

# Best Practices for Licensing of Genomic Inventions

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**DRAFT**

**WORK IN PROGRESS**

**Comments and suggestions are invited**

# What We Fear

- **Inhibit Innovation**
- **Inhibit Competition**
- **limit access to tools - Slow Research**
- **Shift from Basic to Applied Research**

# What Grantees Fear

- **No Good Deed Goes Unpunished**
- **Slippery Slope to Gov't Regulation**
- **Easier Said Than Done**
- **Chill Licensing Interest**
- **Gov't Should Mind Its Own Business**

# Not All Innovations Require Further R&D to Meet Goals

## Examples in Genomics

- Bulk Sequences
- Plasmids
- Cloning Tools/Vectors
- Libraries
- Databases
- Software
- Lab Techniques

**If significant R&D is not needed**

**Consider**

**Not**

**Patenting**

# Potential Benefits

- **Conserve Resources**
- **Commercially viable tools can be licensed without IPR**
- **Incremental improvements still advance field through publication**

# **Not all Patents Require Exclusive Licensing**

- **Market sufficient to support competition**
- **Background Rights**
  - Genus/Species**
  - Product/Method of Use**
- **Bundles/Combines with Licensee's own  
Proprietary Technology**
- **Broad Enabling Technology**
- **Research Uses**

# Exclusive Licenses

- **Ensure Appropriate Scope**
- **Ensure Expeditious Development**

# Appropriate Scope

- **Limit to specific indications or fields of use**
- **Limit to specific territories**
- **Commensurate with Licensee's ability and commitment to develop**

# Expeditious Development

- **Include developmental milestones/benchmarks**
- **Require performance-based royalty payments**
- **Monitor & enforce performance; include provisions to modify and terminate**
- **Sublicensing provisions & requirements**

# Take-Home Message

The good that patents do lives after them

The rest can be fixed by good licensing

So

Go For The

Good