

## IP/Technology Transfer

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### ▼ Humboldt University beefs up technology transfer

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#### **With its new patent policy, the university aims to deal with industry partners on an equal footing.**

Humboldt University (HU; Berlin, Germany) became the first university in Germany to formalize a patent policy, outlining the rules for technology transfer, revenue sharing and the creation of spin-offs in October. Other publicly funded research institutions in Europe could soon follow suit, helped by a set of guidelines to encourage exploitation of intellectual property (IP) due to be published by the European Commission (EC; Brussels) in 2004.

Until recently, German universities were not interested in dealing with IP issues because, by law, professors retained ownership of their discoveries. As a result, universities saw little return from licensing patents to companies. This all changed in February 2002 when a new law ([Gesetz zur Änderung des Gesetzes über Arbeitnehmererfindungen](#)) came into force that shifted IP ownership to the universities and ruled that academics are to receive 30% of the licensing revenues.

The Humboldt IP policy (see [Box 1](#)), which is designed to use the provision of the new German law to maximize the university's returns, is primarily "a signal to industry that this university is on the verge of becoming an equal partner in research collaborations," says Christian Kilger of ipal GmbH, a Berlin-based IP asset management firm. And it is "a signal to researchers employed at the university that IP is important." In the past, German industry did not let universities share revenues that were generated from collaborative research projects, although academic work is financed by taxpayers' money.

Politicians at the EU level hope that more institutions will follow HU's example and get involved in actively managing IP derived from public funding. Indeed, the EC is due to publish in the coming months a set of guidelines for the exploitation of IP rights within academic institutions and in collaboration with private partners<sup>1</sup>. These guidelines are expected to promote the harmonization of IP management across European member states. Currently, each country has different IP ownership rules. For example, in Sweden, scientists traditionally own the IP of their inventions. Denmark, like Germany, abolished that privilege in 2001, but Italy introduced it in the same year. France has never had such a law in place; all IP ownership traditionally belongs to universities.

So what factors are pushing European institutions to formalize their IP policies? Experience in various institutions across Europe suggests that successful technology transfer programs depend on institutional control of IP. Even in countries where professors retain IP ownership by law, successful technology transfer tends to occur at institutes and universities, such as the Istituto Scientifico Universitario San Raffaele (Milan, Italy), that ask scientists to relinquish IP ownership in return for a percentage of the profit generated.

Such practice "actually channels the IP and allows you to build a patent portfolio, which makes it more interesting for companies to talk to you," says Gábor Lamm, Managing Director of EMBLEM, the commercial arm of the European Molecular Biology Laboratory (EMBL) in Heidelberg. "You can also



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Humboldt University is the first German university to formalize its patent policy.

start mixing and matching different patent applications from different labs and put them together to try and create new startup ideas," he adds.

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Whereas academic institutions benefit from IP ownership, researchers receive different levels of compensation depending on where they work in Europe. For example, the EMBL has a sliding scale for remunerating inventors, where scientists receive 30% of returns up to €125,000 (\$143,500), 20% of returns up to €500,000 (\$574,000) and 10% of returns for anything beyond this. By contrast, inventors at Karolinska Institutet (Stockholm) receive 60% of returns from their inventions. There is no one-size-fits-all approach, says Paul van Grevenstein, president of the Association of European Science and Technology Transfer Professionals (The Hague, The Netherlands). "Europe is made up of a patchwork of different cultures. Technology transfer needs to be tailored to the local situation," he adds.

But more than just a formalized IP policy is required for a university's technology transfer program to be successful. "You get the best value if you have the cooperation of the scientist," says Christian Policard, vice president of business development and industrial partnerships at the Institut Pasteur (Paris). And having access to a group of technology transfer professionals, internally or externally, is very important. "You need people with different expertise: people who are coming from the industry and people who are competent in patents, but also in licensing and financial issues, and they have to work together as a team with the scientist."

#### Box 1: Humboldt University's Patent Policy

- The university claims IP ownership of inventions made by university employees or students; the inventor receives 30% of the revenues. IP management is handled by the Berlin-based asset management firm ipal GmbH.
- If a scientist wants to create a startup company on the basis of his/her invention, the university will contribute the IP rights in exchange for shares in the company.
- HU outlines standards for contract research or research collaborations between university and industry in the Berlin Contract. In contract research, where academia performs research for an industrial partner, the industrial partner is entitled to all the IP rights; in collaborative research where university and industry work on a joint project, IP ownership is subject to negotiation. With the Berlin Contract, the university will own the IP rights if university employees develop at least 50% of the results. If the university employees' share in the invention is below 50%, the industrial partner owns the exclusive IP rights.

#### References

- EU [working paper](#) on guidelines for the management and exploitation of IP rights in public research institutions. (Office for Official Publications of the European Communities, Luxembourg, 2003.)

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