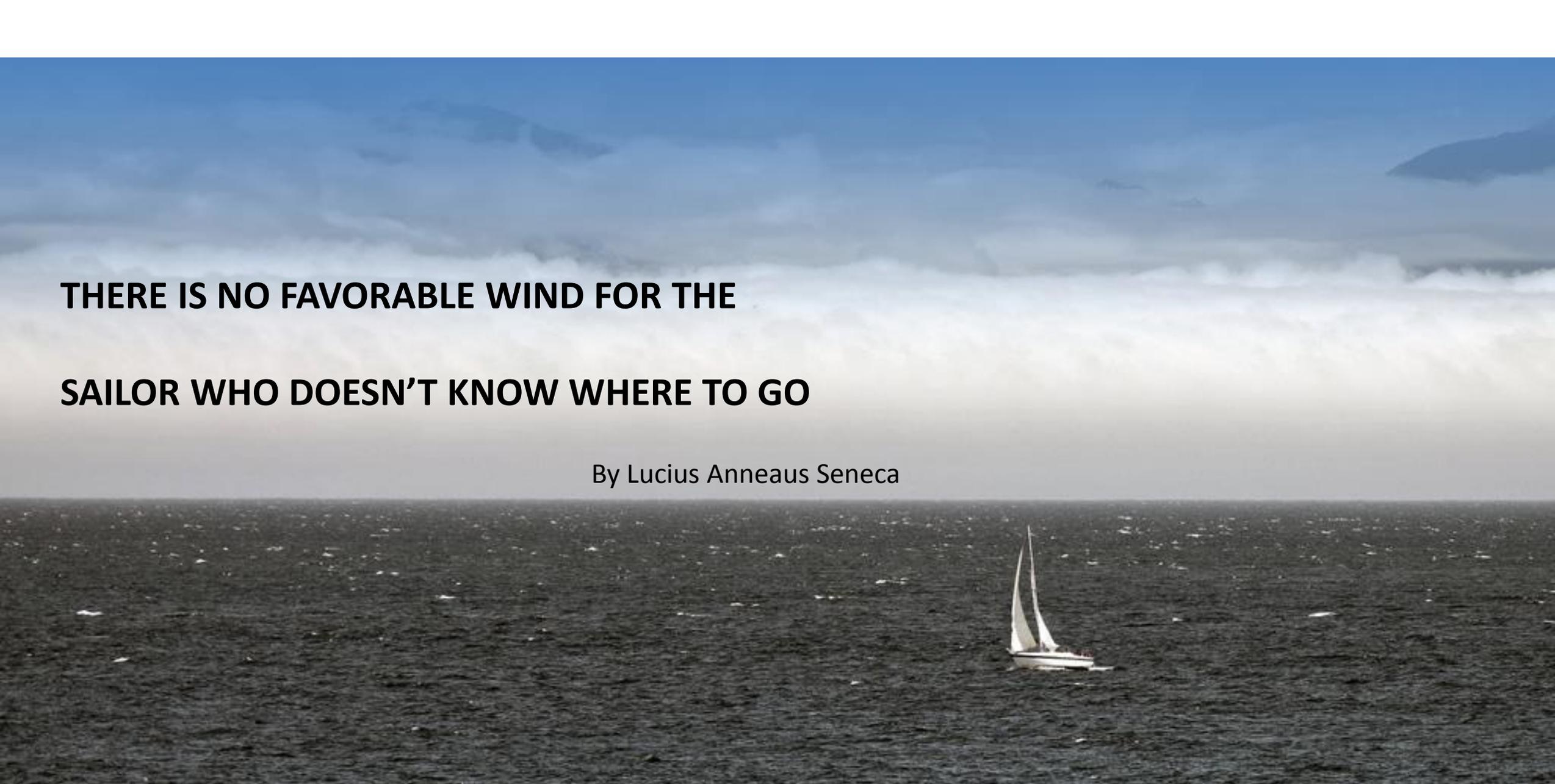


Graphs are from Il Sole 24 Ore/ Nòva24 n. 646 22 April 2018

What make the difference is

**STRATEGY**

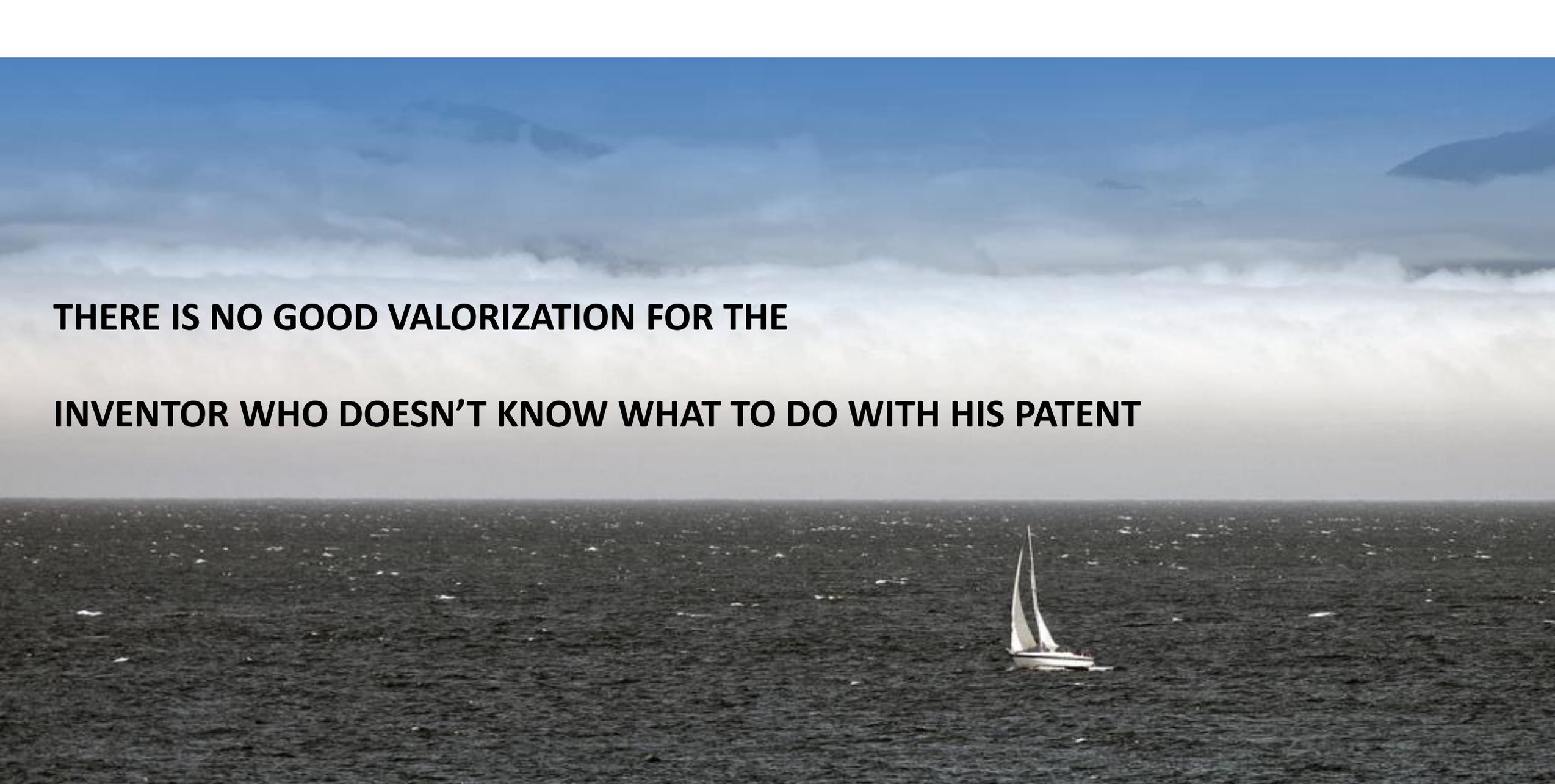




**THERE IS NO FAVORABLE WIND FOR THE  
SAILOR WHO DOESN'T KNOW WHERE TO GO**

By Lucius Anneaus Seneca





**THERE IS NO GOOD VALORIZATION FOR THE  
INVENTOR WHO DOESN'T KNOW WHAT TO DO WITH HIS PATENT**



# HOW TO BUILD A GOOD I.P. STRATEGY?

WHAT?

- CLAIMS + PRIOR ART SEARCH

WHEN?

- WHICH ARE THE RISKS IN WAITING?

WHERE?

- COMPETITORS' MARKETS AND WHERE I WANT TO PRODUCE

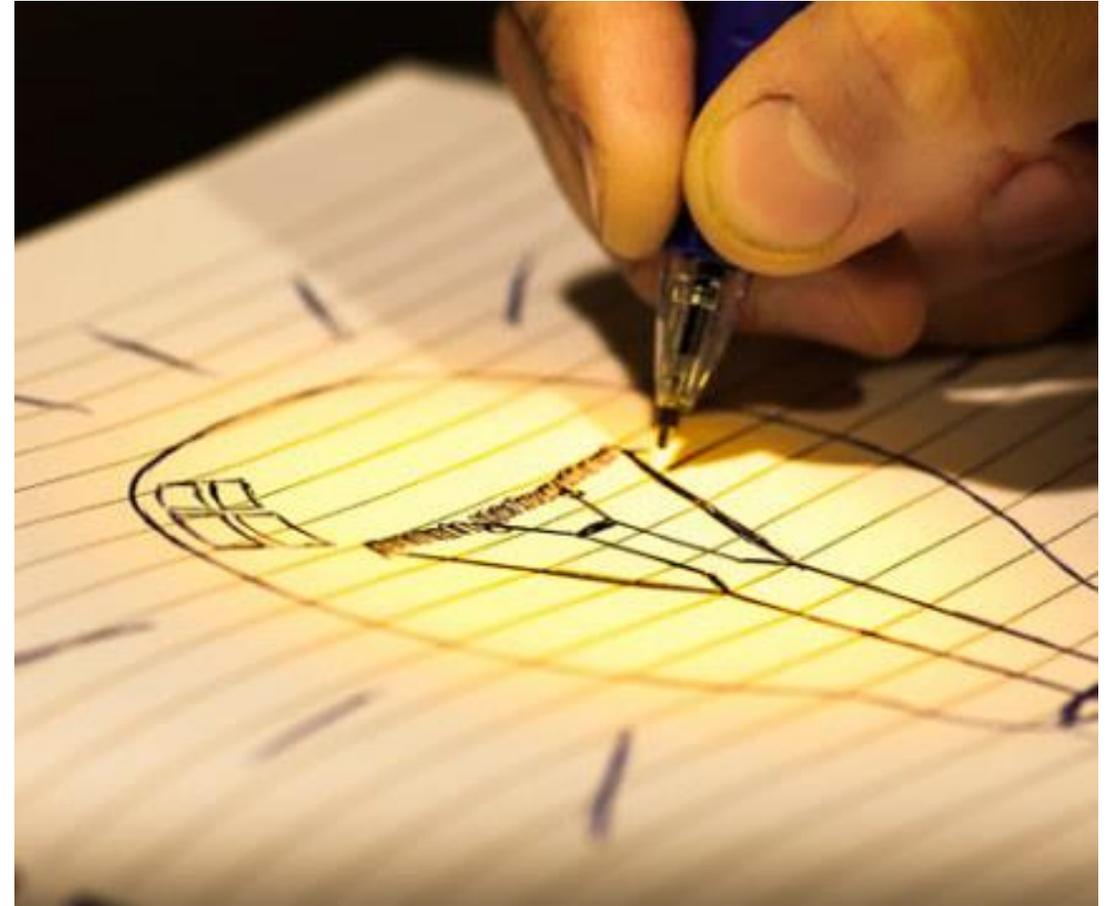
WHY?

- WHAT DO YOU WANT TO GET WITH YOUR PATENT?



# WHAT?

- Patent is a legal document: claims define your unique legal rights
- The description must be clear, but some time is better to keep secret some details
- Claims must be specific, more claims generally mean better protection, but at the same time keep them widest possible, because you cannot foreseen from the very beginning the killer application of you technology



# THE BUSINESS CASE OF GELESIS

A black and white portrait of Alessandro Sannino, a man with a beard and glasses, wearing a dark suit jacket over a white shirt. The portrait is set against a background of geometric shapes in shades of blue and grey, with a yellow outline around the man's head and shoulders.

ALESSANDRO SANNINO

**FULL PROFESSOR OF MATERIALS SCIENCE**

*University of Salento - Italy*



# GELESIS IS TRANSFORMING OBESITY TREATMENTS



Gelesis, funded 2008, in 4 years (2014-2018) has raised 90 million



# WHEN?

- File a patent application as soon as possible when waiting is a risk (before publishing)
- In some very competitive technological sectors it is important to patent very soon, while implementations in mature technologies can be patented with «calm»
- When patenting too soon, the risk is to have little experimental data to support claims
- Remember that patent is a cost: patenting too early exposes you to excessive costs before arriving at the market



# PUBLICATION

By publishing, the invention is no longer new and not patentable.

Decide not to patent and prevent others from patenting

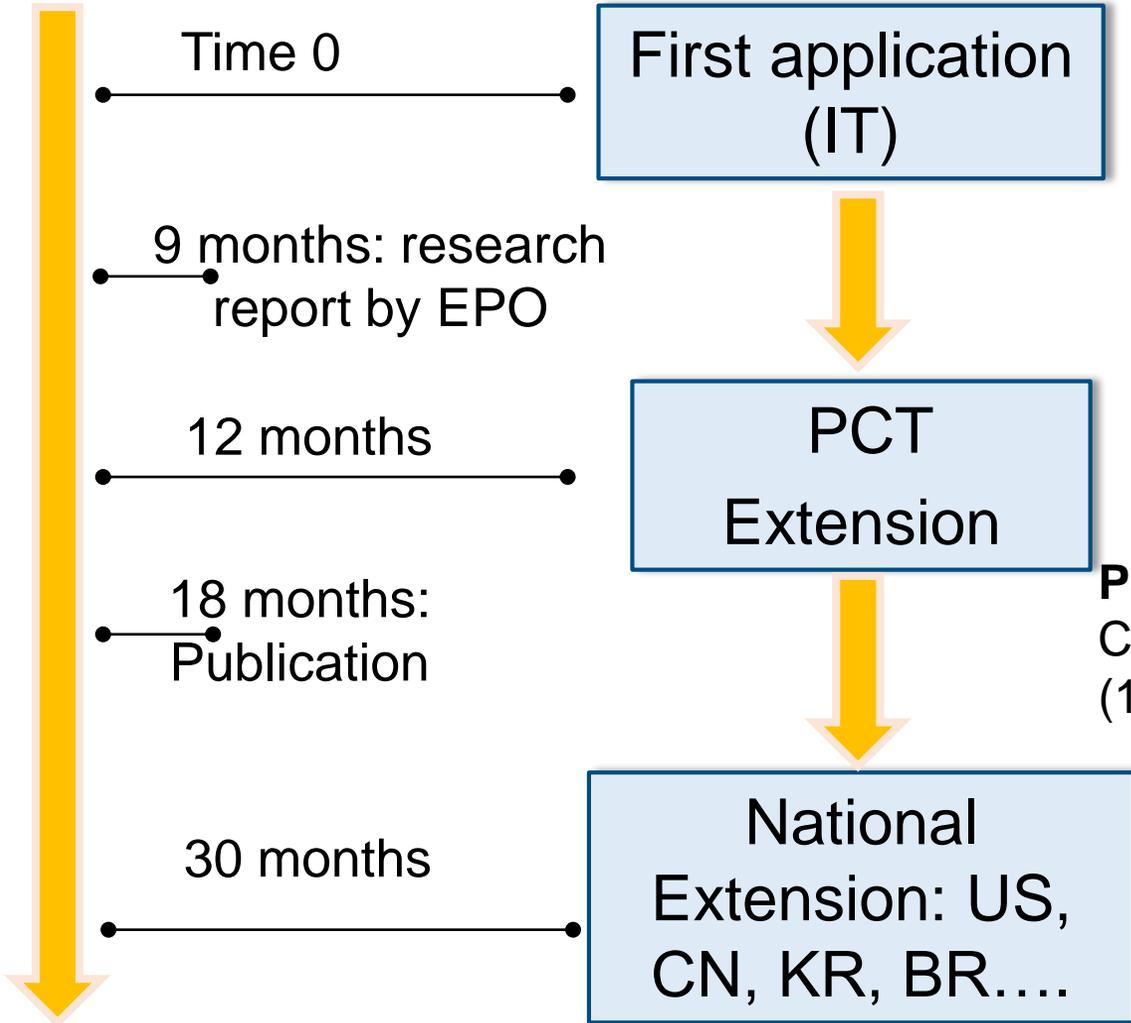


# WHERE?

- Usually the first application (priority) is filed in the country where the company has its headquarter
- In the Italian procedure, after 9 months a Research Report form is provided by EPO, with an opinion about patentability
- Then in 12 months it is possible to extend the patent application
- The extension of the patent is a balance between the need to protect the invention in all the countries relevant for the company and the budget



# Important Deadlines

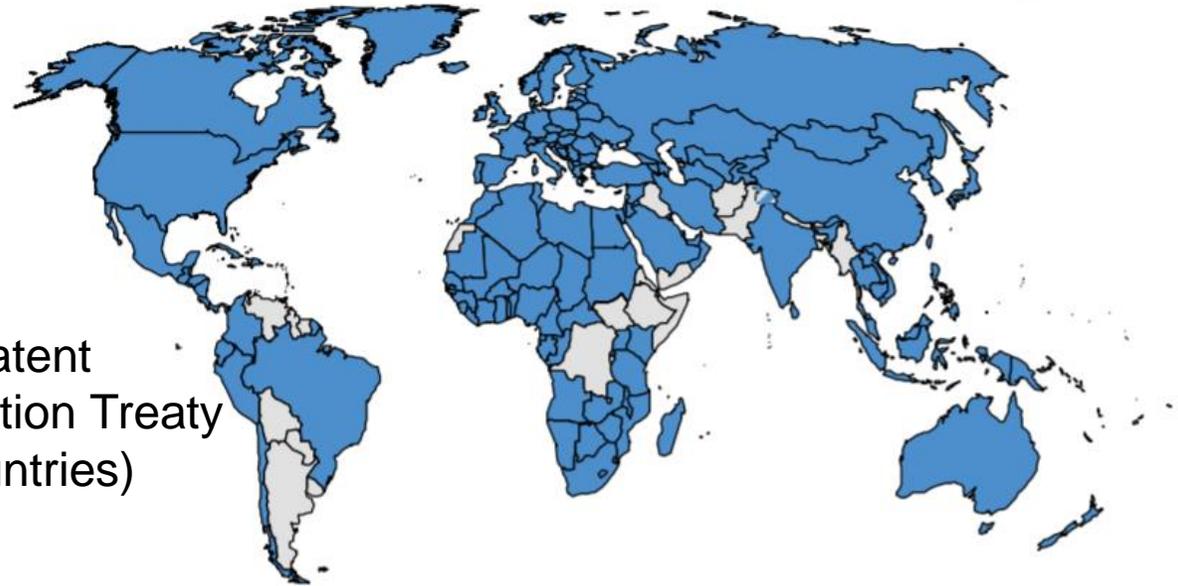


First application  
(IT)

PCT  
Extension

National  
Extension: US,  
CN, KR, BR....

PCT Contracting States and Two-letter Codes (152 on 1 June 2018)



**PCT**= Patent  
Cooperation Treaty  
(152 countries)

Or **EP**= European  
Patent (29 countries)



# WHY? WHAT DO YOU WANT TO GET WITH YOUR PATENT?

- PATENT AS A CORPORATE/LAB ASSET
- PATENT AS A DEFENCE AGAINST COMPETITORS
- PATENT AS A PRODUCT
- PATENT AS A WEAPON TO ATTACK



# PATENT AS AN ASSET

As assets they could be pledged as a collateral for a bank loan

Angel investors and Venture Capitalists are inclined to invest in companies that have a good IP portfolio

Industrial partnerships

EU projects

As scientific creditorial, for the subdivision of the Politecnico funds



# PATENT AS A DEFENCE AGAINST COMPETITORS

When you want to produce or to sell a product

But sometimes patent infringement is difficult to prove (es.: when reverse engineering is not effective)



# PATENT AS A PRODUCT

From the right to exclude necessarily follows the right to grant others the right to use it by

- Licensing
- Sell/Assignment



One-Page strategy for a possible Technology Transfer Process  
between POLIMI and a Company

**STEP 1: N.D.A.**

**Mutual:** an agreement according to which both parties exchange confidential information.

**Unilateral:** an agreement according to which only one part will disclosure confidential information.

**STEP 2: M.T.A.**

A Material transfer agreement (MTA) is a contract that governs the transfer of tangible research materials between two organizations

No

yes

**STEP 3: RESEARCH AGREEMENT**

For a co-development activities

No

yes

**STEP 4: LICENCE/ASSIGNMENT**

**EXIT**

# PATENT AS A WEAPON TO ATTACK

Patents are often used offensively to facilitate the negotiation of licensing agreements



# THE CASE OF THE SMART BENCH

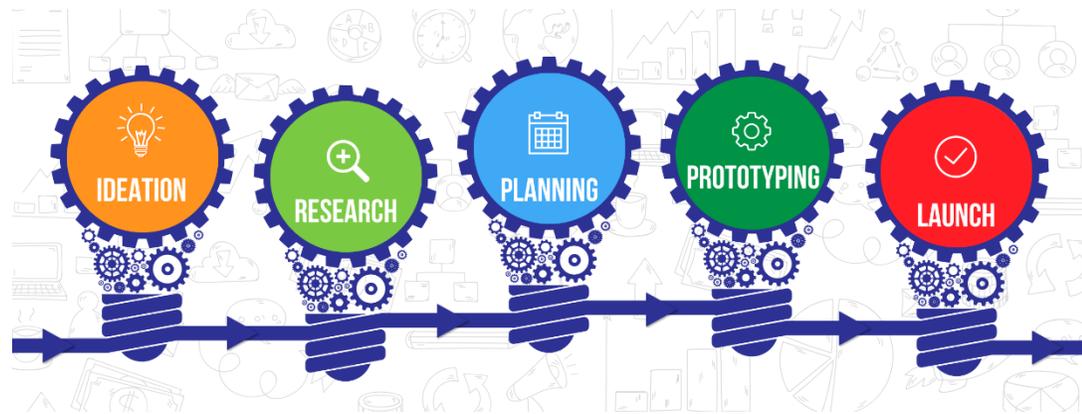
Prof. Jessica Astolfi (Dep. Architecture)



# CONCLUSIONS

## INVENTION IS NOT THE SAME AS INNOVATION

IP RIGHTS CAN BE USED STRATEGICALLY TO FACILITATE THE DEVELOPMENT OF THE INVENTION INTO INNOVATION BY:



- PROVIDING ACCESS TO FINANCING
- PROVIDING ACCESS TO TECHNICAL FACILITIES
- PROVIDING TO BUSINESS PARTNERS
- PROVIDING A STRONG NEGOTIATION POSITION
  
- **PROVIDING AN OPPORTUNITY TO VALORIZE YOUR KNOWLEDGE**

# FLASH of GENIUS

The story of Robert Kearns and his legal battle against the Ford Motor Company when they developed an intermittent windshield wiper based on ideas the inventor had patented.

The jury awards him US\$10.1 million. The closing credits indicate that Robert later wins an US\$18.7 million judgement from Chrysler Corporation as well.





**POLITECNICO**  
MILANO 1863

## Contacts:

**ANNALISA BALLOI, PhD**

Phone: +39 02 2399 9246

email: [annalisa.balloi@polimi.it](mailto:annalisa.balloi@polimi.it)

[info.tto@polimi.it](mailto:info.tto@polimi.it)

Politecnico di Milano - Piazza Leonardo da Vinci 32, 20133 Milano

Website: <http://www.polimi.it/ricerca-scientifica/brevetti/>