

## **The Joint Training on Intellectual Property for the U.S.-China Clean Energy Research Center (CERC)**

**School of Management, Huazhong University of Science and Technology (HUST), Wuhan, China**

**November 16-17, 2015**

Organized by the Chinese-German Institute for Intellectual Property at the School of Management, HUST, and the U.S.-China Clean Energy Forum (CEF), with support from China's Ministry of Science and Technology (MOST), this training was the first pilot effort to introduce regular researcher trainings and executive education for Participants in the CERC program.

Over 120 individuals from CERC Participating institutions registered to attend the two-day program. The program was presented in the Chinese language (with simultaneous translation for the English-speaking lecturers).

Opening the training, attendees heard from Counselor CAI Jianing, the China CERC Director for MOST, Joseph ZADROZNY, U.S. Consul General in Wuhan and CHEN Jianguo, Vice President of HUST. Justin CONROY representing the U.S. Patent and Trademark Office in Beijing, and SUN Quanliang, representing China's State Intellectual Property Office, discussed their organization's collaborations to improve the patenting process globally and efforts to advance cooperation between the U.S. and China in innovation. Each recognized and praised the unique characteristics of CERC with regard to IP management.

The program undertook to provide an overview of the CERC IP program and CERC IP legal framework, and then offer insights into the patent application process in China, patent strategy, and IP licensing strategy and practice. The first speakers, the leads for CERC on IP, Professor YU Xiang and Mr. Stacy BAIRD, each presented aspects of the CERC program's approach to IP, including an overview of the CERC Protocol, IP Annex and the TMP, and the provisions to which all CERC-related IP contracts must comport. Professor YU provided an overview of international patent cooperation and placed CERC IP management in the context of cooperation between the US PTO, SIPO and the European Patent Office. Mr. Baird discussed the CERC IP framework, the specific terms of the CERC Technology Management Plans (TMPs) and the work of the IP Experts group. Both Mr. BAIRD and Professor YU emphasized the need for CERC Participants to have IP-specific contracts or terms in their project agreements to address the terms and conditions for the use of Background IP and the allocation of rights and responsibilities with regard to Project IP. Mr. Donald Challman, the Associate Director & General Manager of the University of Kentucky Center for Applied Energy Research, presented a case study of the University's licensing trade secret, the 'know-how' and 'show-how' to use patented technology, between CERC Participants.

Turning to patent strategy, Mr. WANG Hanpo, Director, Beijing East Rain Law Firm, set the context by discussed the history of IP rights protection and management in international science and technology cooperation. Mr. Shaobin ZHU, Shanghai-based attorney at the U.S.

law firm Finnegan, Henderson, Farabow, Garrett & Dunner, discussed formulating patenting strategies with the aim for future patent licensing. Mr. ZHU looked at patent strategy from both a defensive, and offensive perspective, examining litigation trends, partnerships, deal structures, developing a portfolio and key elements to success. Assistant Professor LIU Shan from the Zhejiang University of Technology, discussed the use of patent search and both qualitative and quantitative analysis to identify possible areas for further research.

The second day focused on patent licensing, opening with Professor MA Jun, the Director of Overseas R&D Management Office of Tsinghua University, explaining how universities approach IP licensing, beginning with why they value technology licensing and how they license in different contexts. Professor MA illuminated the path toward successful licensing and offered an overview of new policies that impact university technology licensing. Mr. Shaobin ZHU from the Finnegan law firm offered more detailed guidance on patent licensing negotiations and drafting agreements for IP. Dr. Vincent ZHONG, Chief IP Operation Officer for Sinofaith IP Group in China followed, explaining the value proposition of innovation, patents and patent licensing, including a discussion of models of patent licenses, approaches to royalties and an overview of patent licensing in China. The day closed with Mr. Ka-Yin LI from the Chinese law firm, Anjie, engaged the audience in a discussion of a fictitious case and the pitfalls that can beset a licensing negotiation.

The training was well attended and received positive feedback, with both academic researchers and IP experts from CERC Participating companies from China fully engaged through the two-days. Although some aspects to establish a self-sustaining program for training have yet to be developed, such building the relationship between a Chinese and U.S. academic institution to partner to undertake the training, and situating the trainings to be more along the lines of a continuing education program, the training allowed lecturers to develop curriculum specific to CERC's IP requirements and demonstrated that there is substantial interest in training on these important issues. Furthermore, CEF video-recorded the training and will be making the presentations available to all CERC participants through the CERC websites in the U.S. and China. This will be an invaluable resource to researchers and executives unable to attend this first CERC training.