European
IPR Helpdesk

www.iprhelpdesk.eu

European IPR Helpdesk

Case Study

Acting wisely in collaborative research projects

December 2017

Project Details:

Department of General Biophysics, University of Łódź

http://www.biol.uni.lodz.pl/en/content/department-general-biophysics

WYDZIAŁ BIOLOGII
i OCHRONY ŚRODOWISKA
Uniwersytet Łódzki

Background

The Department of General Biophysics at the University of Łódź has been studying polymers called dendrimers for over 17 years. Dendrimers possess unique properties making them promising materials for biomedical applications such as in cancer and HIV treatment.

In 2014, a member of this Department was conducting research at the Clinic of Infertility Treatment GRAVITA, within the Innovation Assistant Project[1]. The main aim of the research was to analyse the dependence of sperm plasma membrane charge and sperm quality measured using routine methods.

Problem faced

During the duration of the project, it was discovered that a special technique ("Zeta technique") could be considered a promising method in sperm selection, yet the analyser used in this technique is very costly and it seems unlikely that many clinics of infertility treatment would be in possession of such equipment. Therefore, to solve this problem, a need to design an inexpensive and relatively simple apparatus capable of analysing semen samples has arisen.

[1] The Innovation Assistant Project was conducted by the Foundation for Promotion of Entrepreneurship (FPE), Łódź, under Structural Funds, Operational Programme Innovative Economy.

The development of the research project that resulted in development of the above-described apparatus required setting up a collaboration between the Department of General Biophysics of the University of Łódź and the Clinic of Infertility Treatment GRAVITA.

In order to set up such a collaboration, both partners had to enter into a contract and agree on issues related to intellectual property rights (IPR), such as access to background, ownership of the research results as well as entering into a non-disclosure agreement (NDA) and determining its terms and conditions.

Actions undertaken

In 2015-2016, the Enterprise Europe Network[2] centre at the Foundation for Promotion of Entrepreneurship (FPE) supported the Department of General Biophysics in the research development by fostering collaboration between the two parties, facilitation of the preparation of the contract and negotiations between the parties.

In 2016-2017, the method of evaluation of sperm quality was designed in the Department of General Biophysics. Currently, the research team is working on the design of an inexpensive apparatus capable of analysing semen samples to tackle the issue of the high cost of the previous analyser.

Outcome

The method of evaluation of sperm quality based on the Zeta technique became the subject matter of a patent application submitted to the Polish Patent Office in 2016.

Moreover, the method of sperm quality evaluation was described in the manuscript entitled "Perspectives to use zeta potential technique to analyse the semen quality" and sent for publication. The issue of timing related to publishing information included in a patent application was discussed at numerous occasions in order to make sure the patent application is not negatively influenced. It is because a disclosure of the invention that takes place before the patent application may harm the "novelty" of the invention and may prevent the acquisition of a patent.

In 2017, the Department of General Biophysics applied to the Polish Programme *Innovation Incubator* to obtain financial support for the construction of a prototype. The Enterprise Europe Network also helped the project team in commercialising the research results by finding partner companies.

[2] For more information about Enterprise Europe Network and to find your local contact point, please click here.

Once the method had been secured through a patent application, the team began working on the design of the apparatus. Subsequently, a decision to apply for an industrial design was made in order to maximise the benefits from the commercialisation of the invention.

Lessons learned and suggestions

When research teams are working on new developments, it is important that they manage their relationships using a certain contractual framework, especially regarding confidentiality clauses, contributions of each party, access rights to the results of the project and IPR of all the parties. This is particularly important if the teams comprise members from different institutions, as each institution might have different rules regarding ownership or treatment of research results. In order to avoid disputes and therefore hindering the research process, it is recommended to agree on those issues in advance, before commencing research activities.

Secondly, when disclosing research results, attention should be paid to the possibility of IPR loss. Namely, novelty is one of the requirements for an invention to be patentable. If an invention is made public, e.g. in a scientific publication or at a fair, before a patent application is filed, it might be rejected due to a lack of novelty, as this disclosure becomes a part of the prior-art. Therefore, it is important to take care to secure the rights before presenting the invention to the public. In this regard, it can also be helpful to sign an NDA to better control the spread of information[3].

Thirdly, an invention can comprise numerous IPRs, such as a patent for the invention itself, design of the aesthetical appearance of the invention, trade mark for the brand of the product, etc. All those IPR aspects should be considered before taking any steps towards commercialisation. Note that in order to obtain design protection, the design (similarly to patent) has to be novel. Therefore, it is important to pay attention to what is revealed in the patent application, and if the patent application contains any sketches or drawings that could be used in the design application. Revealing those drawings in the patent application might prevent the acquisition of design protection due to the non-novel character of the design itself.

Lastly, researchers may face barriers and problems when trying to establish cooperation with the business sector. Using advisory services in this area, such as those provided by the Enterprise Europe Network for finding international partners or those provided by the European IPR Helpdesk for IP related issues can contribute to the success of the project.

[3] For further information about NDAs please consult the European IPR Helpdesk fact sheet "Non-disclosure agreement: a business tool".

GET IN TOUCH

For comments, suggestions or further information, please contact

European IPR Helpdesk
c/o infeurope S.A.
62, rue Charles Martel
L-2134, Luxembourg

Email: service@iprhelpdesk.eu

Phone: +352 25 22 33 - 333

Fax: +352 25 22 33 – 334

©istockphoto.com/Dave White

ABOUT THE EUROPEAN IPR HELPDESK

The European IPR Helpdesk aims at raising awareness of Intellectual Property (IP) and Intellectual Property Rights (IPR) by providing information, direct advice and training on IP and IPR matters to current and potential participants of EU funded projects. In addition, the European IPR Helpdesk provides IP support to EU SMEs negotiating or concluding transnational partnership agreements, especially through the Enterprise Europe Network. All services provided are free of charge.

Helpline: The Helpline service answers your IP queries within three working days. Please contact us via registration on our website – www.iprhelpdesk.eu – phone or fax.

Website: On our website you can find extensive information and helpful documents on different aspects of IPR and IP management, especially with regard to specific IP questions in the context of EU funded programmes.

Newsletter and Bulletin: Keep track of the latest news on IP and read expert articles and case studies by subscribing to our email newsletter and Bulletin.

Training: We have designed a training catalogue consisting of nine different modules. If you are interested in planning a session with us, simply send us an email at training@iprhelpdesk.eu.

DISCLAIMER

The European IPR Helpdesk project receives funding from the European Union's Horizon 2020 research and innovation programme under Grant Agreement No 641474. It is managed by the European Commission's Executive Agency for Small and Medium-sized Enterprises (EASME), with policy guidance provided by the European Commission's Internal Market, Industry, Entrepreneurship and SMEs Directorate-General.

Even though this Case Study has been developed with the financial support of the EU, its content is not and shall not be considered as the official position of the EASME or the European Commission. Neither EASME nor the European Commission nor any person acting on behalf of EASME or of the European Commission is responsible for the use which might be made of this content.

Although the European IPR Helpdesk endeavours to deliver a high-level service, no guarantee can be given on the correctness or completeness of the content of this Case Study and the European IPR Helpdesk consortium members are not responsible and may not be held accountable for any use which might be made of this content.

The support provided by the European IPR Helpdesk should not be considered as of a legal or advisory nature.

© European Union (2017)