

TreMonti

Technology Transfer

Relating Commercial Interest to Scientific Research

Heidjer Staecker, J.D., LLM
TreMonti Consulting LLC
9302 Lee Highway, Suite 306
Fairfax, VA 22031
Tel: 703-352-1827
www.tremonticonsulting.com

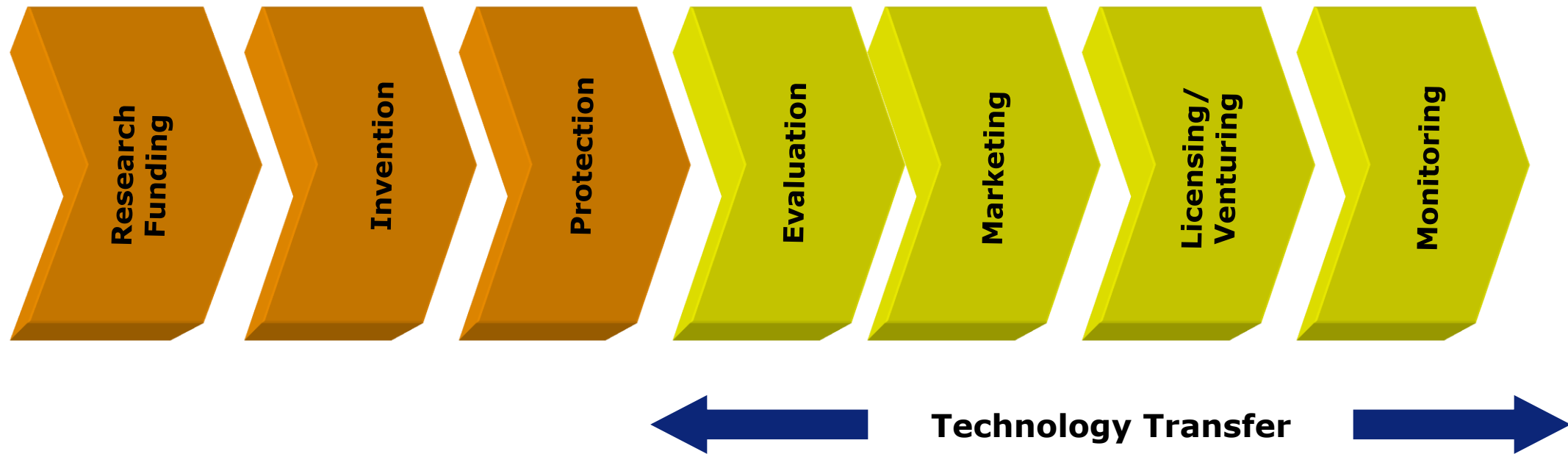
What is Technology Transfer?

- Technology transfer is a term used to describe a formal transfer of rights to use and commercialize new discoveries and innovations resulting from scientific research to another party.
- Benefits:
 - Leads to new products and services that improve our quality of life.
 - Adds billions of dollars to the U.S. economy
 - Supports hundreds of thousands of jobs.
 - Creates new businesses, industries and markets.
- Statistics:
 - In 2007, through university technology transfer efforts, 686 products were introduced and 555 start-up companies were established during the year — an average of 13 products and 10 start-ups per week.

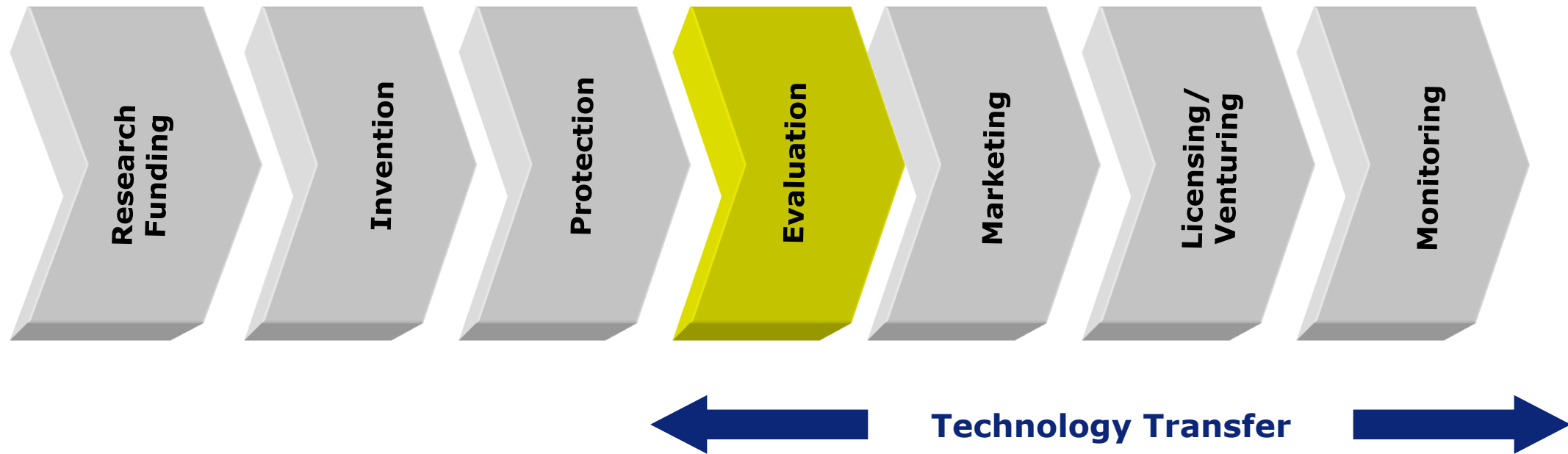
How Do Universities Commercialize Their Technologies?

- Universities typically transfer technology through protecting (using patents and copyrights) then licensing new innovations.
- Ways to transfer
 - License
 - Sell
 - Spin Out
 - Give it away
- Identify potential commercial partners
 - Research Sponsor
 - Contact by Licensee
 - Marketing
 - Attending Industry Events

What are the Stages Technology Development?



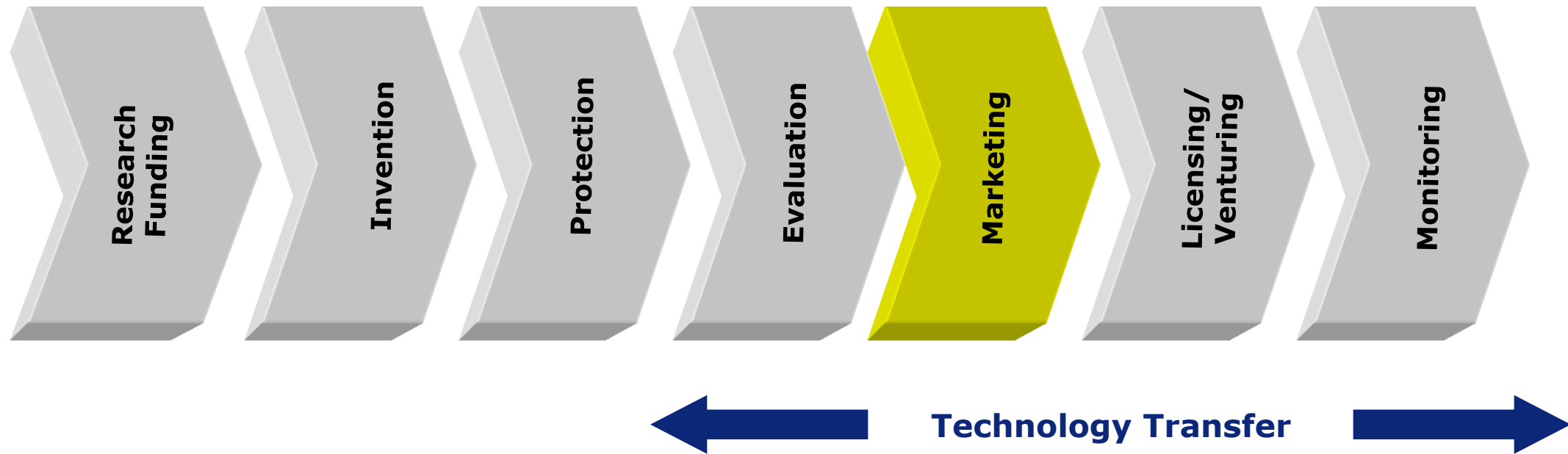
What are the Stages of Tech Transfer?



Evaluation

- **Technologies that are disclosed need to be evaluated for commercial potential**
 - What is the commercial potential?
 - What problem does the technology solve?
 - How is the technology an improvement over the state of the art?
 - What are the economic issues?
 - Cost of commercialization vs. Economic benefit
 - Economic vs. social benefit
- **Not every disclosure has commercial potential**

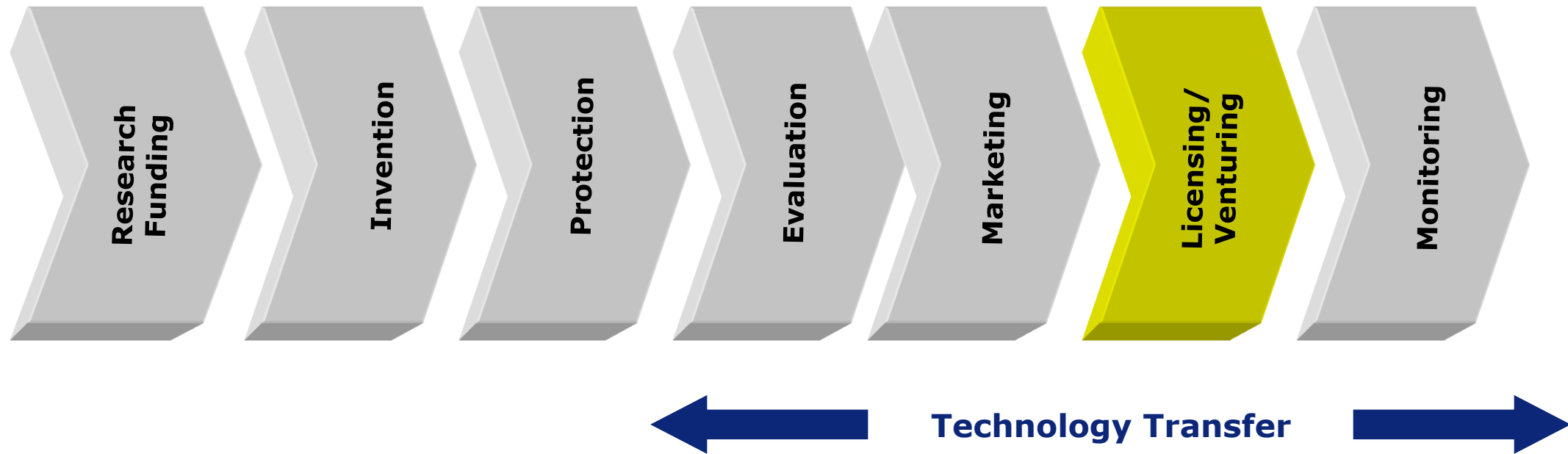
What are the Stages of Tech Transfer?



Marketing

- **Means of marketing**
 - Existing relationships
 - Direct Marketing
 - Websites
 - Industry Meetings
 - Social Networks
- **Information provided**
 - Confidential v. Non-confidential
 - Why do you need a CDA/NDA?

What are the Stages of Tech Transfer?



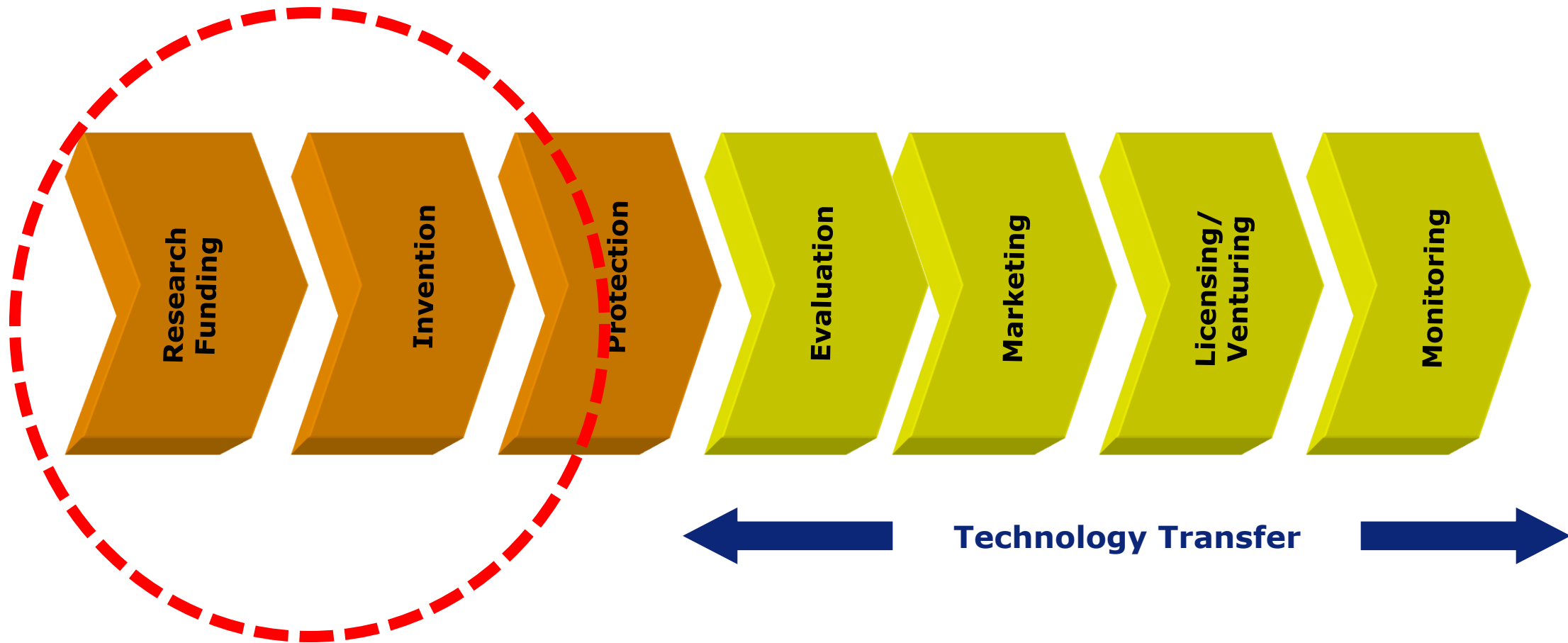
Forms of Technology Transfer

- How can rights be transferred?
 - Sale of IP rights
 - License of IP Rights
 - License of Know-How
- License agreements are the most common way to transfer rights
- “Spin Out”
 - Start up company’s still need a license

Overview of Licensing Agreements

- Contract transferring IP rights to third party
- Important sections:
 - Grant – What is being transferred?
 - Territory
 - Royalties & Milestones
 - Return of Rights
 - Research Rights
 - Publishing Rights
- Sponsored Research

Early Stages



Philosophy of Research

- Why are you doing research?
 - Answer questions
 - For profit / scientific interest
- Who is the funding agency?
 - Government?
 - Not for profit?
 - Industry?
 - Institution?
- What is their interest?
- End Goals – Results, Publication and/or Patent
 - Not exclusive
 - Different purposes

Role of the Researcher

- Develop research goals
- Find funding to support research
 - Traditional federal grants and others (foundations, etc.)
 - Corporate sponsored research
- Corporate sponsored research can align with your research goals
- Collaborators can be potential licensees and vice versa

Invention

- When do you have an invention?
 - Scientific/technical breakthrough
 - Concept or reduction to practice
 - Doesn't have to be a "big ticket" item
- Should you disclose?
 - Yes
 - Are there potential commercial benefits to the discovery?
 - Better, Faster, Stronger, Cheaper, Greener
 - Talk to the TTO
- Scientific breakthrough \neq Commercial opportunity

Research + Invention = Opportunity

- Publication
- Licensing opportunities
 - Especially if already funded by potentially interested party
- Corporate sponsored research
 - Are there potential commercial benefits to the discovery?
 - Better, Faster, Stronger, Cheaper, Greener
 - Talk to the TTO
- Scientific breakthrough \neq Commercial opportunity

Relating Research to Commercial Opportunity

- Not at odds with “science as search for knowledge”
- Assess from a research funding standpoint, not from a license product standpoint
- Assess from funding entity’s viewpoint
- How are your research results going to affect your field?
- If you validate your hypothesis, what does it mean in the long term?

Roles of Research Office/Inventor

- Research Office
 - Communicate
 - Assist in finding commercial opportunities
 - Assist with patent and marketing process
 - Provide sounding board and support for the inventor
- Inventor
 - Communicate
 - Talk to the Research Office before publishing
 - Interact with commercial partners

Q&A
