Technology Transfer Office requirements

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SARIMA

Weaving research into the fabric of society
Overview of systems and procedures
Technology transfer process

- Market Need
- "Invention"
- Invention Disclosure
- Patent Management
- Marketing
- Negotiation
- Licence
- Spin-out Company
- Investor Networks
- Commercial Networks
- Equity Stake
- Post-Deal Management
- Licensing Revenue

ISIS, University of Oxford
Medical Research Council
Call from inventors reporting new invention
- Request inventor to fill in Invention Disclosure Form

Invention Disclosure Form received by IC

Information capture
- Assign project name
- Open e-file & hard copy file
- Email notification to IC

Preliminary project review/ due diligence

Preliminary review of patentability, IP ownership, financial support, market, risks & commercial feasibility

Consultation with inventor

Preliminary Review Report
- Short report on preliminary due diligence with recommendations to IC

Acknowledgement of receipt
- Email to inventors
- Email to institution
Process overview

- IC review meeting
  - Decision on way forward

- Reject project/advise additional R&D

- Inform inventors
  - Email and call to inventors to advise of decision

- Include project in portfolio

- Monitor progress
  - Contact inventors periodically to monitor progress of project

- Protect IP
  - See IP protection strategy
  - IP Contributor’s Form

- Full due diligence

- Full due diligence report and recommendations
Process overview

IC review meeting
- Discussion on future IP protection & commercial strategy

Refine due diligence report
- Proposal to MRC IP Committee

Abandon application/project

Feedback outcome to inventor
- Offer IPRs to inventor

Project definition workshop
- Development of commercialisation strategy / project plan

Proceed with IP protection & commercialisation

Project implementation

Ongoing monitoring
- Progress reports
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
  o Invention disclosure forms
  o Assessment checklist
  o Due Diligence report
  o IP Contributors Form
  o Template Agreements
  o 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
  o Invoices
  o Signed forms
  o Signed agreements
  o 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](http://www.infoedglobal.com)

• Inteum - [www.inteum.com](http://www.inteum.com)

• Sophia - [www.wellspringworldwide.com](http://www.wellspringworldwide.com)

• Pro-TT - [www.pro-tto.com](http://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.rcips.uct.ac.za/ip/overview/
- http://tech.uchicago.edu/docs/uctech_inventiondisclosure.pdf
- http://www.ctt.upenn.edu/files/faculty/Online_Disclosure_Form.pdf
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:

<table>
<thead>
<tr>
<th>INVENTOR’S NAME</th>
<th>INSTITUTIONAL AFFILIATION</th>
<th>NATURE OF CONTRIBUTION</th>
<th>PERCENTAGE CONTRIBUTION</th>
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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://www.ipo.gov.uk/whyuse/research/lambert/lambert-mrc.htm)
- [http://www.urmc.rochester.edu/technology-transfer/inventors/Forms-Agreements.cfm#CDA1](http://www.urmc.rochester.edu/technology-transfer/inventors/Forms-Agreements.cfm#CDA1)
- [http://invent.ucsd.edu/industry/sampl/licenses.shtml](http://invent.ucsd.edu/industry/sampl/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
  o Confidentiality
  o Transferring materials
  o Protecting before publishing
  o Good laboratory practice (notebooks)
  o Getting involved in commercialization
Information for Researchers

Sample inventor guide:

• guideforinventors.pdf
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://patft.uspto.gov/
- www.google.com/patents/
Patent Searching

Subscription databases:

- http://www.delphion.com
- http://www.micropatent.com
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

• 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
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