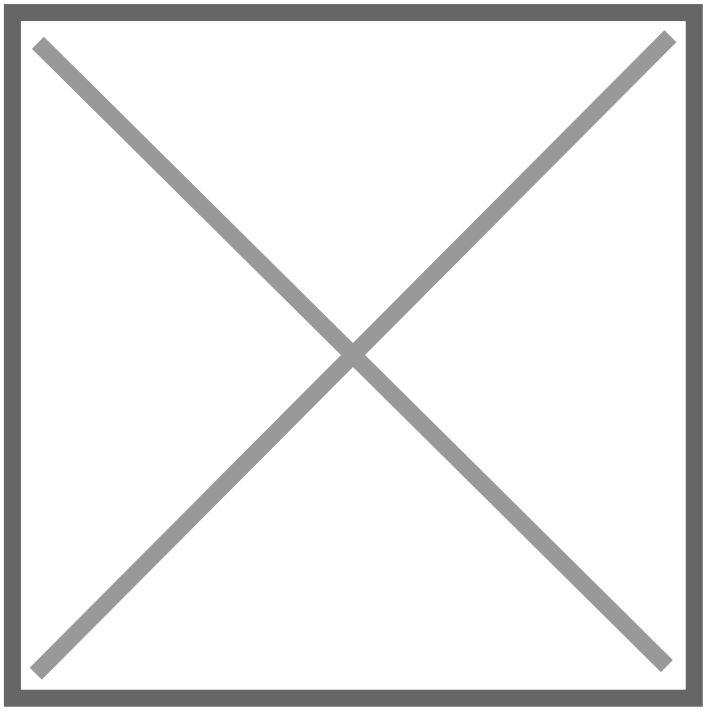
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Role of law firms after Utilisation of Public Funded Intellectual Property Bill 2008 becomes an Act

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The Utilization of Public Funded Intellectual Property Bill 2008 provides a framework for the protection and utilization of intellectual property originating from public-funded research which would read as universities and research centers (referred to as public funded research labs). However, such a framework would amount to just that, a framework. For this proposed law to work, it would require the public funded research labs to recognize that its scientists are important members of the society at large and the scientists have a important role to perform as harbingers of scientific solutions to social problems.

Since the scope of intellectual property under the new version of the proposed Bill has been limited to patents and plant varieties, the focus most obviously is on technology related research and development labs. It also means that the patent agent and patent lawyers become an integral part of the university research ecosystem. Both forms of intellectual property rely on being the first to file to be able to claim the exclusive rights under the respective IPR laws.

In fact, I envisage that the role of the lawyers and law firms will become that of a guardian and legal mentor to the scientist viz a viz the implementation of the various provisions of the Utilization of Public Funded Intellectual Property Bill 2008 as and when it comes into law. The expertise profile of the legal practitioners involved in these matters would necessarily encompass subject matter expertise as in case of patent agents as well as expertise on technology transfer and contractual obligations.

Situations such as exclusive license arrangements used by certain foreign organizations to commandeer intellectual property generated in the Indian universities and research centers will have to be closely monitored by lawyers with considerable experience in understanding the technology landscape as well as various forms of efficient and effective transactions under the prevailing contract law and the IP laws.

In effect the profile of the lawyer will have to necessarily change from being either a patent attorney or a transaction lawyer to a balanced amalgam of both with enough exposure to the licensing market as well as the litigation scene. Personally I would say that while a patent lawyer is the required profile, the said lawyer must also have enough exposure to identifying trade secrets, handling of confidential information as well as trademark, copyright and industrial design laws to be able to spot golden opportunities and ensure competitive advantage of the university technology viz a viz their competitors.

An ideal situation would be the establishment of a technology transfer office with suitable representations of a transactional lawyer, a patent agent and a business development officer. I call it the 3-pronged approach. This will help in establishing:

a. an in-house system of submission of a research outcome
b. an evaluation system for patentability
c. a system for conducting novelty searches, drafting, filing and monitoring of the patent portfolio
d. a cell for searching out licensing partners for development work from lab to market, conducting clinical trials or field experiments, entering foreign markets including filing corresponding patent applications overseas and / or creation of patent pools for platform technologies
e. an overarching innovation ecosystem including a network of other national and international research laboratories
f. of course, business development with aid from the research scientists / scholars themselves

While some of the IITs and research organizations in India do have an incipient technology transfer office, the focus is merely on patent filing and prosecution with no clear concepts of licensing mechanisms and prevention of appropriation of intellectual property through devious agreements with third parties.

Interestingly, many of these public funded research labs do not ever commission a technology landscape or such studies to take a proactive decision on the line of patentable research that can be undertaken for finding solutions to a given problem.

It is also a fact that there is a rather self-defeating trend of intellectual arrogance among the university Fellows which include both the professors as well as research scientists, which in today's world of innovation is rather a ridiculous stance to adopt. Today, the norm is the application of a business mind to convert both the successes as well as the apparent laboratory failures into a startling business ventures through sound legal transactions and sharp business mind as well as effective legal interventions by way of enforcement and / or non-exclusive licensing strategies.

It may well be that the proposed law could be the tool for the systematic and consistent development and channelizing of the Indian scientific temper into creating viable solutions to socio-economic problems. But this can happen only if the public funded research labs bridge the gap between the innovators, their lawyers and the business developers and establish an efficient and well-organised in-house technology management and transfer offices having efficient legal help in terms of patent agents, transaction lawyers and business development officer, who can if need be handle work in-house, but are proficient enough to seek outside legal help as and when the situation warrants before serious damage is done to the technology so painstakingly developed by the public funded research labs.