



Technology Transfer Office requirements

Jacqueline Barnett

Michelle Mulder

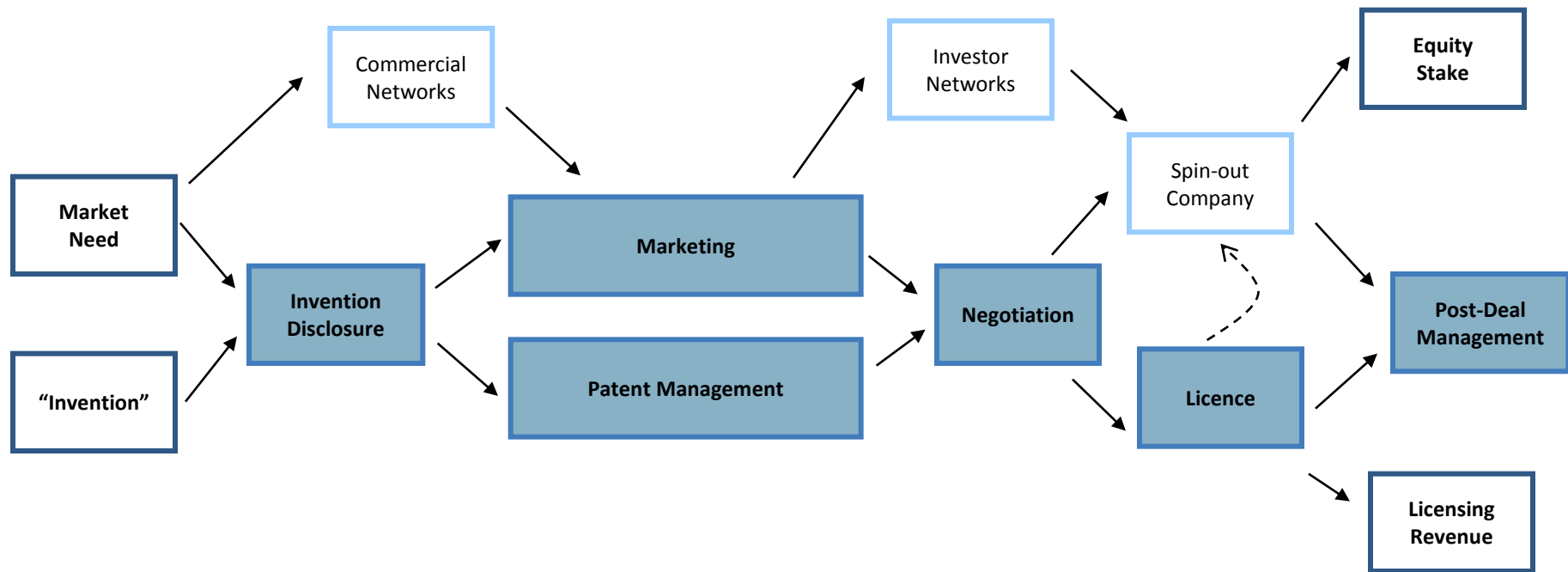
SARIMA

Weaving research into the fabric of society

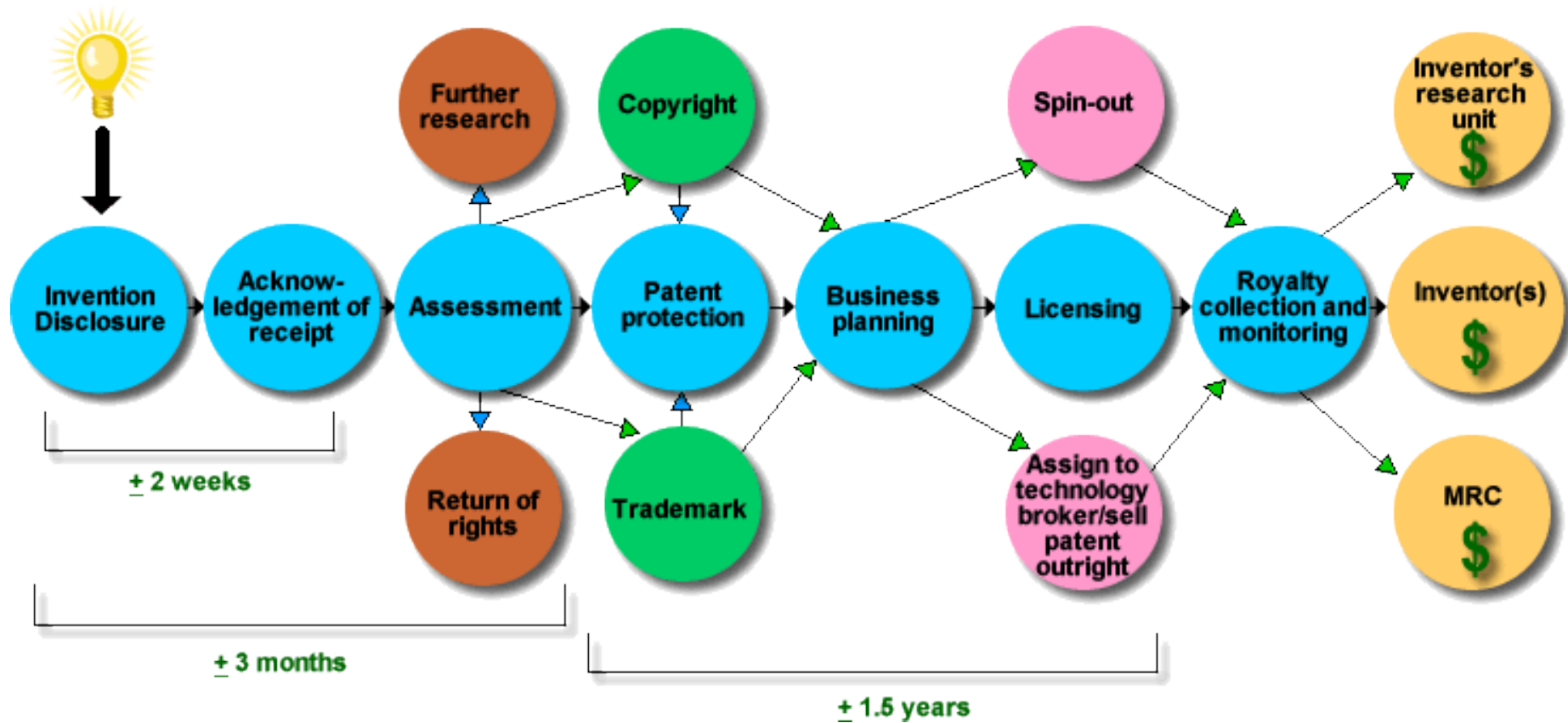


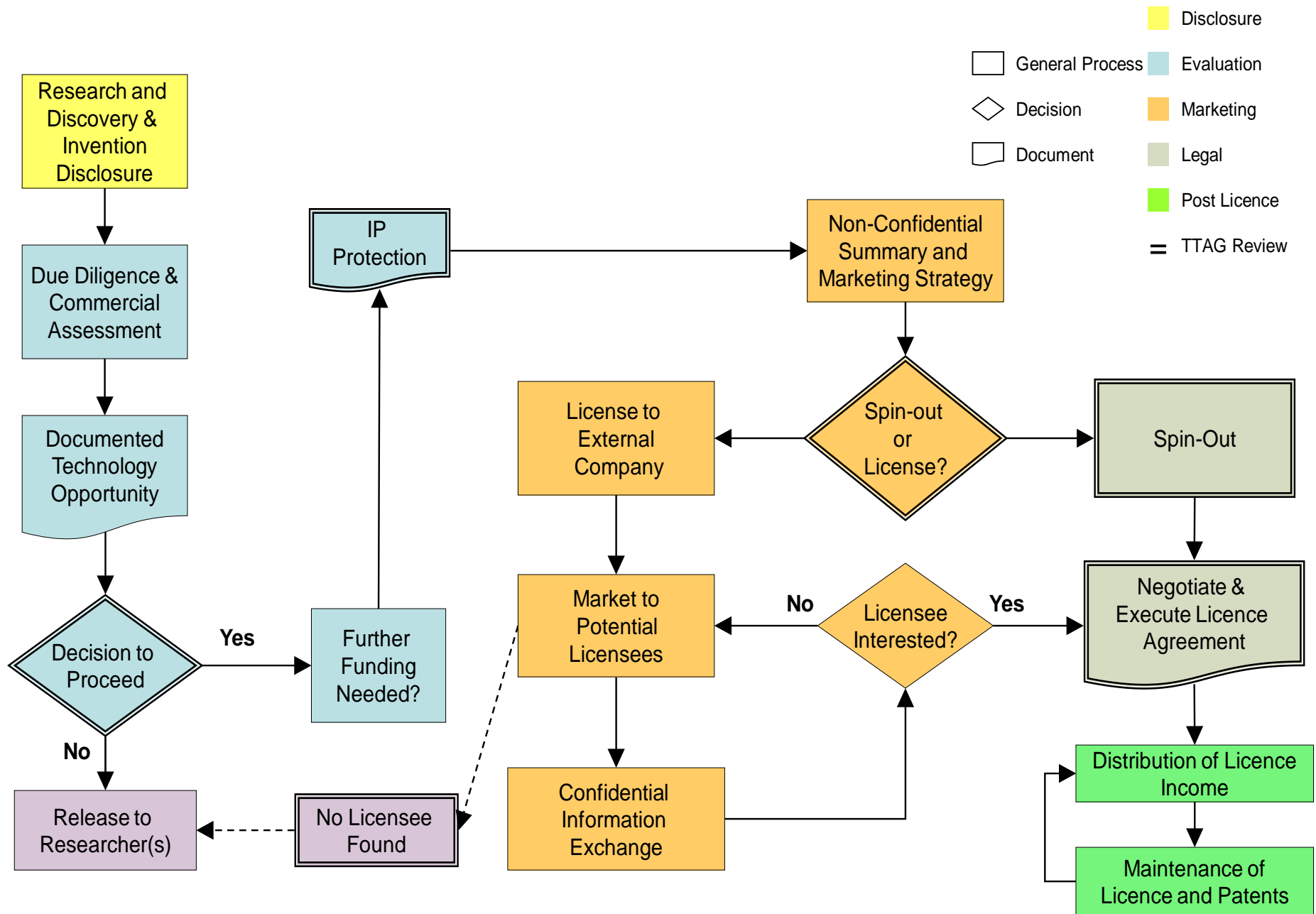
Overview of systems and procedures

Technology transfer process



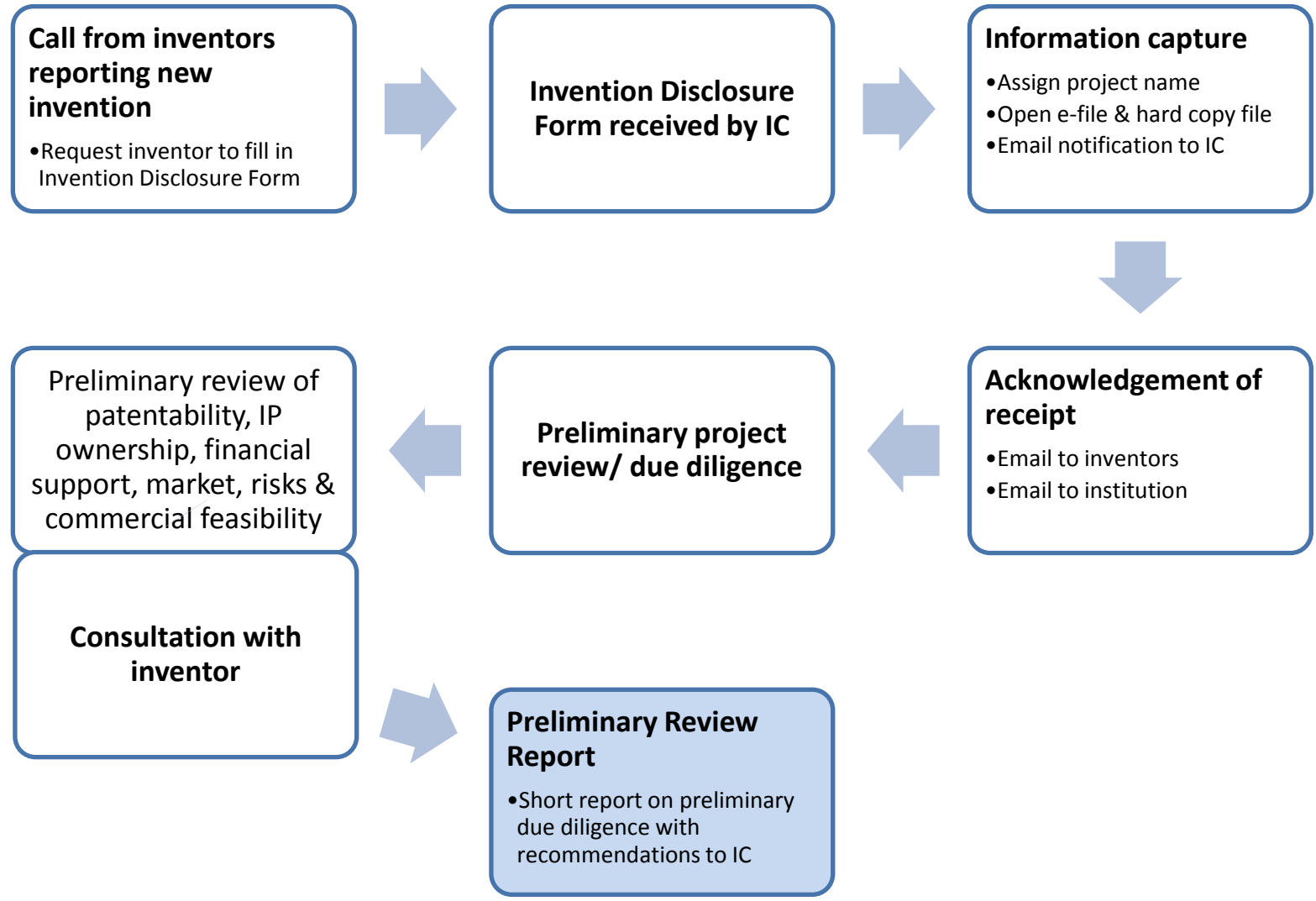
Technology transfer processes



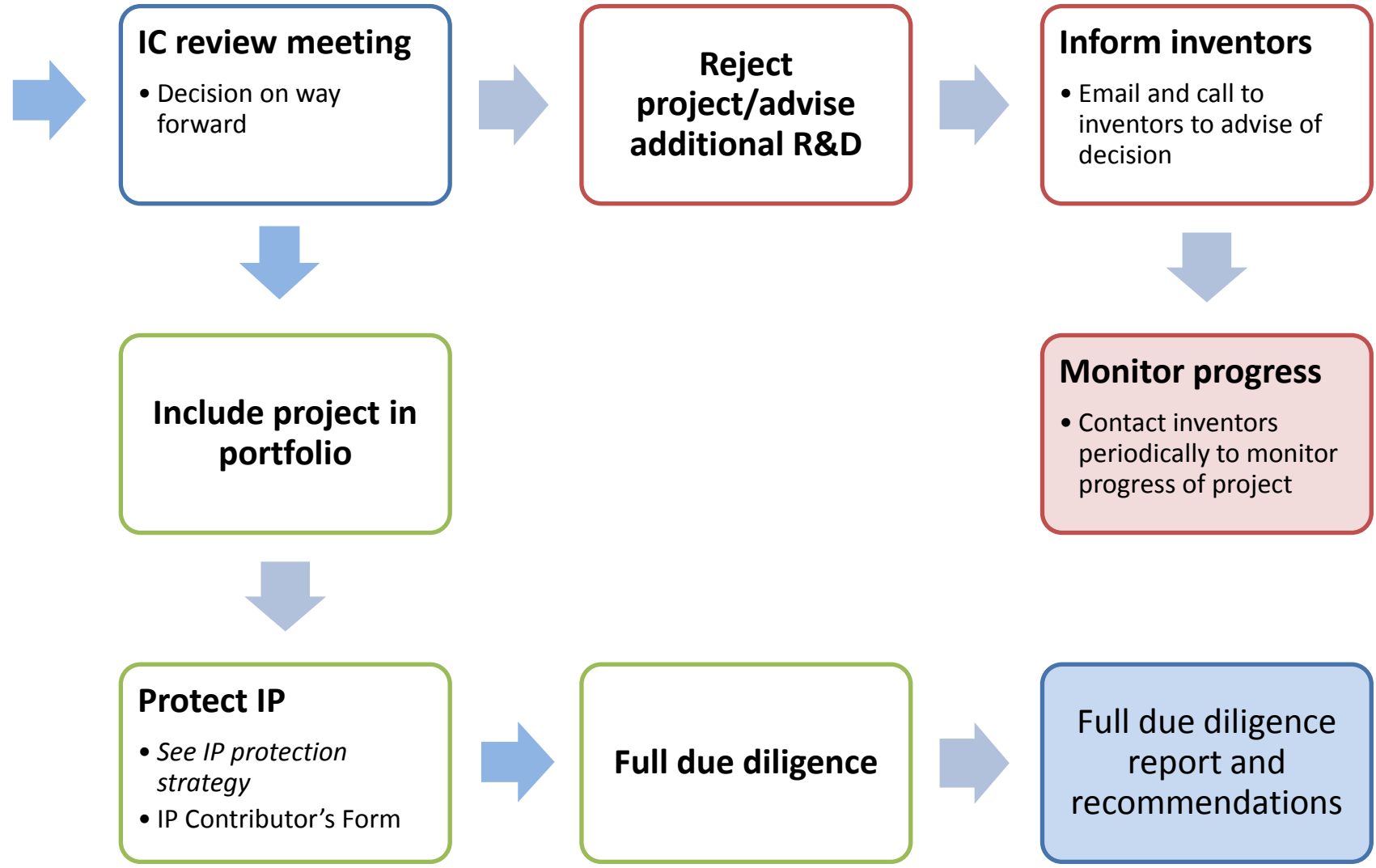




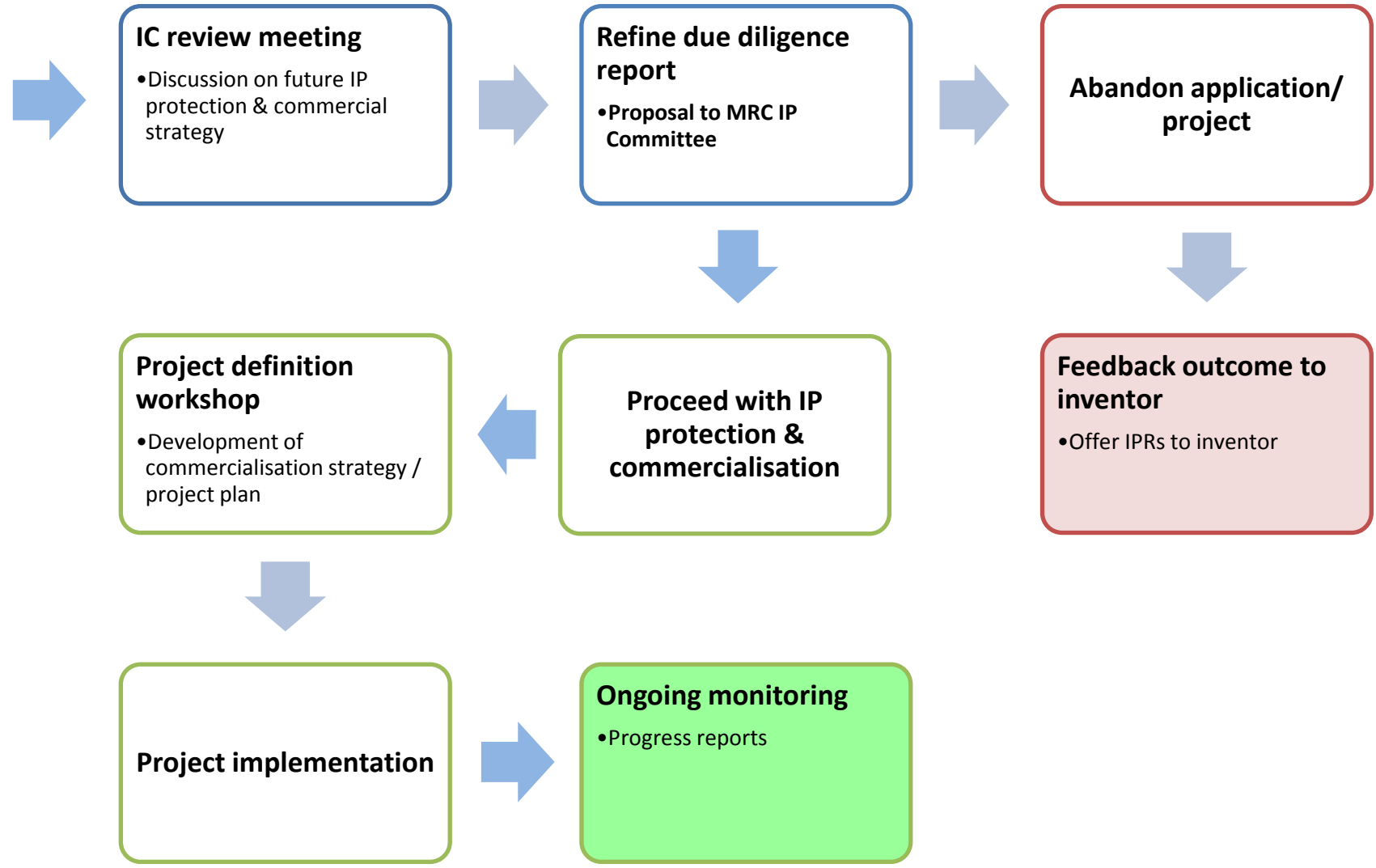
Process overview



Process overview



Process overview



Disclosures: create awareness

- If the TTO is to manage the IP Portfolio, it must know what the institution is doing.
- Need a clear process for disclosing new IP that might be patentable
 - Is this information centralised?
 - Meetings with Research Centre Directors?
 - Visits to all researchers?
 - Internal “call for disclosures”?



What is a disclosure?

- Questions to ask:
 - Is it new?
 - Does it have advantages?
 - Can it be applied and by whom?
 - Can it be patented?

- If all answers are NO, it is not a disclosure

TTO Requirements

- **Information management system(s) and infrastructure**
- **Documents**
 - **Invention disclosure forms**
 - **Assessment checklist**
 - **Due Diligence report**
 - **IP Contributors Form**
 - **Template Agreements**
 - **Information for Researchers**



Information Management

Why?

- Record keeping
- Internal and external reporting
- Meet deadlines – e.g. patents
- Financial management
- Relationship management
- Support the essential tasks of the TTO
- Informed decision making
- Efficient management of assets



Information Management

What?

- Invention disclosures, inventors etc.
- IP protection – patent information
- Expenditure
- Due diligence results & decision making
- Marketing efforts - potential partners
- Agreements concluded
- Income
- Benefit sharing
- Spin-out details
- Important contacts



Information Management

How?

- **Hardcopy – filing system**
 - **Invoices**
 - **Signed forms**
 - **Signed agreements**
 - **Patent documents**
- **Electronic**



Information Management Systems

Minimum Requirements

- Excel Spreadsheet

Generate your own – add fields as required –
problem with multiple users

Preferable

- Secure – user login, access levels
- Preferably web-based
- Workflow processes and alerts
- Electronic document management
- Report generation
- Relational databases
- Data integrity

In-house software development or purchase
a system – license fees



Information Management Systems

Example Systems:

- InfoEd – www.infoedglobal.com
- Inteum - www.inteum.com
- Sophia - www.wellspringworldwide.com
- Pro-TT - www.pro-tto.com



Documentation

Why?

- **Consistency**
- **Forms part of systems & procedures**
- **Streamline processes**
- **Provide information**



Documentation

What?

- **Invention disclosure form**
- **Assessment checklist**
- **Due Diligence report**
- **IP Contributors Form**
- **Template Agreements**
- **Information for Researchers**



Invention Disclosure Form

Purpose: For the inventor to disclose details of an invention to the TTO

Format:

- Electronic document
- e-Form that is part of an information management system

Approvals: May require sign off by Principal Investigator, Department Head etc. before submission to the TTO



Invention Disclosure Form

Information required:

- **Inventor contact details**
- **Brief description of the invention**
- **Invention's applications, uses, and markets**
- **Stage of development**
- **Novel aspects**
- **Novelty searches done**
- **Any public disclosure of the invention**
- **Any plans to publish or present the invention**
- **All contributors to the invention**
- **Any external collaborators or funders**



Invention Disclosure Form

Sample ID Forms

- <http://innovation.mrc.ac.za/invention.htm>
- http://www.innovus.co.za/media/documents/Disclosure%20form%202012_eng.pdf
- <http://www.rcips.uct.ac.za/ip/overview/>
- <http://techtransfer.nmmu.ac.za/IP-Management-and-Commercialisation/Processes>
- http://tech.uchicago.edu/docs/uctech_inventiondisclosure.pdf
- http://www.ctt.upenn.edu/files/faculty/Online_Disclosure_Form.pdf



Assessment Checklist

Purpose: To conduct due diligence on an invention

Format:

- Electronic document
- Online tool

Benefits:

- Ensure all questions have been addressed
- Decision making tool – scoring of inventions
- Consistent criteria applied to all inventions
- Justification / explanation for inventors



Assessment Checklist

Areas to include:

- IP ownership
- IP novelty and protection options
- Inventors / team
- Technology
- Market
- Economic & social benefit
- Commercial feasibility (incl. finances)

Online tool:

- Easy to complete – checkboxes or score
- Automatic generation of final score
- No room for flexibility



Assessment Checklist

Sample Checklists:

- [Assessment Checklist.doc](#)
- [Comm assess checklist.doc](#)
- [Interview with Inventors.doc](#)
- TechAdvance
- SA MRC tools



Due Diligence Report

Purpose: To summarize the findings of the due diligence assessment and provide recommendations for taking the invention forward

Format:

- Electronic document - narrative

Benefits:

- Decision making tool
- Document trail for the invention
- Justification for decision (management & inventors)



Due Diligence Report

Areas to include:

- Value proposition
- Description of invention
- Market information
- IP position
- Product development requirements
- Commercialization options
- Inventors/team
- Economic & social benefit
- Possible obstacles
- Conclusion and recommendations



Due Diligence Report

Sample DD Report:

- [5-Full Due Diligence Report.doc](#)



IP Contributors Form

Purpose: To determine the percentage contribution to the invention by all IP creators and “IP enablers” and the benefit sharing proportions

Format:

- Electronic document – signed hardcopy

Considerations:

- All contributors must be listed and must agree
- Get it signed preferably before patenting
- Re-evaluate at the time of commercialization



IP Contributors Form

Content:

The creators/enablers of the following invention [*insert invention title & number*]: _____ do hereby agree to the following distribution of the portion due to the IP creators/enablers:

INVENTOR'S NAME	INSTITUTIONAL AFFILIATION	NATURE OF CONTRIBUTION	PERCENTAGE CONTRIBUTION

In Witness thereof, the creators have hereto accepted this Intellectual Property Contributors Form in duplicate originals, by their signature.

Creator/Enabler

Date



Template Agreements

Purpose: Templates from which to draft various agreement types

Format:

- Electronic documents

Considerations:

- Saves time in drafting agreements
- Every agreement is different and should be customized to the situation
- Final draft should be checked by a lawyer



Template Agreements

Examples:

- **One-way confidentiality agreement**
- **Two-way confidentiality agreement**
- **Material transfer agreement**
- **Consultancy agreement**
- **Research Collaboration agreement**
- **License agreement**
- **Option agreement**
- **Shareholders agreement**



Template Agreements

Sources:

- <http://www.ipo.gov.uk/whyuse/research/lambert/lambert-mrc.htm>
- <http://contracts.onecle.com/type/220.shtml>
- <http://www.urmc.rochester.edu/technology-transfer/inventors/Forms-Agreements.cfm#CDA1>
- <http://invent.ucsd.edu/industry/sample-licenses.shtml>



Information for Researchers

Purpose: To raise awareness among researchers on IP and commercialization and what they entail, issues they need to be aware of in the course of their research, and the services offered by the TTO

Format:

- Electronic and hardcopy manual
- Website
- Brochure
- Newsletters
- Presentations



Information for Researchers

Information to include:

- Information on the TTO and what it offers
- What is IP?
- What is technology transfer?
- IP protection (patents, copyrights etc.)
- Evaluating/assessing IP
- The commercialization process
- Commercialization routes
- IP considerations in research
 - Confidentiality
 - Transferring materials
 - Protecting before publishing
 - Good laboratory practice (notebooks)
 - Getting involved in commercialization



Information for Researchers

Sample inventor guide:

- [guideforinventors.pdf](#)



TTO Requirements

Databases, Information Sources & Online Tools



Databases, Information Resources & On-line Tools

General considerations:

- Make use of free online resources as far as possible
- Most subscription tools & databases have far more functionality that you will need
- Look at joint or national licenses or subscriptions
- Build up repositories of information that can be reused and shared (especially due diligence information and sources)
- Develop a tools database



Patent Searching

Free databases:

- <http://www.wipo.int/patentscope/en/dbsearch/>
- <http://patft.uspto.gov/>
- www.google.com/patents/
- <http://www.epo.org/searching/free/espacenet.html>
- <http://www.ipaustralia.gov.au/auspat/index.htm>



Patent Searching

Subscription databases:

- <http://www.delphion.com>
- <http://www.micropatent.com>
- <http://ip.thomsonreuters.com/product/derwent-world-patents-index>



Market Information

Free information:

- Google
- Departments of Trade & Industry
- Other National Government Departments
- Trade associations
- National Statistics Offices
- US Food and Drug Administration
- World Health Organization
- World Trade Database
- US Department of Commerce - National Trade Data Bank
- Market report abstracts



Market Information

Reports for purchase:

- Frost & Sullivan - www.frost.com
- Drug & Market Development - www.drugandmarket.com
- Dialog Corporation - www.dialog.com
- Ernst & Young - www.ey.com
- Market Guide Inc. - www.marketguide.com
- Mindbranch - www.mindbranch.com
- Datamonitor - www.datamonitor.com
- World Markets Research Centre – www.wmrc.com
- Marketsearch Directory - www.marketsearch-dir.com
- www.marketresearch.com



Tech Transfer Information

Online Resources:

- **MIHR-PIPRA IP Handbook**
- **AUTM Tech Transfer Manuals**
- **WIPO**



TT & IP Distance Learning

- WIPO Worldwide Academy:
<http://www.wipo.int/academy/en/index.html>
- SwiftOnline Workshops:
<http://www.swiftt.cornell.edu/ipcourse/>
- NIH Office of Technology Transfer:
<http://tttraining.od.nih.gov/>
- AUTM webinars: <http://www.autm.net>
- UNISA: <http://www.unisa.ac.za>



Technology Transfer Societies

- SARIMA: Southern African Research & Innovation Managers Association:
www.sarima.co.za
- AUTM: www.autm.org
- Auril: www.auril.org
- Indian Society for Technology Managers (STEM) (est. 2005)
- Licensing Executives Society: www.les.org



1. Introduction to SARIMA:



WHAT IS SARIMA?

Southern African Research & Innovation Management Association

Strengthening the research and innovation system to ensure the social and economic development of the region.

... to ensure that the excellent R&I currently being implemented in South Africa is translated into relevancy and public benefit... to the sustainable social and economic development of the region.

SARIMA service

- conferences, workshops, training
- networking, national, international
- publications, audio-visual, e-learning materials
- workshop groups, focus areas, staff exchanges



Support for Tech Transfer in Southern Africa

Innovation & Technology Transfer Portfolio

- Training courses on IP management and TT
- Information guides and manuals on IP and TT
- Facilitation of networking and sharing among TT practitioners
- TT Forum for discussion of common issues
- Facilitation of dialogue and cooperation on legislation affecting IP&TT

African Partnerships Portfolio

- Extension of SARIMA activities into Southern Africa

