

## BRIEF PATENTING STEPS EXPLANATIONS

The mission of PACTT is to enable the Institutions' research results to reach the market for the benefit of society.

PACTT kindly asks you to carefully read the following explanations in order to optimize the evaluation and the future licensing of your invention.

### A. The IDF and the evaluation of the invention

- The IDF provides PACTT with all information necessary to evaluate whether your invention is patentable. The evaluation can take up to 1 month.
- For an optimal evaluation of the invention, the IDF should be filled in as accurately as possible with all the details that are available to you at the present time.
- In particular, please provide details on:
  - what is the matter of your invention
  - previous or planned public disclosures of the invention, in part or whole, by you or members of your laboratory (please provide drafts of any publications and talks in preparation)
  - publications on the same matter of the invention
  - all contributors to the invention : names, addresses, % of inventive contribution which should be decided among the potential inventors
  - third party rights : possible sponsoring by funds received through a contract that could limit the intellectual property rights to the results
  - commercial potential of your invention and potential industrial partners
- An evaluation of your invention will be conducted by a PACTT representative with the possible support of a patent agent. Your invention will be analyzed in terms of
  - a) any prior art that could destroy the novelty of the invention and hence render the invention not patentable;
  - b) the aspects of the invention that are novel and inventive and can justify a patent application with reasonable chances to be granted;
  - c) the possible industrial application of your invention, which is also a legal requirement for patentability;
  - d) the commercial potential of your technology that will justify the investments incurred for patenting.

### B. Writing the priority patent application

- If there is a positive evaluation of your invention, PACTT will engage the filing procedure.

- The patent agent will then be in charge of drafting the text so that it offers maximal protection to your invention. At this time, the inventors are expected to cooperate extensively with the patent agent by providing information, text and figures and improving the draft of the patent application. The time needed depends on the complexity of your invention, its state of completion or the extent of the prior art. This can take up to 3 months.
- The first filing application defines what is referred to as a priority application. The date when the initial patent application was first received by the appropriate Patent Office corresponds to the priority date. ONLY the features of the invention described in the priority application – even in a very broad and quick-and-dirty way - benefit from the priority date. It is thus important that all major aspects of the invention, even prospective ones, are identified and included in the priority patent application.
- CHUV and/or UNIL are the owners of the intellectual property (hence of the patents) that has been generated by their employees and researchers including staff paid by external funding. The name of all inventors reported in the original IDF shall appear in the patent application.

### C. Towards the definitive patent application and increasing the value of the patent

#### ***Priority period; 12 months after the filing date***

- From the priority date, PACTT has 12 months to amend the patent application by completing the description, the claims and/or the figures. Meetings will be held between the inventors and PACTT to analyze any new research results and evaluate how they can contribute to raise its commercial potential. Following the evolution of such results, PACTT will decide whether and when to file a definitive patent application.
- There are two critical factors for PACTT to decide to continue the patent procedure or to abandon the patent application: The first critical factor will be based on how far inventors have established the proof of concept so that it reaches a high degree of completion. Additional features added after the priority date will not benefit from the original priority date. The second critical factor is based on the identification of industrial partners that may be interested in licensing the invention. The mission of PACTT is to insure appropriate licensing of the patents. On one side, PACTT will search through an established network for such industrial partners and set up negotiations for the licensing of the patent rights. On the other side, the inventors are expected to strongly cooperate to help identifying such partners. Preliminary contacts (which must take place under a non disclosure agreement) are thus strongly encouraged and recommended.
- Ideally, the inventors keep the invention secret during the priority period. Please contact PACTT if you plan to publish your results (described and claimed results and/or new additional results) during this period.

#### ***From the priority date to the grant***

- The patent application will be published 18 months after the priority date.
- Filing a patent application does not mean that your invention is protected. This will happen only when the patent is finally granted. This implies a long procedure of examination of your patent application by the international and national patent authorities that requires several years and substantial administrative

costs.

- At this time again, PACTT will need commitment from the inventors.

#### **D. Licensing or harvesting the value to the patent**

- The ultimate goal of a patent is the commercialization of the protected invention. This can be achieved through:
  - a) the licensing – or assignment - to an industrial partner
  - b) the licensing – or assignment – to the inventors (to create their own start-up)
- Inventors should participate in further negotiations with the chosen industrial partners if the transfer of know-how, materials, or knowledge is involved, or if collaborative work is envisaged. In parallel to license agreements, PACTT may, when appropriate, negotiate research agreements so that the inventors' laboratory continues developing the invention with (and sponsored by) the industrial partner.
- If no industrial partner is interested in licensing the invention, PACTT may then choose to abandon the patent application. In this case, inventors are duly informed of the reasons of the decision. The rights to the ownership of the invention remain at the Institutions. Upon written request by the inventor, the Institutions may decide at their discretion to transfer the IP rights against the reimbursement of the incurred patent costs to the inventor through a formal agreement.
- Inventors may also decide to create their own start-up. PACTT will then negotiate a license agreement with the founders of the start-up and provide support for its launching.

#### **E. Distribution of Financial returns**

- Any revenue arising from the licensing out and final exploitation of the Institutions' intellectual property will be shared between the actors of the invention.
- After deduction of all patent-related costs and a percentage (10%) to contribute to the operating cost of PACTT, the Institutional rules define the sharing of these net revenues as follows:
  - a) 1/3 to the inventors
  - b) 1/3 to the unit/group at the origin of the invention
  - c) 1/3 to the Institutions (equally to CHUV and UNIL)
- These revenues will be centralized and redistributed by PACTT.

We at PACTT are passionate about finding the best way to bring your invention to the market and we are looking forward to a successful collaboration.