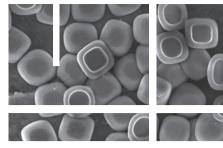




## NANOTECHNOLOGY COMMERCIALIZATION FOR

**MANAGERS** 

AND **SCIENTISTS** 



# NANOTECHNOLOGY COMMERCIALIZATION FOR MANAGERS

AND SCIENTISTS

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#### Published by

Pan Stanford Publishing Pte. Ltd. Penthouse Level, Suntec Tower 3 8 Temasek Boulevard Singapore 038988

Email: editorial@panstanford.com Web: www.panstanford.com

#### **British Library Cataloguing-in-Publication Data**

A catalogue record for this book is available from the British Library.

#### **Nanotechnology Commercialization for Managers and Scientists**

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ISBN 978-981-4316-22-4 (Hardcover) ISBN 978-981-4364-38-6 (eBook)

Printed in the USA

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**Efrat Kasznik** is a valuation expert with over 15 years of economic consulting experience. She holds an MBA from UC Berkeley and a BA in accounting and economics from the Hebrew University, Jerusalem and is the founder and president of Foresight Valuation Group, a Silicon Valley-based consulting firm providing IP valuation. litigation, and strategy services. Kasznik specializes in performing business valuations and valuations of intellectual property for a range of purposes, including mergers and acquisitions, financial reporting, technology commercialization, transfer pricing, and litigation damages. Prior to founding Foresight, she held a series of partner-level positions with leading litigation and IP consulting organizations. She has also been involved as a CFO, co-founder, and adviser to several Silicon Valley start-ups in the telecommunications, media, and cleantech fields.

Michael B. Landau is professor of law at the Georgia State University College of Law in Atlanta, Georgia. His law degree is from the University of Pennsylvania, where he won the Nathan Burkan Memorial Copyright Award. In 2005-2006 he was a Fulbright Scholar at the IPR University Center at the University of Helsinki. Prior to entering academia, Prof. Landau practiced law with the New York firms of Cravath, Swaine & Moore and Skadden, Arps, Meagher, Slate & Flom, where he represented entertainment, technology, and media clients. He has presented papers or has been an invited guest lecturer at numerous law schools in the United States and Europe, including Georgetown, NYU, Vanderbilt, Emory, Tulane, the London School of Economics, Cambridge, University of Edinburgh, University of Durham, and the Amsterdam Institute for Information Law. Before entering the legal profession, Prof. Landau was a professional musician.

Hanna R. Laurén received a Master of Science degree from the University of Turku in 2002, majoring in chemistry and minoring in biochemistry, physics, and mathematics. After graduation she worked for five years as a researcher at the University of Turku, focusing on the functionalization and solubilization of singlewall carbon nanotubes and their layer-by-layer self-assembly into polyelectrolyte multilayers with conducting polymers. Since 2007, Hanna has been working as a patent agent at the Helsinki-based patent agency Oy Jalo Ant-Wuorinen Ab, where she specializes in chemistry, chemical instrumentation, and nanotechnology.

Claes Post works at the Technology Transfer Office at Linköping University. He received his MPharm from Uppsala University and his PhD (Pharm) from Linköping University. A professor of neuropharmacology at Linköping University, Sweden, he is focusing on developing commercially viable projects from the medical faculty at the university. Dr. Post has had almost a 20-year-long career in the pharmaceutical industry as head of preclinical research at Astra Pain Control in Södertälje, Sweden, as well as at Astra Draco in Lund, Sweden. For 4 years he was also head of preclinical and clinical CNS at Pharmacia in Milan, Italy. During the last more than 10 years, Dr. Post has worked with VC-funded start-up companies in Sweden and Denmark apart from being a partner at VC funds in Sweden and Denmark. He has published more than 120 peer-reviewed scientific papers. Academically, he has been adjunct professor of neuropharmacology at Uppsala University, as well as at Lund University and Karolinska Institute.

Sarah Rouse is a registered patent attorney at Katten Muchin Rosenman LLP focused on identifying, securing, and maximizing the value of clients' intellectual property. Dr. Rouse is co-inventor on patents directed to nanomedicine. Her research led to the formation of Keystone Nano, a company providing platform technologies for nano-enabled therapeutics, and NanoSpecialties LLC, a company creating nano-based products for industrial markets. Dr. Rouse received dual undergraduate degrees from the South Dakota School of Mines and Technology and her PhD in materials science and engineering from the Pennsylvania State University. Her doctoral research focused on the synthesis, dispersion, and characterization of nanocomposite particles for bioimaging, drug delivery, and gene therapy. While at PSU. Dr. Rouse was named a National Science Foundation Fellow. She received her ID and certificate in intellectual property from DePaul University College of Law. She also interned at the World Intellectual Property Organization (WIPO) Coordination Office at the United Nations.

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Marco Spadaro has a degree in pharmaceutical chemistry and technologies. Marco has been involved in IP practice since 1990, both in private law firms and as head of the Corporate Patent Department of a primary Italian pharma company. He was a founding partner of Studio Associato Leone & Spadaro in 2006, and from 2010 a partner of Cantaluppi & Partners. Marco is an expert in drafting and prosecuting patents in chemistry, particularly pharmaceutical, biotech, nanopharma, food, polymers, and composite materials; patent strategies and patent portfolio management; and opposition and litigation proceedings. In addition, he is a lecturer in IP at the Patent Academy of the European Patent Office and at several universities and industries. He is also a tutor at the Centre d'Etudes Internationales de la Propriété Industrielle Université Robert Schumann, Strasbourg, France, since 1996.

Ennio Tasciotti, PhD, is an associate professor in the Department of Nanomedicine and Biomedical Engineering at the Methodist Hospital Research Institute. He received an MS in biological sciences from the University of Pisa in 2000 and a PhD in molecular medicine from Scuola Normale Superiore in 2005.

Pekka Valkonen is a patent manager at Fortum Corporation, a Scandinavian Euro STOXX company in the utility sector. He is responsible for intellectual property matters of major business units within the company. He deals with patents, trademarks, domain names, and research agreements. When handling the IP matters of spinoff of companies, Valkonen has made himself familiar with IP matters in small technology-based companies. Before the formation of Fortum Corporation, he worked at Neste Corporation, where he was responsible for patent matters in specialty polymers and especially electrical conducting polymers. He began his IP career in the Finnish Patent Office as an examiner, senior examiner, and consulting manager. Valkonen has lectured on utilizing patents in business, valuation of IP, and patent strategies.

**Pieter de Witte** obtained his PhD in supramolecular chemistry from Radboud University in Nijmegen in 2004, after which he became a postdoctoral researcher at ISIS institute of Strasbourg University. France, From 2004 to 2008 he was program officer for the Dutch national nanotechnology program NanoNed, at Technology Foundation STW, where he coordinated the utilization program and the interactions between industrial users and academic research programs. Since 2008, Dr. de Witte has been working at FOM Foundation and is responsible for collaborations with industry, in particular the coordination of the Industrial Partnership Programme (IPP).

Po Chi Wu is an adjunct professor in the School of Business and Management at the Hong Kong University of Science and Technology and a visiting professor and co-founder of the Global Innovation Research Center in the School of Software and Microelectronics at Peking University in Beijing, China. He is a co-founder and managing director of Dragon Bridge Capital, a merchant banking firm helping Chinese and US technology companies become global citizens. Dr. Wu has been a venture capitalist and entrepreneur for more than 25 years and has invested in early-stage high-tech and life science companies in Silicon Valley and Asia. He has a PhD in biochemistry and molecular biology from Princeton University and a BA in mathematics and music from the University of California at Berkelev.

### **Foreword**

Nanotechnology holds great promise for the future of humankind, and scientists and managers should be aware of this. Public and private sector investments in nanotech research have increased exponentially in the past two decades. We are now facing a future, not too far beyond the present, in which materials and devices with astonishing properties will completely change the rules of the game. Novel products will possess features that were almost unimaginable just a few years ago.

Until recently, universities and research centers around the world had been the prime actors in this developing revolution because nanotechnology research requires the skills of interdisciplinary teams that are most readily found in academia. What we are seeing today is a paradigm shift into the entrepreneurial arena. More and more pure researchers are getting involved in spinoff ventures that spring from the academic setting, and there is a need for interdisciplinary knowledge that combines scientific and managerial skills. At the same time, managers who expect to become involved in near-term nanotechnology enterprises require basic knowledge of the wide range of current applications in this fascinating field.

This book is a valuable attempt to satisfy these objectives. Authors with diverse backgrounds offer insight and useful advice both to scientists who may be seeking to capitalize their nanotech research through the creation of a new venture and to managers who need to know how and why this unique technology domain is regulated. The book focuses strongly on the creation and monetization of the intellectual property related to nanotechnology inventions, starting from the conception of the patentable idea and progressing through the venture capital stage

and also nanotechnology regulation. The full pipeline of presentday nanotechnology is examined through the expert eyes of patent attorneys, professors, regulation experts, managers, and scientists, with helpful comparisons of IP issues in the United States and Europe.

I have found this volume to be very useful in my own work. Anyone who is interested in starting a nanotechnology-based venture or who wishes to understand how to manage one should read this book to become more aware of the opportunities and challenges that nanotechnology will bring into our lives.

Robert A. Freitas Jr.

## **Preface**

Nanotechnology will have a large impact on our future, but a lot of research and development (R&D) projects have yet to be conducted. This R&D will require extraordinary efforts from individuals and groups in universities, research institutes, and the industry. Unfortunately, scientific genius does not always equal commercial success. In order to benefit commercially from one's research, or even to prevent others from obstructing research, a myriad of factors need to be taken into account. Many of those, for example, environment, health and safety regulations, academy-industry cooperation, intellectual property, and attracting investments, come into play well before and during the research process. This book intends to provide the reader with the basics of the most relevant factors that need to be taken into account before. during, and after the R&D phase. Although some of the subjects discussed are highly complicated, the authors have written the chapters in a way that makes them understandable for professionals who are not familiar with the topic at hand.

The nanoscale brings many challenges to scientists who deal with it. Some of its unique characteristics also pose challenges in the process of commercialization. This book discusses these nanospecific challenges. While most chapters and parts of chapters are nano-specific, others are of a more general nature, either because a more general discussion is needed in order to understand the nanospecific part or because, despite not being nano-specific, they are essential in the commercialization process.

To provide our readers with the best possible information, we relied upon the expertise of a great and diverse team of authors: Joanna Brougher, Niklas Bruun, Rachel Buchanan, Bärbel Dorbeck-Jung, Michael Heintz, Kaarle Hämeri, Efrat Kasznik, Michael Landau,

Hanna Laurén, Claes Post, Sarah Rouse, Christine Smid, Marco Spadaro, Ennio Tasciotti, Pekka Valkonen, Pieter de Witte, and Po Chi Wu. We wish to extend our deepest gratitude to them for sharing their expertise and for their commitment and diligence during the entire process.

We are also very grateful to Stanford Chong, the publisher of this work, and to his editorial team for having made the realization of a book with so many authors a smooth and enjoyable experience.

> Wim Helwegen and Luca Escoffier Helsinki and Tokyo September 2011