

Contribution of Centre for Technology Transfer and Innovation to Technology Transfer at Jožef Stefan Institute and in Slovenia



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Contribution of Centre for Technology Transfer and Innovation to Technology Transfer at Jožef Stefan Institute and in Slovenia

- **Systems for support for technology transfer in Slovenia (in summary),**
- Organisation of support for technology/knowledge transfer at JSI, departments, employees, processes, activities and services related to technology transfer, handling and assistance in development of proof of concepts and prototypes, funding of inventions, commercialisation, collaboration with external institutions,
- **Strengths and weaknesses of the CTT at JSI and how we tackle the weaknesses, future plans for CTT at JSI,**
- A recent major success achieved by the CTT at IJS in providing its technology transfer services (in summary), important and crucial points.

IP Commercialization System in Slovenia – Acts and Regulations

Intellectual property legislative system in Slovenia is in general relatively well structured and is quite similar to comparative systems in the group of most developed EU countries

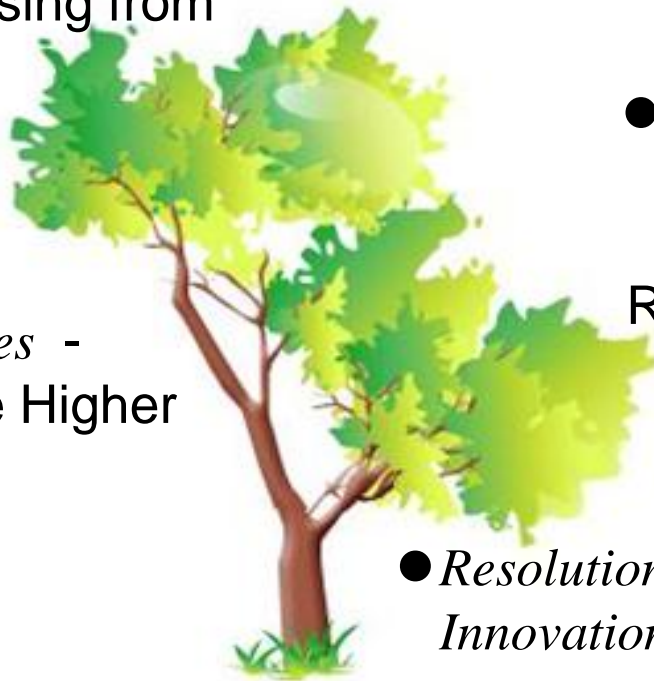
- Industrial Property Act

Slovenian Intellectual Property Office

- Act on Inventions Arising from Employment

Employees

- *Public research institutes* - Institutes Act and The Higher Education Act



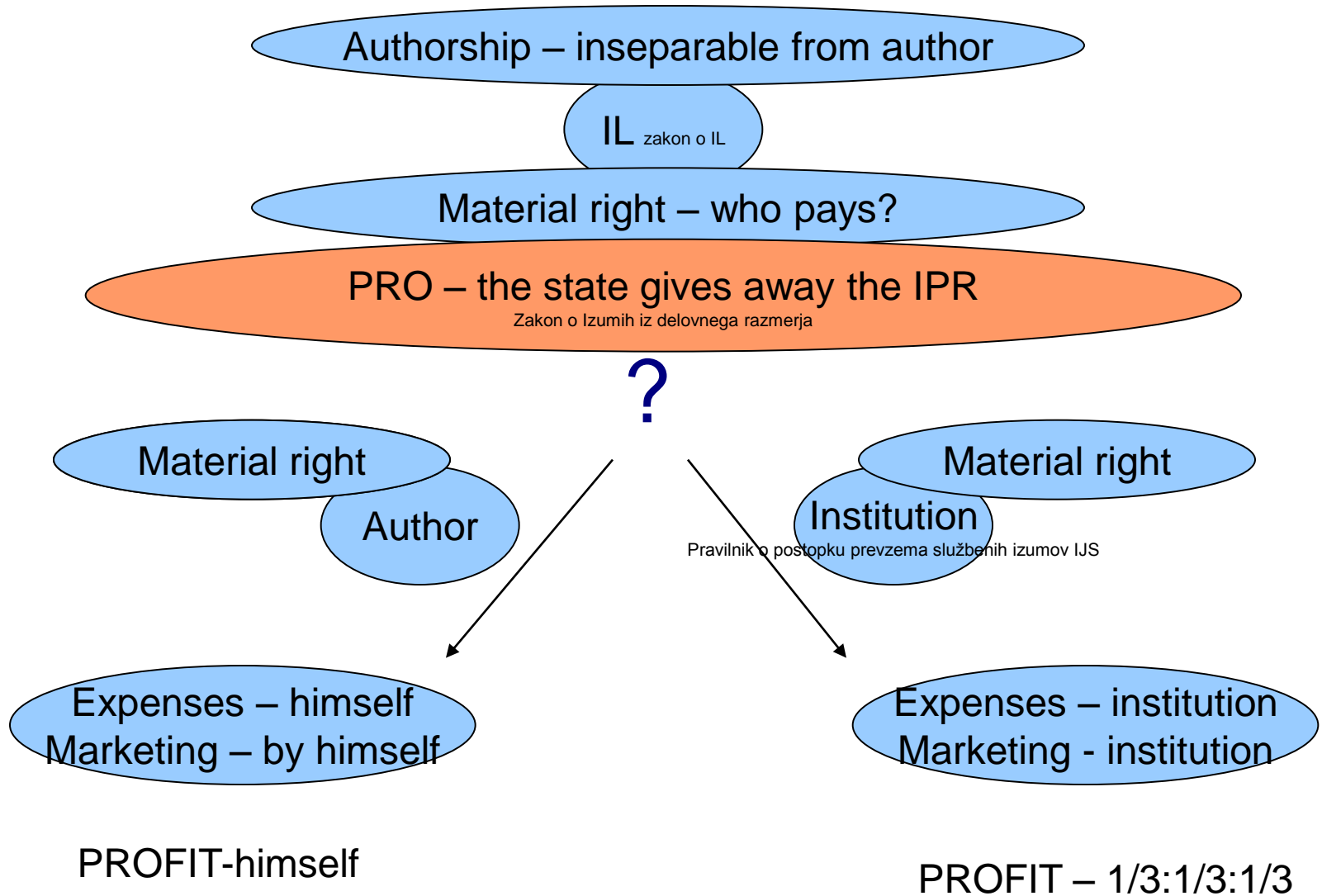
- Supportive Environment for Entrepreneurship Act and

Record on Keeping Rules on the Innovative Environment

- *Resolution on Research and Innovation Strategy 2011-2020*

IP in PRO

Zakon o visokem solstvu, zakon o javnih zavodihL



Evaluation of R&D

Slovenian criteria: MVZT (2009), following AUTM, ASTP

	FIELD
A.1	Financing
A.2	Research excellence
B.1	Invention disclosures
B.2	Patents
C.1	Contract research
C.2	Collaborative research
C.3	Licensing
C.4	Spin-offing

WHAT IS
INNOVATION
COMMERCIALIZA
TION?

↓
**Added value for (home)
economy**

Motivation:

- **Efficient public research financing**
- **Financial benefit for inventor and institution: 1/3:1/3:1/3**
- **Human resources flow through spin-outs**

Systems for support for technology transfer in Slovenia (in summary),

Governmental:



Intellectual Property Office:



Associations:



TTOs:



NIC



NIB



JSI



UL



UM



UP

Strengths and weaknesses of the CTT at JSI and how we tackle the weaknesses, future plans for CTT at JSI,

Governmental:

- lacking knowledge about the importance of TTOs
- occasional financing of TTO activities

Intellectual Property Office:

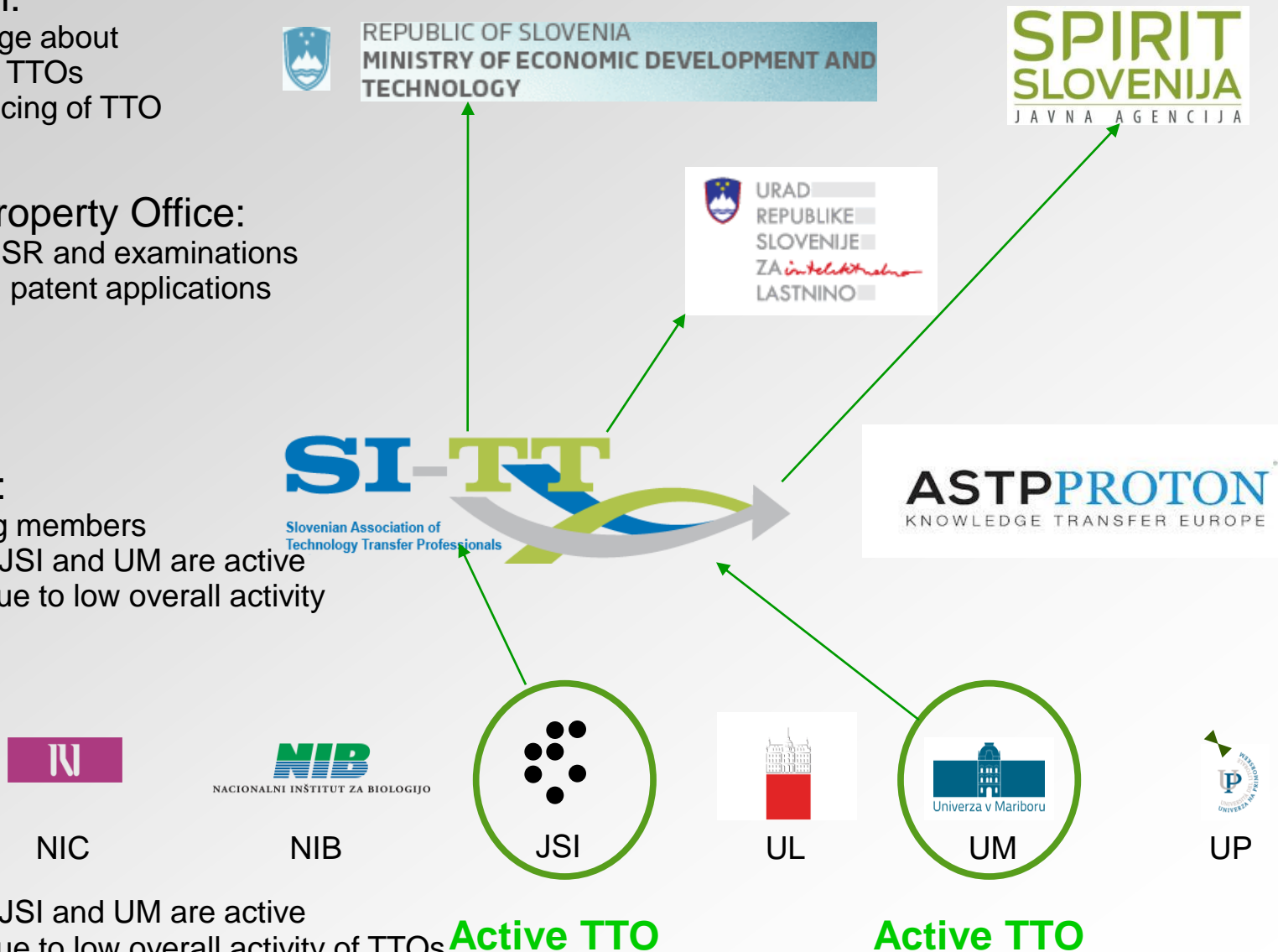
- not performing ISR and examinations
- low quality of SI patent applications

Associations:

- a lot of sleeping members
- members from JSI and UM are active
- low influence due to low overall activity

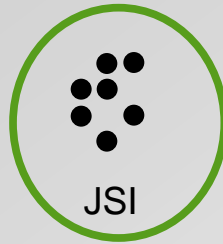
TTOs:

- members from JSI and UM are active
- low influence due to low overall activity of TTOs



Active TTO

Active TTO



Active TTO
The biggest TTO
The most successful TTO

WEAKNESS:
Unstable governmental financing

No funds for
IP protection

Expired
patents

Unstable
jobs

Deadlines
overlooked

Commercialization
not consistent with
the plan

How we tackle the weakness internally at JSI?

In 2014 CTT's work was financed by government. Due to good results achieved in 2014, JSI's director decided to open a special director's fund at JSI dedicated to CTT's activities.

Slovenian KTOs

- 7 KTOs
- Slovenian KTOs are comparable to EU KTOs by size, but not always by:
 - Organizational structure
 - Competences

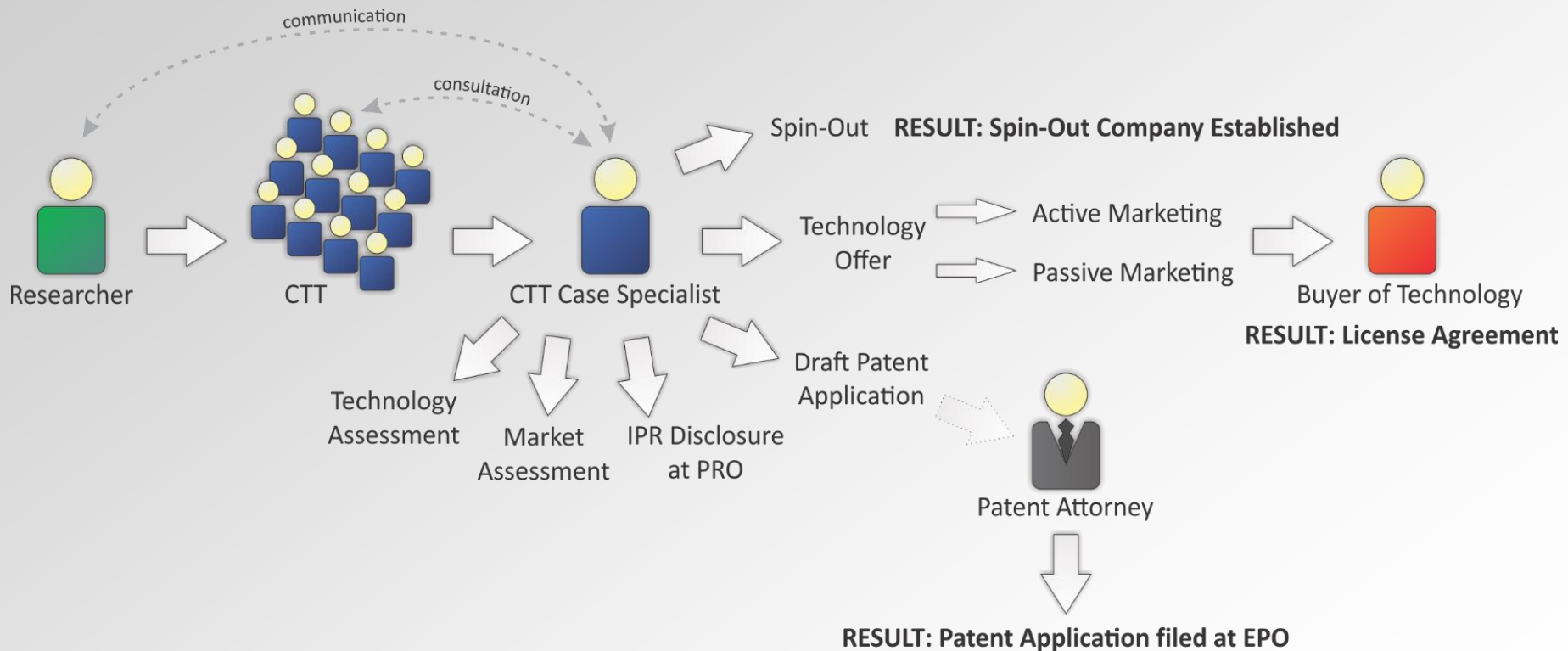
The educational structure of the licencing staff at KTOs	
Licencing staff:	Education
JSI	2X PhD Biotechnology
	1 X PhD Chemistry
	1 X Bsc Chemistry
	1 X Msc ICT
	1 X PhD Physics
	1 X Bsc Law
NIC	1 X Bsc Law
NIB	1 X Msc. Economics
UL	1 X PhD Electrotechnics
UM	1 X PhD Electrotechnics
	2 X Bsc. Economics
	1 X Bsc law
UP	1 X Bsc law

INSTITUTION	LICENCING STAFF	CCR STAFF	ALL STAFF
Jozef Stefan Institute (JSI)	7	4	13
National Institute of Chemistry (NIC)	1	0	1
National Institute of Biology (NIB)	1	0	2
University of Ljubljana (UL)	1	0	2
University of Maribor (UM)	4	0	4
University of Primorska (UP)	1	2	8
University of Nova Gorica (UNG)	0	0	1

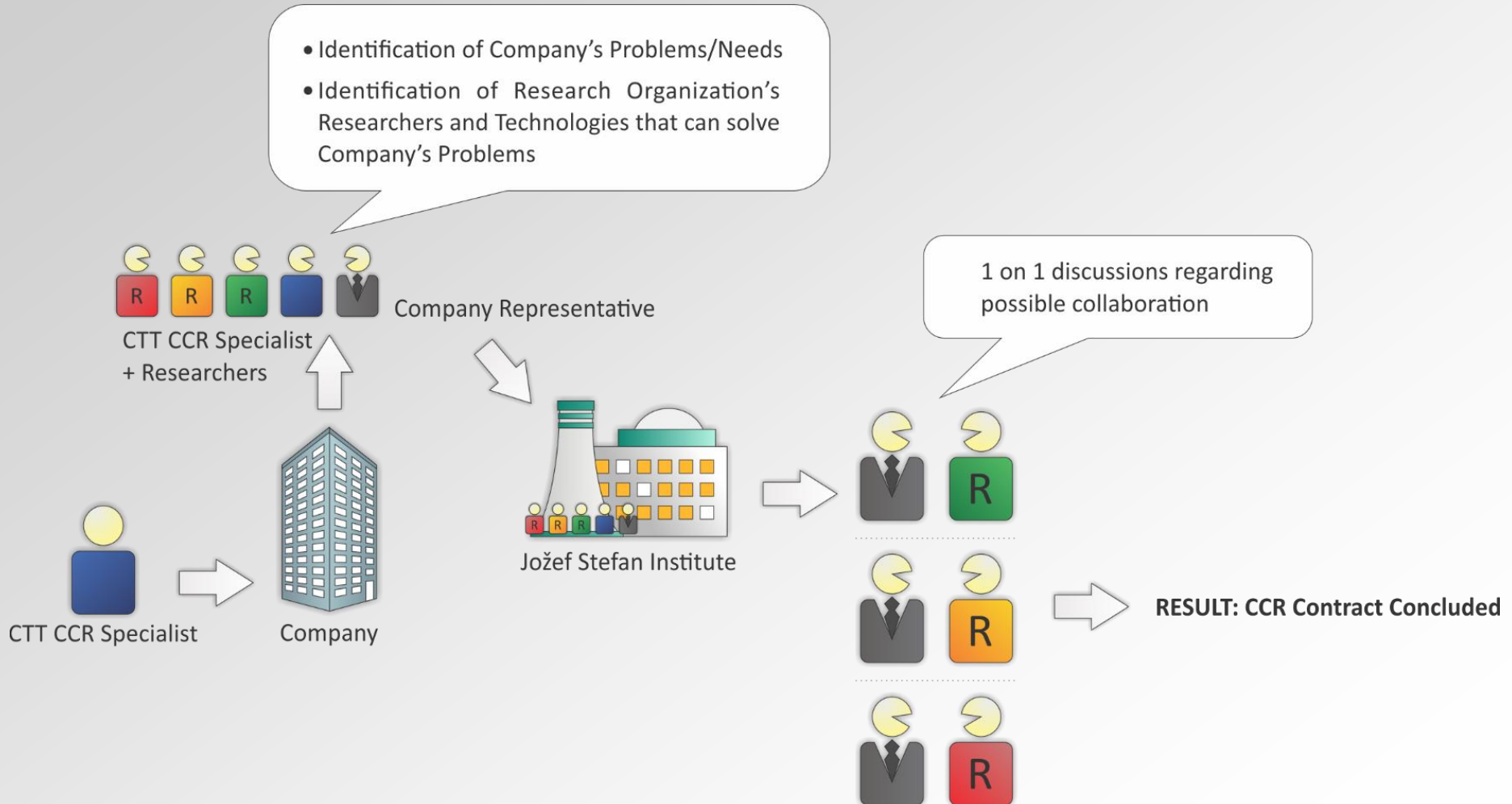
JSI's CTT:

- the biggest KTO in Slovenia
- having the widest range of experts at different fields of technologies
- having natural science Ph.Ds active in licencing field

Knowledge Transfer Workflow at CTT



CCR Workflow at CTT



Who constitutes the competent body in our institution to make the final decision on commercialisation (e.g. Head of CTT, committee at CTT, Dean/Chancellor of faculty/university, faculty/university board, etc.).

- **Decision making at JSI for commercialization of IP:**
 - CTT prepares plan for commercialization
 - Inventor agrees with the plan
 - Head of inventor's department approves the plan
 - Director of JSI supports CTT's actions, if they are approved by the department heads
- The competent body is actually the Head of department, since each department is financially independent and responsible for the consequence of its financial decisions

Success Story

Draft licence agreement

- The draft agreement was prepared by CTT;
- CTT Technology manager (case specialist) prepared the terms;
- CTT IP law expert incorporated the terms into the agreement;
- Foreign Company had only minor comments regarding the content of the agreement.

Success Story

Contact Details - Basics

- The purpose of the agreement was establishing the rights and obligations of the parties regarding the development, use and commercialization of know-how
- Partner was granted the license to:

use
the know-how

grant sublicenses
to any third party
to use the
know-how

market the products
based on the use
of know-how

- The granted license was:

non-exclusive
JSI withheld the
right to transfer
the know-how to
any third party

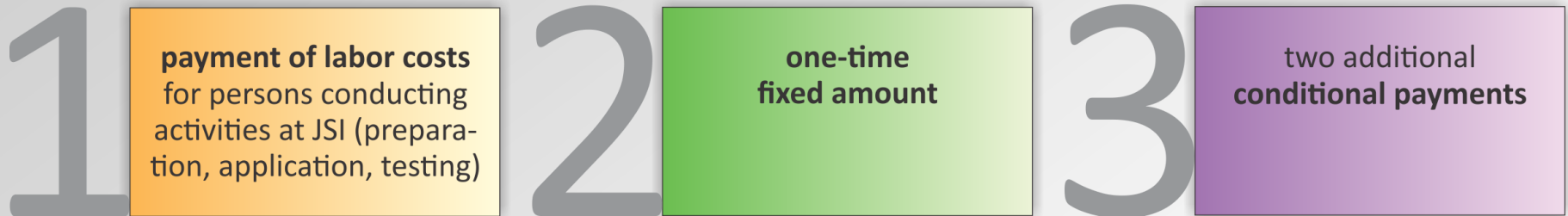
**geographically
limited**

limited in scope
of applicable areas

Success Story

Contact Details - Compensation

- Agreed compensation consisted of three components:



- The first conditional payment depended on the results of certain tests, carried out regarding materials processed on the basis of know-how – in case of positive test results, the payment would become due.
- The second conditional payment would become due in case partner filed a regulatory approval application for production of sellable products based on the use of know-how to the competent authority.

Success Story

Contact Details – Intellectual Property

- Parties agreed that the ownership of any patents and other intellectual property rights resulting from the collaboration of the parties shall be distributed between the parties in a **50% : 50% ratio**.



Was it worth it?

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THANK YOU!

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