

Interview to Montserrat Jané, technician at the Patents Center of the University of Barcelona¹

Montserrat Jané

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Abstract

On this document we will present the interview done to Montserrat Jané, patent technician of the Patents Centre of the University of Barcelona. This interview was done on May 2007 by Victor Cavaller for SCIWATCH scientific magazine. In this interview, Montserrat Jané talks about the work that is being held at the centre, about the people that work there and their professional profiles, about the centre's structure, its relations with other agencies, organisms and entities from the private and public sector, and also about the information fluxes and the different procedures that are being done and held in the patent field.

¹ Interview done on Wednesday the 9th May of 2007, in the offices of the Patents Center of the University of Barcelona. Interview has been done by Victor Cavaller. Transcription has been done by Matias Welling.

The Patents Center is a research facility of the University of Barcelona that, since year 1987, dedicates itself mainly to tasks of research, divulging and teaching in the field of the patent rights and documentation. The center counts on specialized staff to carry out research on patentability of inventions, and with several Patent Rights Agents, registered as such, that are responsible for the writing and the whole procedure of requesting a patent.



Figure 1.: Montserrat Jané

How is the team of work that you dedicate to each of the tasks composed? How do you organize the working teams? Which are the main sequences of activity at the Patents Center?

The team at the Patents Center is formed by:

- . Pasqual Segura
- . Bernabé Zea
- . Lidia Cases
- . Montserrat Jané
- . Nuria Sants

Which are the professional main profiles of the patents technicians?

The main professional profiles at the Center have technical and scientific background with specialization in the technical or scientific area in which the patentability is being studied. We value not only knowledge on patents but also the knowledge about documentation. In particular, the center of patents of the UB is especially focused towards the areas of chemistry, biology, biochemistry or biotechnology, even though these areas are not at all restrictive.

Which sectors from the industry are the main customers of the services that you offer, and how do you manage their patents?

Besides the individuals who work in general areas, the main companies that come to the Patents Center are from the area of pharmacy, chemistry, biology, biochemistry or biotechnology. From the creation of the center, about 30 projects have been formalized with success. This number is explained because of the fact that in the UB the Spanish patent is usually requested, and this type of patent offers a year of protection and therefore, an international patent is requested, PCT, which as a matter of fact will never be granted but allows the requester to win time of protection; up until two years and half. All this extra time allows us to visualize if this project can effectively be transferred to the business world. If after this period this technological transfer has not been made, the project is abandoned. On the other hand, if the project is viable, we proceed to patenting the invention in other countries. The interest of the university is precisely achieving a successful transfer to the business world, and this will only be possible if this invention has commercial possibilities. To go for the international patenting is very expensive, therefore the university will only do it if, from its point of view, is plausible. In accordance with the current regulations (posterior annex) and once the technological transfer has been made, the University will have the right to an economic compensation corresponding to a proportion of the derivative benefits of the economic exploitation of the invention. It is contemplated that the researchers as well as the university have the right to receive economic compensations, in equal parts.

The Center of Patents is one of the agents in the System of Innovation of the UB Group, in which we can also find:

- Agency of Valuation and Commercialization of the Results of the Research (AVCRI)
- Center of Innovation of the *Bosch i Gimpera* Foundation
- Scientific Park of Barcelona
- Scientific and technical services

- [Clinic Foundation](#)
- [August Pi i Sunyer biomedical research institute \(IDIBAPS\)](#)
- [Bellvitge biomedical research institute \(IDIBELL\)](#)

How do the services of the Patents Center of the UB organize with the other agents of the System of innovation of the UB group?

The patents center of the UB as well as the Center of innovation of the Bosch i Gimpera Foundation are independent units of the AVCRI, even though they work in collaboration in certain projects. This means that only the tasks that the Patents Center does regarding patents are being conducted in collaboration with the AVCRI and the Center of innovation of the Bosch i Gimpera Foundation. In this collaboration, the mission of the Patents Center is based on protecting, through patents, the inventions of the UB environment. This implies that the initial search, the patentability analysis, the writing of the request of patent and the posterior procedure are all conducted in collaboration.



Figure 2.: Patents Center headquarters in Barcelona

The internal process of protection of inventions in the University of Barcelona starts with the researchers filling the form, which will then be sent to the AVCRI for the initial valuation. From here on, a first committee is formalized by members of the three areas (AVCRI, Patents Center, and Center of innovation of the Bosch i Gimpera Foundation) that evaluates the project.

The committee then proceeds to the writing of a report that analyzes different aspects such as: The Patents Center studies the patentability, the Bosch i Gimpera Foundation studies commercial aspects and possible feasibility of the technological transfer. Then this report is remitted to a management committee that will decide if a working team is going to be formed or not, in other words, if the project is going to be carried out or not.

Besides from patent consultancy, the Patents Center of the UB develops other functions such as:

- Teaching
- Free and public information service for general advice in subjects such as patentability (in collaboration with the CIDEM; Center of Innovation and Entrepreneurial Development) oriented to individuals as well as companies and entities that want to brief themselves about the procedure which is necessary to protect an invention with a patent. The companies or individuals concerned can then be remitted towards agents of the patent rights, which offer a commercial service for patenting inventions, or we can give them advice so that they patent the invention by themselves. In this second case, individuals must start the work of searching in the data bases to verify that the invention is effectively new and exclusive. They can carry out this search in commercial or free databases (there are commercial data bases with effective search tools based on indexing and standardization of contents by different criteria of search. There are also free open databases that unfortunately are not as effective or complete as their commercial counterparts). In this context, it is recommended to begin using the open access data bases, and then, if they are not successful, continue the search with professional data bases.
- Service of library specialized in intellectual and patent rights.

The institutions mentioned above, Agency of Valuation and Commercialization of the Results of the Research (AVCRI), Center of Innovation of the Bosch i Gimpera Foundation, Scientific Park of Barcelona, Scientific and technical services, Clinic Foundation, August Pi i Sunyer biomedical research institute (IDIBAPS), and Bellvitge biomedical research institute (IDIBELL) can be considered like customers of the Patents Center, because they are users of the services that the Patents Center offers.

On the other hand, the center also offers the UB Group and the Scientific Park of Barcelona a series of services addressed to the public in general and, especially, to the linked entities: The center is one of the agents of the System of Innovation of the UB Group, in which it is in charge of the protection of the results of the research with patents, in accordance with the Regulations about Intellectual and Patent Rights, in collaboration with the agency of Valuation and Commercialization of the Results of the Research (AVCRI).

Which is the policy related to the management of the patent and intellectual rights of the UB? To what extent does this policy engage the activities of the Patents Center?

The AVCRI is the entrance door for the projects that will pass through the process that implicates the patents center as well as the Bosch i Gimpera Foundation. We, the Patents Center, are not an integral part of the AVCRI, even though we participate in narrow collaboration with the rest of institutions involved in the process. Our management policy of the patent and intellectual rights is in coherence with the patents policy of the UB, based on the selection with clear-cut criteria, of those projects that can have financial feasibility. In this way only those projects with real potential will be thrown ahead.

The center has a public access documental database and offers a free information service about subjects related with the patent rights and an on-demand research service for carrying out searches in patent databases.

Which are the main users of the information services offered by the Patents Center? Which are the main sources of information of this service?

In the library, we offer individuals the opportunity to consult books on the subject, and this service is mainly addressed to lawyers and technicians specialized in the area. The patent documents are already available online, on different open as well as professional data bases, therefore the main disposable resource of the library are updated publications and theory books on the subject of patents, patent rights and copyright. Supply of patent documents is also offered, even though this service is not being requested as much, given the mentioned fact before, that the documents of patents are already present in data bases on the Internet.

The center also takes care of the Spanish representation of Chemical Abstracts Service (CAS) and STN International.

Which are the concrete terms of the collaboration between CAS, STN international and de Patents Center?

There is an agreement between the American Chemical Society (CAS, Chemical Abstracts Service) and the UB for which the staff of the patents center makes the tasks of CAS representation in Spain. This agreement represents a benefit for the University of Barcelona for the prestige of exercising this function, as well as for the remuneration agreed for making this representation. Besides representation and promotion, the Patents Center of the UB gives support to the users who want to know the functioning of these data bases in depth. A service of advice and orientation for the customers of CAS is also offered.

Apart from the STN International software, which other software of exploration/analysis of the production of patents do you use?

In the patents center, STN is used as a retrieval tool for documents of patents as well as for scientific articles, to cover all the recovery needs of the center. STN offers more than 225 data bases of different specific technical fields.

Which do you think are the main trends that can be observed when companies write their patent documents, both respecting the current law but at the same time trying to protect their inventions?

Patent laws establishes which innovations can be protected with patents and stipulates that only the following concepts can be protected: In first place products *per se*, and that is the maximum possible protection since it protects the product itself and nobody can sell it during the time of protection, independently of the procedure that he uses to arrive at it; in second place the procedures to arrive at a final product are also subject to eventual protection, in third place indications and therapeutical uses of a determinate product can also be protected.

The law on patents of 1986 did not allow the protection of products *per se*, even though the European Office of Patents was against the philosophy of this public Spanish law. This situation changed with the new 1992 law that adapted the Spanish regulation to the usual regulations in Europe and WTO member countries. This normative shift has provoked that many companies with patents transacted and published before year 1992, invoked later on the TRIPS 1994 international agreement (WTO agreement that establishes among other things, that it is possible to change the protection of an invention to the best possible protection available) to make the patents former to 1992 transform into product protection *per se*, therefore adopting the best protection available in Spain. There have been several sentences of Spanish courts that effectively affirm that patent protection prior to 1992 can in fact become product protection, in coherence with the TRIPS agreement.

When patenting, the regulations require that the description on the patent document is written in a sufficient way that allows reproduction: the so-called criteria of sufficiency. The companies usually comply with the criteria of sufficiency, even though there are ways of partially protecting the know-how of an invention while complying with the law. A good example could be the case of companies of the chemical sector that want to patent a chemical reaction that produces a determinate product. The patent can be written explaining the way to make it correctly, but without clarifying that there is an exact point of temperature in with this chemical reaction is much more efficient. The chemical process can be carried out at other temperatures, and this is explained in the patent, but the exact temperature in which that retain is highly efficient is not revealed and by doing this, the companies partially protect their know-how. It is more or less usual for companies to obviate certain aspects of the know-how in order to protect the differential competitive advantage of the company. In the US though, this is not possible. In America the regulations about copyright and industrial property are different and the criteria of sufficiency also includes the requirement of explaining, in the patent written document, the best known way for the applicant to arrive to the final product, the best mood.

Another aspect related with the written up of patents is the fact that an inventor who has an invention with eventual commercial feasibility, must protect his invention (and specially the know-how) before starting to look for finance support to develop that invention. By doing this, and with the patent in hand, the inventor is in a better position to negotiate the development of that innovation since he can explain his patent, as far as where it is necessary, and keep the know-how for a later moment once he has a good agreement.

In this context, the so-called nebulous of patents is a very common business strategy for protecting innovation while patenting and complying with the regulation. In order to do that, companies trying to protect one specific innovation do not only create the patent for that specific invention, but also create a variable number of other patents closely related, all in order to create confusion for the competitors, distorting the first intention of the company. By these techniques of lack of information companies can confuse competitors when they carry-out their technological watch functions.

Courses and conferences

The center organizes courses and conferences about the system of patents, seminars on documentation in scientific and technical data bases and forums of discussion.

Which is the balance of the latest years of the formation courses?

- At first, annual conferences were made consecutively once in Barcelona and later in Madrid, nowadays annual conferences are being held in both cities simultaneously, therefore we can say that these conferences have been consolidated.
- This year we are holding the *European Qualifying Examination* courses addressed to individuals wanting to become European patent agents.
- We are also holding free regular conferences on the subject, the "*Jornadas de Estudio y Actualización Materia de Patentes*" that are very popular among experts in the subject.
- Several educational activities are developed in university centers in collaboration with the OEPM (the Spanish patent office). We organize 10 sessions per year, structured like 4 hour conferences where the patent and intellectual rights are explained, as well as explaining the services that the Patents Center and the OEPM can offer.
- Courses and masters in prestigious institutions like the University of Alicante, ESADE, IQS, University of Navarra, Polytechnic University of Catalonia etc. that are imparted by the members of the center of patents.
- The information of the courses and conferences that the Patents Center organizes and/or participates in, are available on the center's website:
<http://www.pcb.ub.es/centredopatents/cursos.htm>

Among the academic activities that the Patent Center regularly organizes, it is offered:

- Days of study and update on patents ("The Patent Monday"): This is a discussion forum that brings together more than three hundred patent experts. During the academic year about five sessions are announced through a distribution list. If you want to enter, contact Pascual Segura.
- Workshop to prepare for the European Qualifying Examination (EQE) of the European Patent Office: The objective of this course is to train Spanish candidates who want to improve their professional practice and submit to the European Qualifying Examination (EQE) in order to become agents of European Patents (you'll find more information about the EQE on the site of the EPO).
- Course on patents and utility models: patentability, drafting, infringement, litigation, transfer and documentation: Modular course (two weeks), in alternate editions in Barcelona and Madrid, aimed at professionals (managers, technicians, documentary makers, consultants, lawyers, jurists, etc.) and inventors who have to deal with patents and technology transfer, and is also particularly designed for people interested in substantive issues of infringement and invalidity.
- Documentation seminars on databases and scientific and technical patents: These seminars are aimed at people interested in learning how to do searches in commercial databases, which provide access to information not available from other sources that can be found on Internet.
- Training Programs for companies and public research: Courses are offered on demand, both for companies (R & D departments), universities and public research. Many of these activities are done in collaboration with other agencies such as:
 - The Spanish Patent and Trademark Office (OEPM),
 - The Information and Business Development Center (CIDEM) of the *Generalitat de Catalunya*
 - The European Patent Office (EPO)
 - The University of Strasbourg's *Centre d'Études Internationales de la Propriété Industrielle* (CEIPI)
 - The CAS of the American Chemical Society

Figure 3.: academic activities carried out at the Patent Center in the UB

What are the main customers of this service?

The main users of the courses are in the pharmaceutical industry, of great weight in Catalonia, and other industrial and scientific Catalan strategic sectors, as perhaps the chemical sector. The fact that these sectors are precisely those who give more importance to activities related to patents can be explained by the fact that in these sectors the investments necessary to do research and develop products are quite important, and only a tiny portion of the projects that start will have commercial viable applications. Patents and in general the legal framework of these are vital in areas with R & D intense activity, such as chemical or pharmaceutical. If companies in these sectors cannot obtain protection for their inventions against the competition, they cannot justify or recoup the huge financial outlay required to do that research to develop new products.

Do you consider the possibility of forming professionals dedicated to the foresight and technology watch?

At the patents center we started working on projects that come through AVCRI and are presented by researchers. We can advise them on issues mainly related to patentability, procedure for patenting, and the economic viability of the projects. The guidance given on the way a specific investigation should go are rather limited. Throughout the process that is undertaken to patent an invention, the members of the

multidisciplinary team (from AVCRI, the patents center, and the Bosch I Gimpera foundation) who analyze the cases, can provide general guidance, but cannot give specific guidelines on what should be included in a project. The training of professionals in the field of technology monitoring and foresight, understood as feedback, is not a priority right now.

Where is the Patents Center located inside the triangular structure University - Institutions - Companies?

In this triangular structure, the Patent Center cannot be seen as a “University – Business” relation, because there is no close collaboration between the Center and private companies. The Center is not an “Institutions – University” agent either, except for the fact that it receives public funding and that it works with the AVCRI, which is a public – private entity, In any case, the daily work of the Patents Center cannot be considered as work carried on in the public administration. So in the end, we can say that the center is located inside the University pole, because its goal is to protect the inventions created in the UB, and the institutions surrounding the UB, exclusively. This is also true, because the relationship with the companies merely intends to transfer, i.e. "sell" the inventions and technology from UB to private companies so that they develop projects to arrive at the product that will reach the market. The key in this triangle is that all the research being done in universities cannot only end up in the scientific literature, but it must be patented and eventually arrive to the society as commercial products. In consonance with these goals, the public sector is financing and promoting the patenting of inventions and the technological transfer from universities to the private sector.

[Since 1988 the Patents Center has been involved in promoting the patent system among researchers from the UB Group, in order to encourage patent protection of research results and the process of patenting in general, under the old 1995 UB Regulation on Patents.](#)

Which measures are you developing with the scientific community in the UB in consonance with these goals?

The Patent Center became involved in teaching and promotion in the field of patents as a mean to promote and encourage the protection of inventions in general and disseminate knowledge on the subject. In some sense the greatest contribution of the Patents Center is to disseminate the culture of patenting and publishing not only in universities. Until recently, this lack of will and lack of patenting culture made many innovations with good commercial potential never come to receive the thrust of companies for the commercial development of a product. Fortunately, we think that this way of thinking is gradually changing here in Spain.

[To have all the information regarding the transfer of knowledge and technology of the UB Group, interested researchers and companies can visit the Transfer Gateway of UB Group and the AVCRI.](#)

Do you consider the technology transfer of the results of the scientific research of the UB to be positive / adequate? What are the main current deficits?

From the Patents Center we believe that many inventions have been successfully transferred to the world of business, although sometimes the projects end up “dying” because they have no commercial applicability or the right timing. In this context we believe that much progress has been made, especially with the creation of AVCRI. This agency represented a great improvement for the rationalization of resources and for the pushing forward of projects in a reasonable way, which is, patenting only what may really have practical potential and not just patenting everything that is being investigated, as it was done years ago at the university level.

The main problem in the field of patents is that traditionally researchers have begun to publish in scientific journals before attempting to patent, in violation of the patent regulation defined by the new

laws governing intellectual property. With the new laws, researchers have to be very careful with what they say in congresses, and what they publish in their doctoral dissertations, or articles. It is important to patent before disclosing an innovation. Again, initiatives such as the Patents Center, the AVCRI or the intervention of the BiG Foundation are of great importance.

Technologies to transfer:

Requested	Title of the patent	More information
09/10/2003	<i>Aparato eléctrico para la estimulación simultánea, controlable y duradera de células cultivadas en placas multipozo.</i>	Oferta tecnológica en el Innovation Relay Centre (IRC)
08/03/2004	<i>Péptidos como portadores penetrantes de células</i>	-
18/06/2004	<i>Nuevo agente terapéutico para el tratamiento de la infertilidad y/o subfertilidad masculina en mamíferos</i>	-
23/06/2004	<i>Compuestos para el tratamiento de la inflamación del sistema nervioso central</i>	Oferta tecnológica en el Innovation Relay Centre (IRC)
23/06/2004	<i>Compuestos para el tratamiento del daño agudo del sistema nervioso central</i>	Oferta tecnológica en el Innovation Relay Centre (IRC)
29/06/2004	<i>Nuevo uso terapéutico del formoterol</i>	Oferta tecnológica en el Innovation Relay Centre (IRC)
26/11/2004	<i>Método de identificación de pigmentos de una sola célula mediante espectrofotometría de imagen confocal en comunidades fototróficas</i>	-
25/02/2005	<i>Sensor radio-químico para fluidos</i>	Oferta tecnológica en el Innovation Relay Centre (IRC)
13/04/2005	<i>Extracto de un alga laminaria como agente terapéutico</i>	-
29/07/2005	<i>Composiciones farmacéuticas para el tratamiento de la enfermedad de Alzheimer y otros tauopatías</i>	-
08/09/2005	<i>Nuevo agente quimioterapéutico para el tratamiento del cáncer</i>	Oferta tecnológica
08/09/2005	<i>Compuestos para el tratamiento del Síndrome de Inmunodeficiencia Adquirida</i>	Oferta tecnológica
14/10/2005	<i>Compuestos para el tratamiento de la fibrilación auricular</i>	-
14/10/2005	<i>Compuestos para el tratamiento de la enfermedad de Parkinson</i>	-
27/10/2005	<i>Intermedio y procedimiento para la preparación de levetiracetam</i>	Oferta tecnológica
20/04/2006	<i>Compuestos inhibidores de acetilcolinesterasa para el tratamiento de la enfermedad de Alzheimer</i>	-

Table 1: Technologies to be transferred

Transferred technologies:

Year	Buyer	Patent	Technical sector	Contract
2006	Unidad Biotecnológica Analítica (UBAN)	WO 2005045425	Analytic Instrumentation	license
2006	ADASA Sistemas	pendiente	Analytic Instrumentation	license
2005	Cancer Research Technology Limited	WO 2004031130	Cancer treatment products	license
2004	Advanced in Vitro Cell Technologies	WO 2004003566	Diagnosis	license
2004	Genmedica Therapeutics	WO 0238152	Diabetes treatment and prevention products	license
2004	Biocontrol Technologies	WO 03000866	Microbiology	license
2004	Pharma Mar	WO 0212240	Cancer treatment products	sold
2004	Seiko Epson Corporation	WO 03079624	Electronics	sold
2004	Advanced in Vitro Cell Technologies	ES 2.192.495 i WO 03080076	Lymphoma treatment products	sold
2002	E-Sense Systems	ES 2.173.048 i WO 02077631	Analytic Instrumentation	sold
2002	Oleoyl-estrone Developments	ES 2.173.049	Diabetes treatment and prevention products	sold
2001	Química Farmacéutica Bayer	ES 2.187.276	Obesity treatment and prevention products	sold
2001	Balagué Center	WO 0052477	Drug selection kit	sold
1997-2002	Glen Research Corporation	US 6.153.742	Cyclic oligonucleotides	license
1996	Química Farmacéutica Bayer	ES 2.108.642 US 5.595.763	Pharmaceutical composition for treatment of diabetes	sold

Table 2. : Transferred technologies

For more information on these technologies contact with the Center for Innovation, Bosch i Gimpera Foundation. You can find more technology offers from other universities and research centers through the search engine “European service for Transfer of Technology”. This includes the Technology surveillance service (AMT), useful for updates on the latest offers and demands in the area of interest.