

Guidebook of IP/Technology Transfer

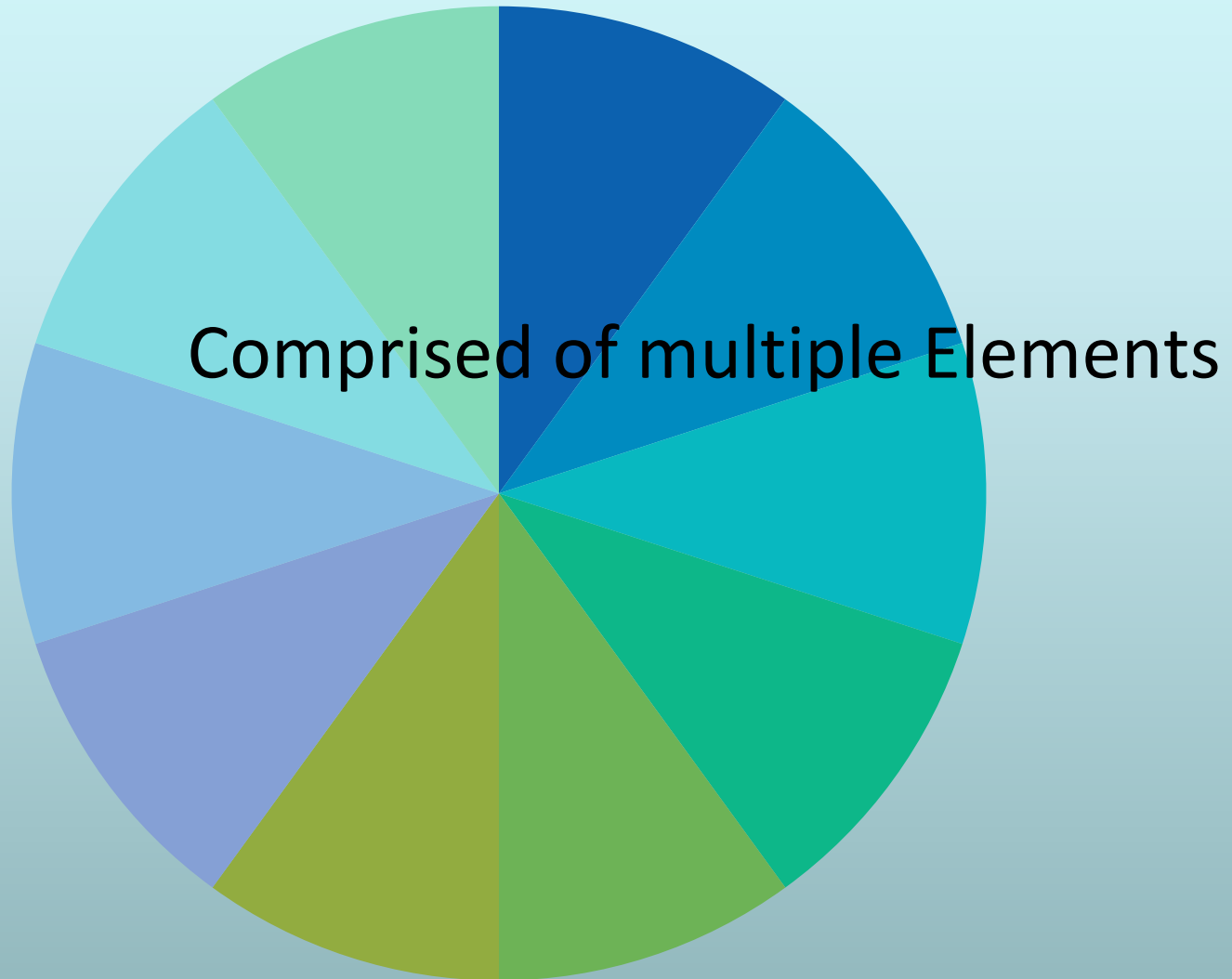
Track 1

Entry-level Tech Transfer Professional

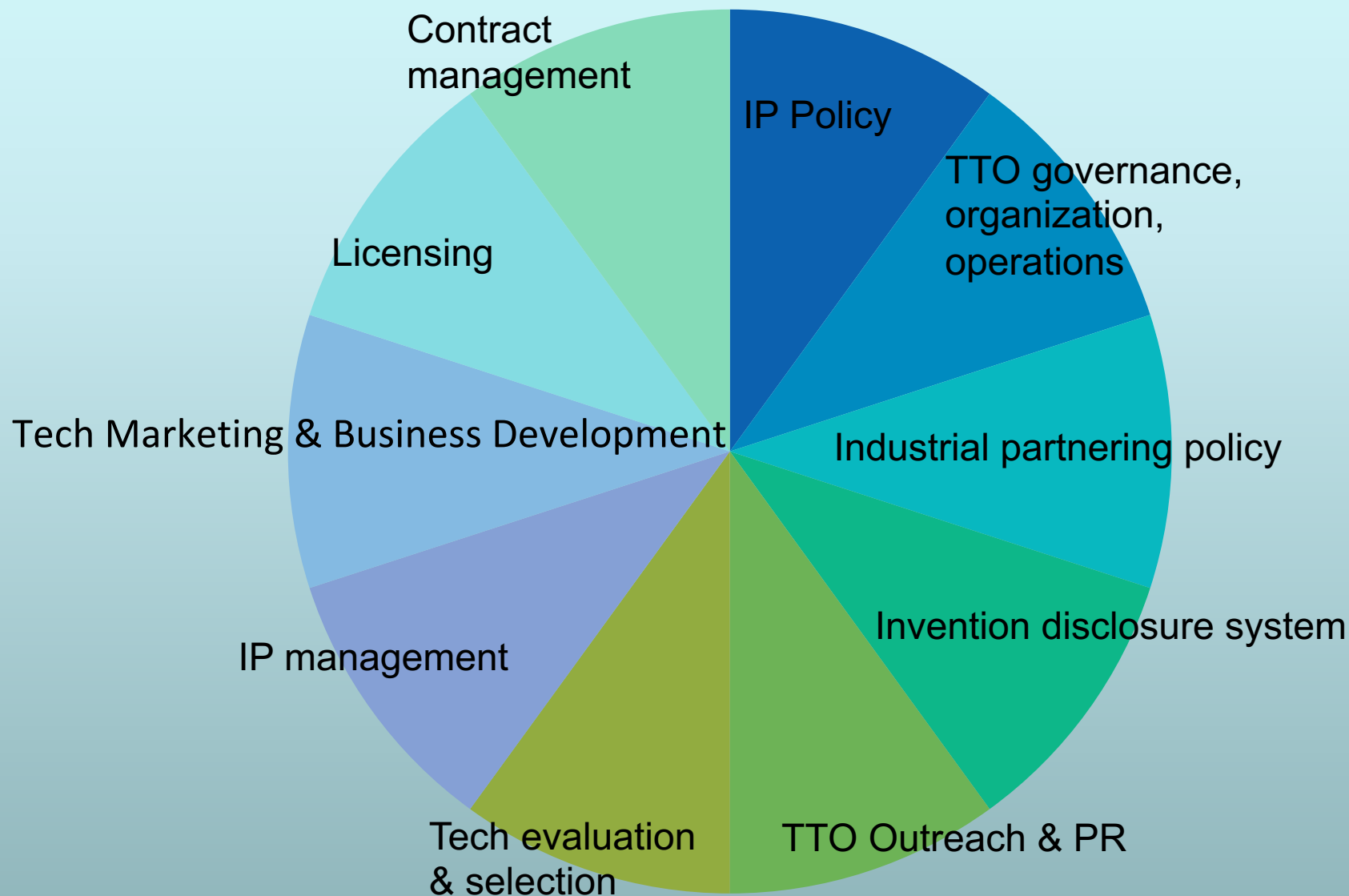
Topic 1.2

The Elements of Technology Transfer

The Technology Transfer System

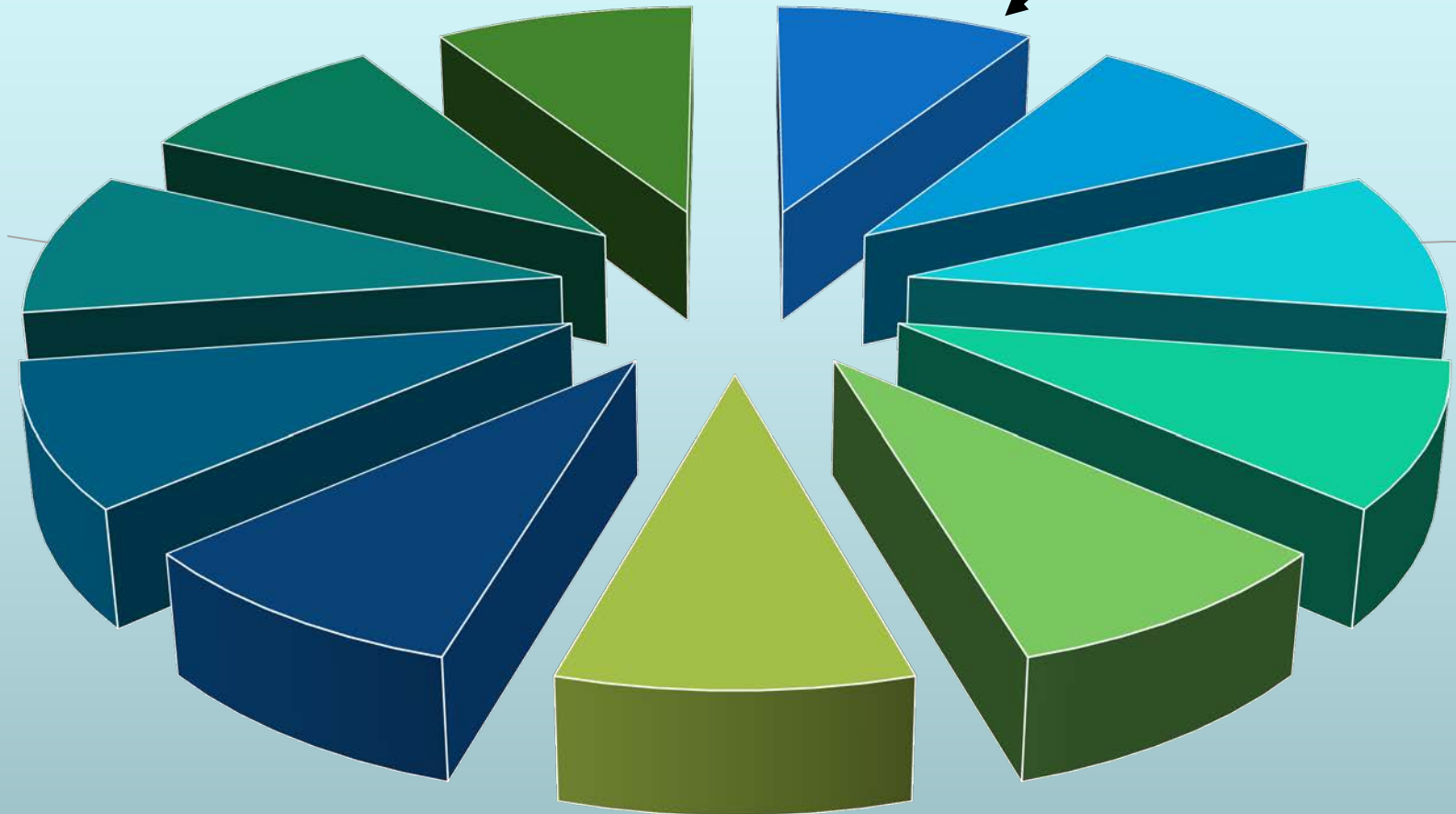


Technology Transfer System



Elements of Technology Transfer

Institutional
IP Policy

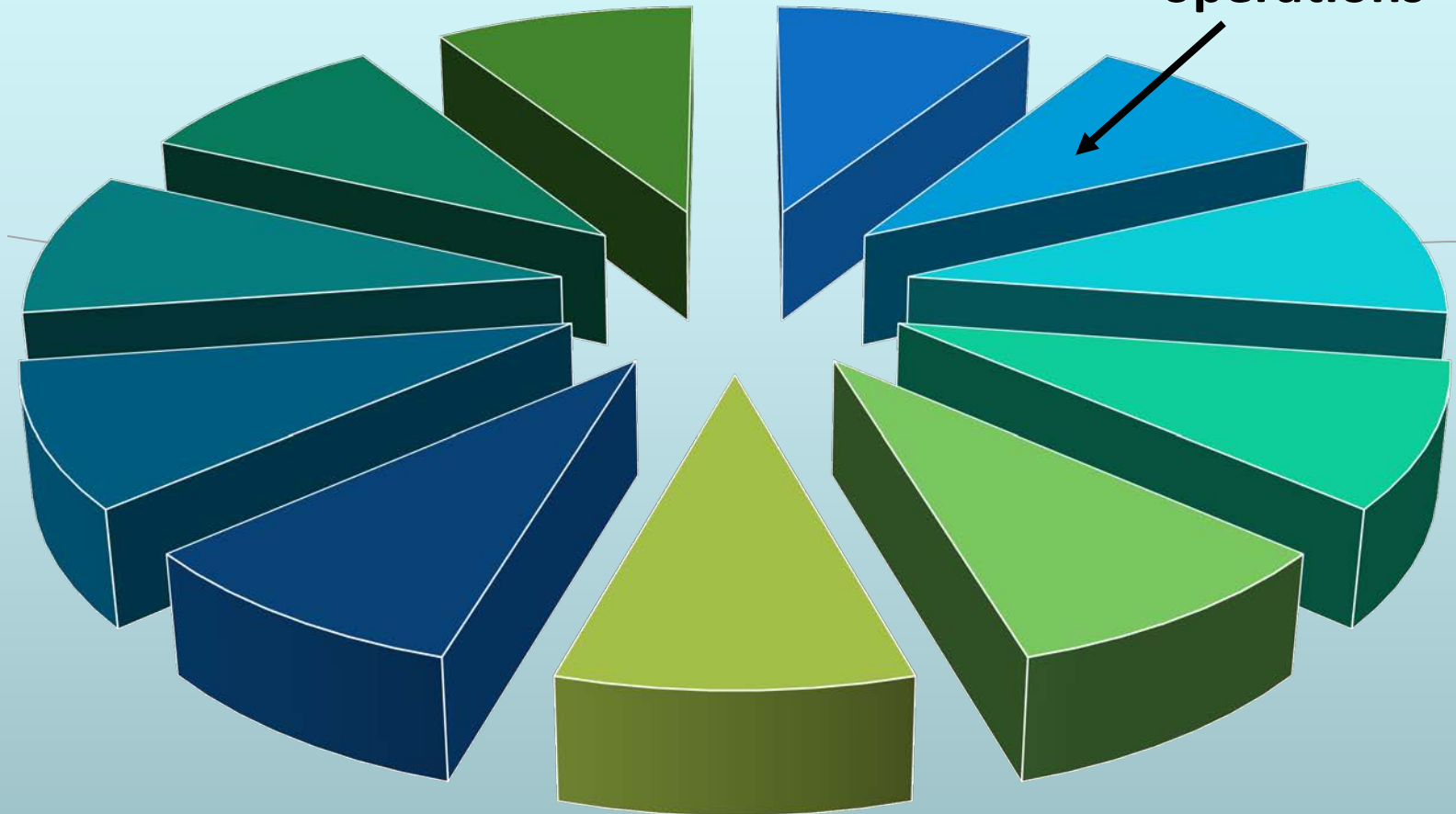


IP Policy

- The critical foundation of any, sustainable institutional IP-based technology transfer function
- Essential elements include:
 - purpose of the policy
 - personnel covered
 - ownership of IP
 - mechanisms of tech transfer
 - revenue sharing
 - academic freedom

Elements of Technology Transfer

TTO governance,
organization,
operations

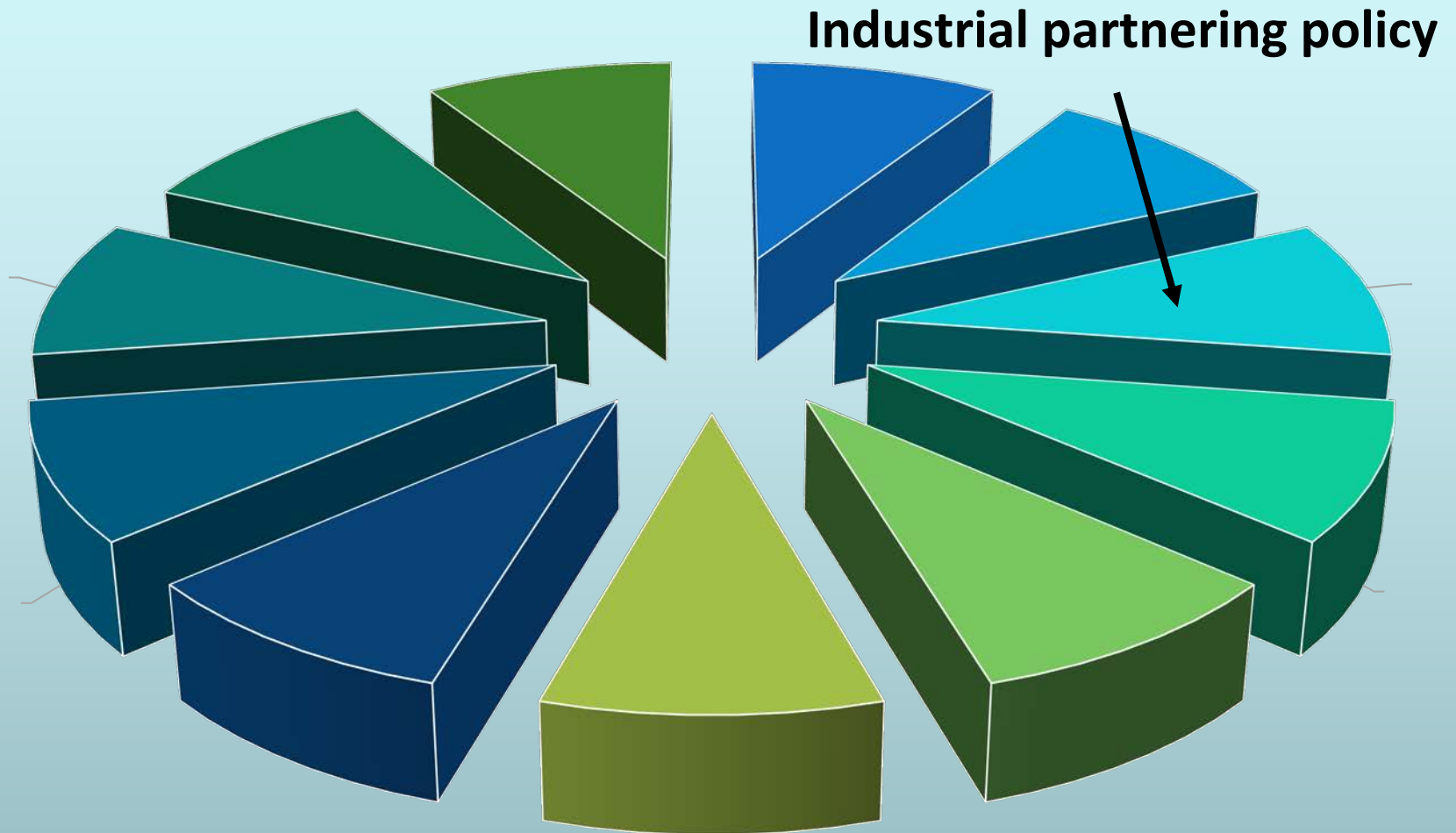


TTO governance, organization, & operations

8

- Institutional governance – not operational management – of tech transfer is essential
- IP/tech transfer committees or boards are common devices for TTO oversight
- Comprehensive policy and governance for entire institution – avoid exceptions
- TTO organization depends on research & IP activity
- Full-time director a primary goal
- TTO functions: IP management, tech marketing, licensing

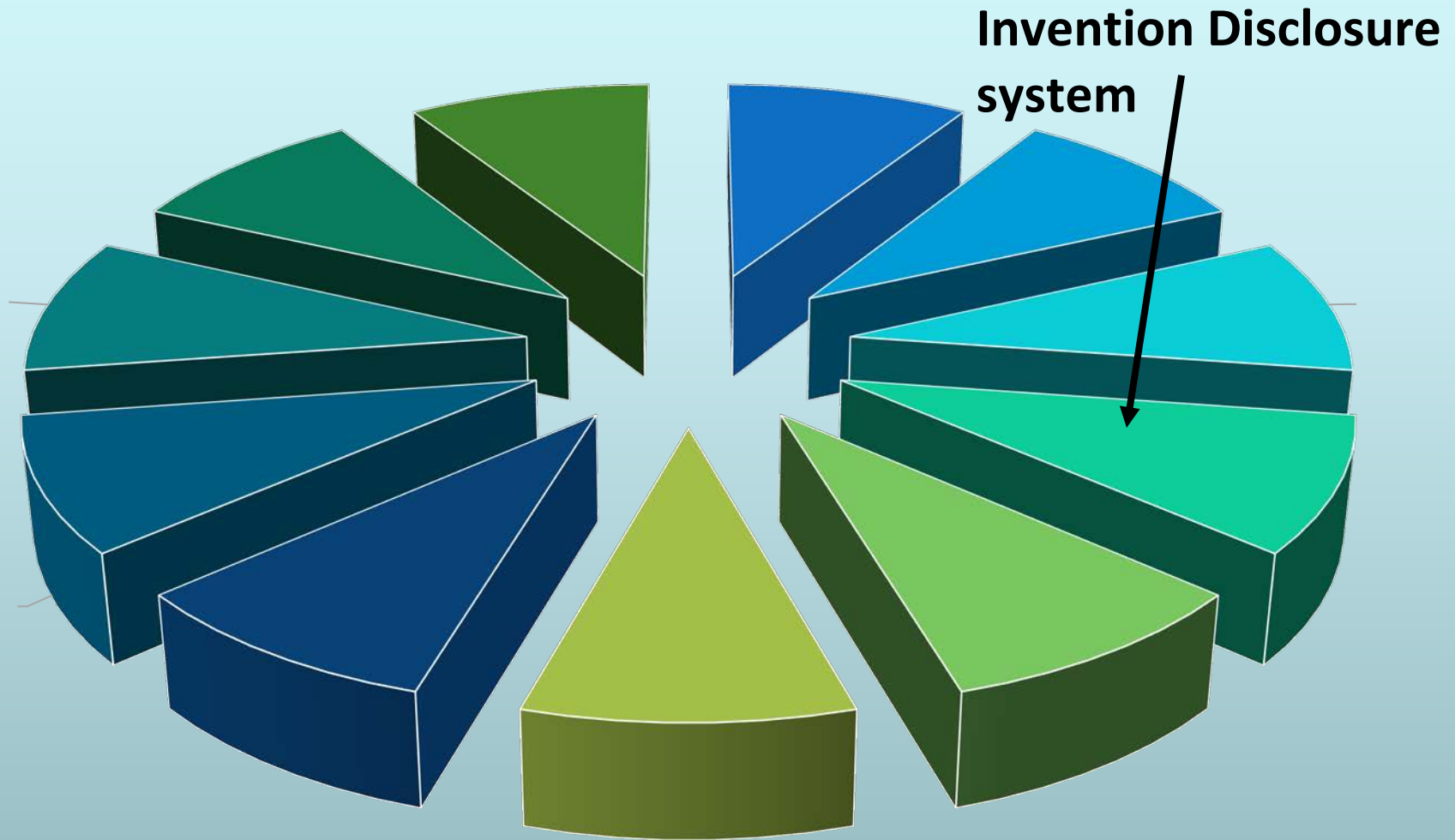
Elements of Technology Transfer



Industrial Partnering Policy

- Industrial partners essential element of technology transfer
- Partnering includes research contracts, licenses, consulting, etc.
- Partnering should be encouraged and promoted
- Institutional ownership of its IP is essential
- Flexible licensing of IP also important
- Institutions and industry have different goals but need each other
- Mutual trust and understanding crucial

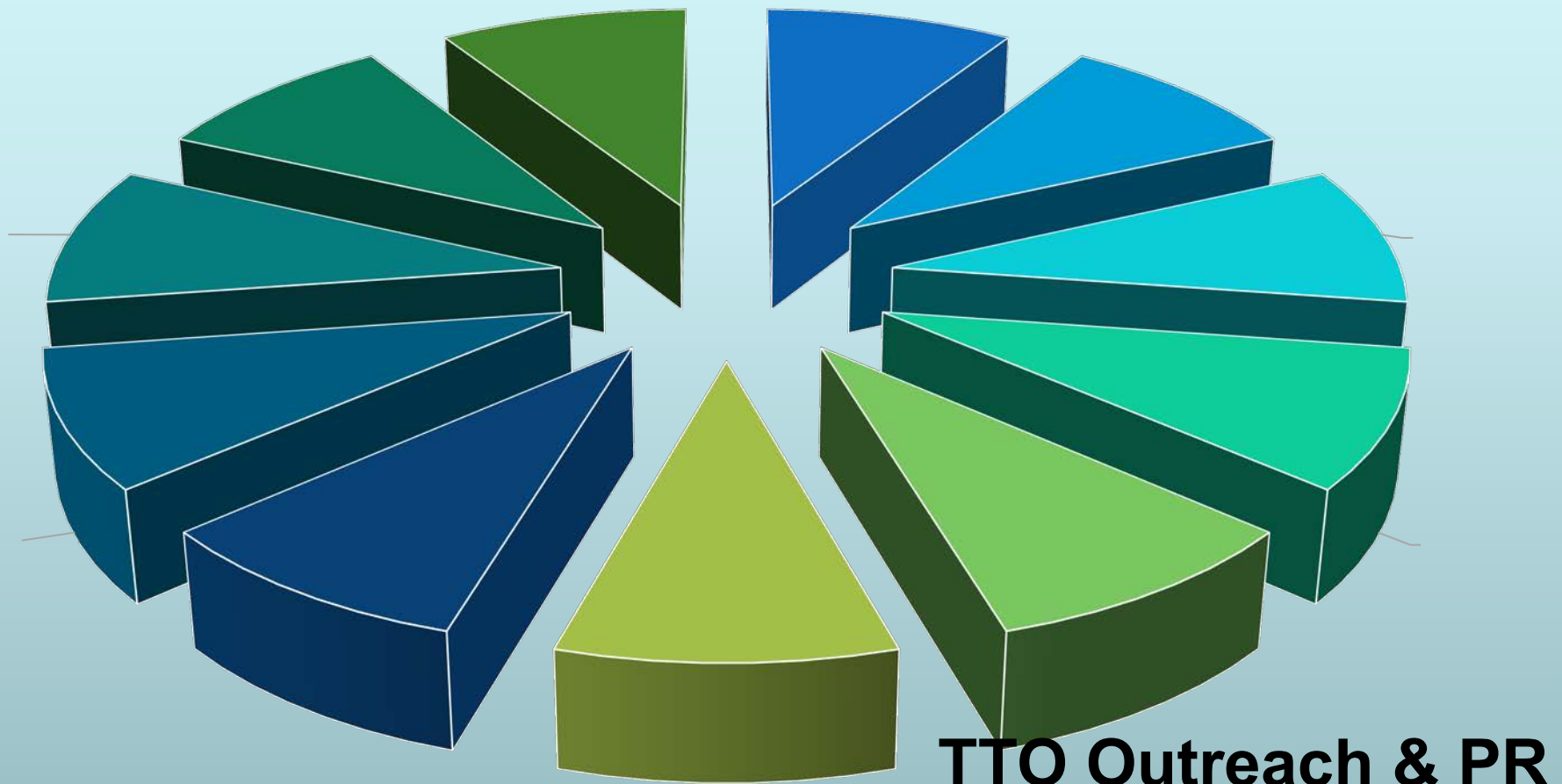
Elements of Technology Transfer



Invention Disclosure System

- Invention disclosure is the beginning of the tech transfer process
- A formal invention disclosure form and procedure is essential
- Invention disclosure documents should all be treated carefully, and potentially valuable
- Administrative analysis is important to satisfy contractual obligations, and other needs
- An effective record-keeping, tracking and monitoring system needed for disclosures

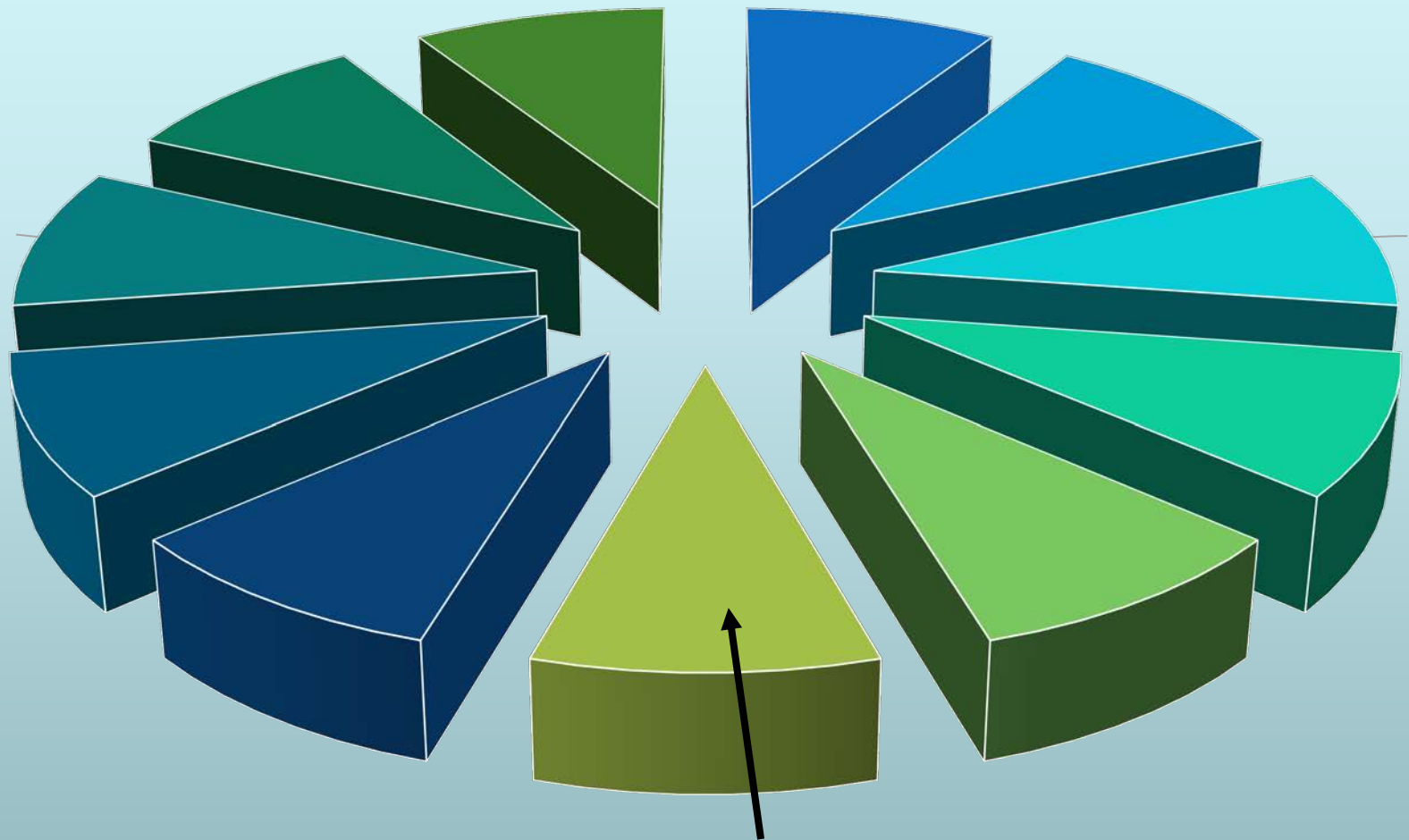
Elements of Technology Transfer



TTO Outreach & PR

- Long-term sustainability and success of the tech transfer function requires outreach and PR for the function *per se*, the TTO, and success stories
- Outreach to internal constituents, including potential faculty and staff inventors, and administrators
- Outreach to external, including local economic development, investors, entrepreneurs
- TTO should invest in some PR materials and activities

Elements of Technology Transfer

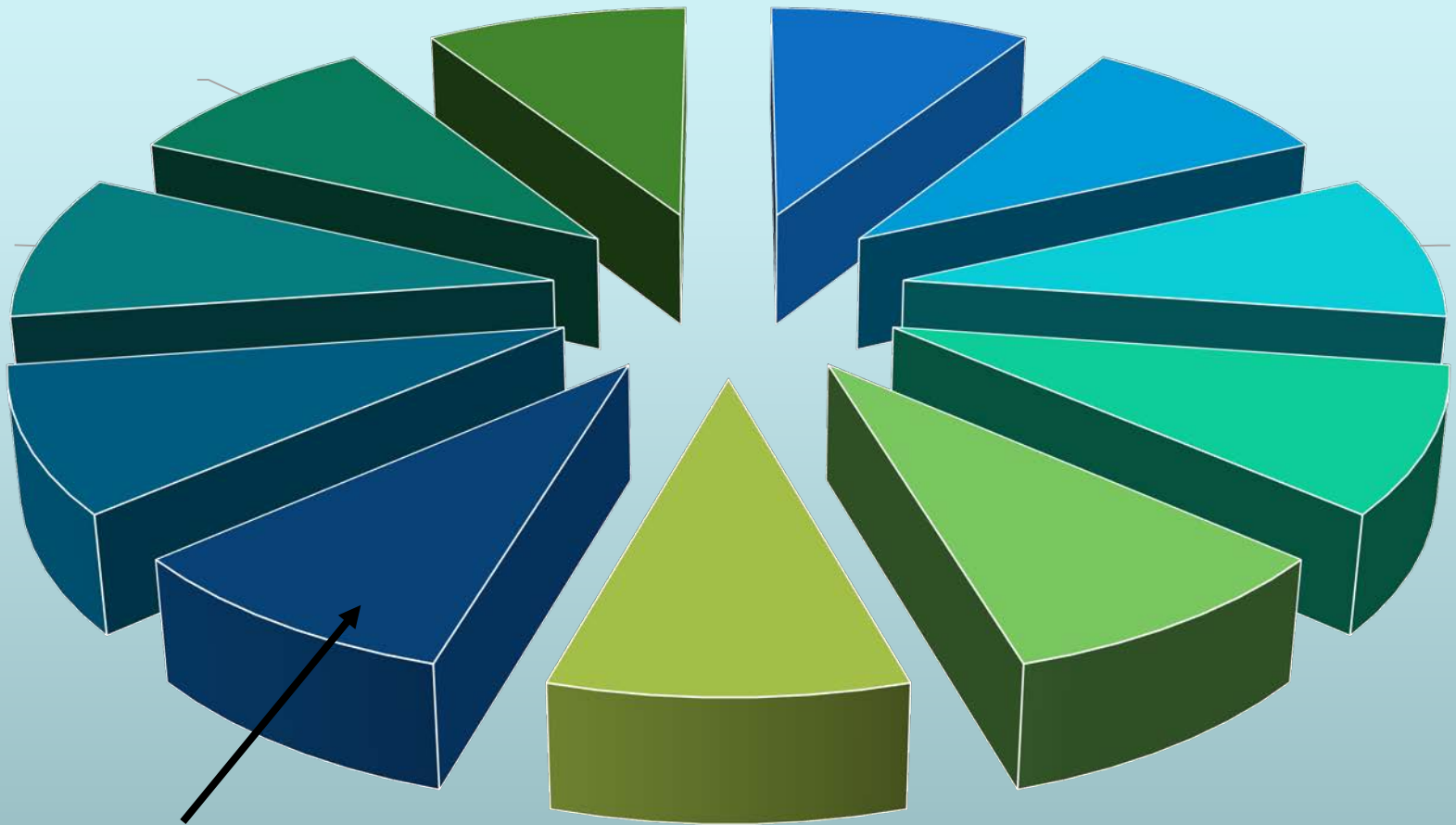


Tech Evaluation and Selection

Technology Evaluation & Selection

- Most inventions are not viable commercialization opportunities
- Evaluation and selection of inventions with some potential essential for long-term TTO sustainability and success
- Selection factors are varied, but most important are IP potential, inventiveness, and market relevance
- Typical PSRI invention selection rate <50%
- “Triage” is critical for successful TTO and tech transfer

Elements of Technology Transfer

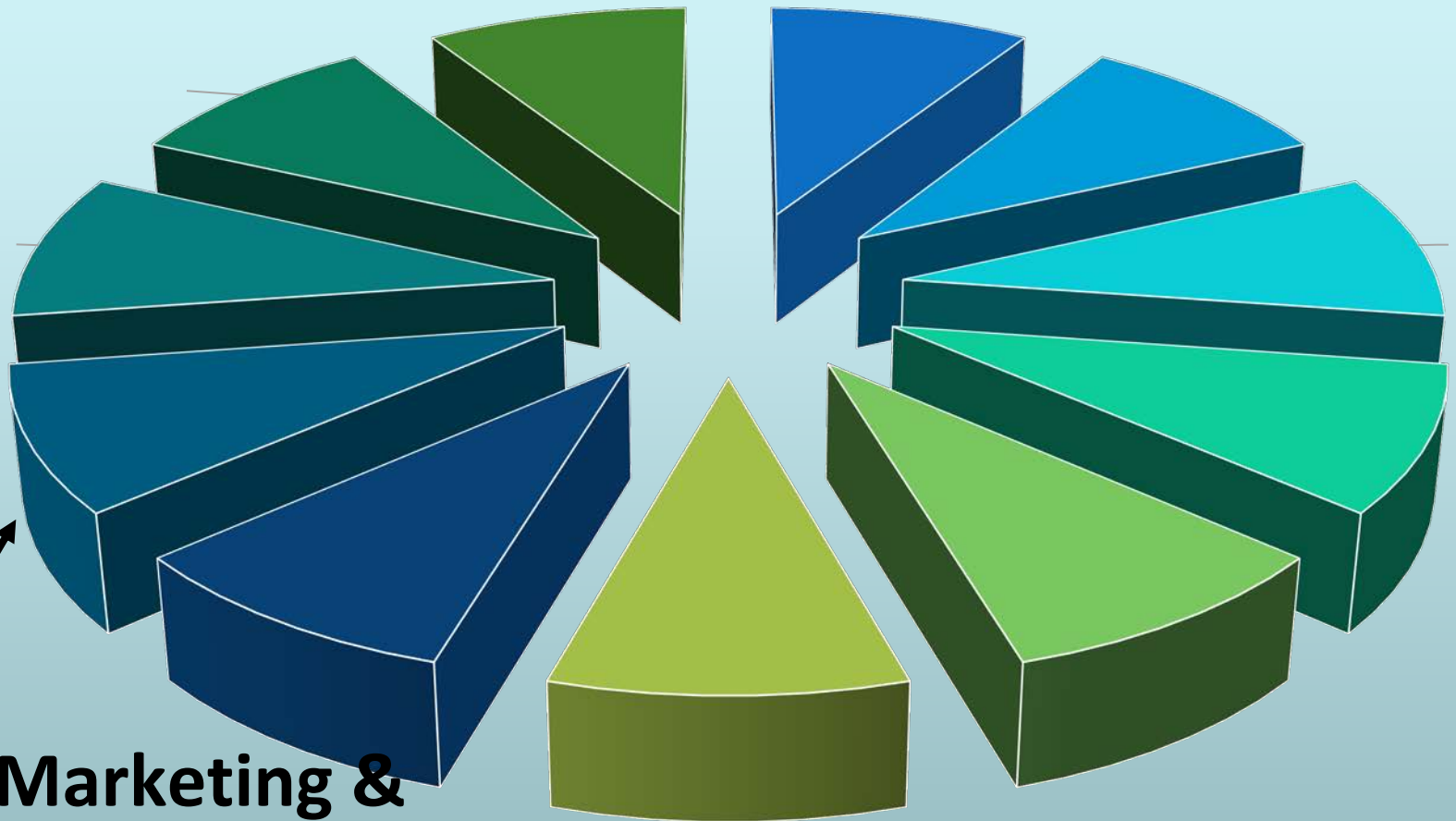


IP Management

IP Management

- Successful and sustainable IP-based tech transfer absolutely requires effective IP management
- TTO must manage the “IP suite” appropriate for each invention selected to pursue
- IP suite can include patents, trade secrets, copyrights, trademarks, Plant Breeders’ Rights
- Cost-effective, strategic IP management of each invention a critical skill of TTO
- Without capable IP management by TTO, technology transfer is an irrational effort

Elements of Technology Transfer



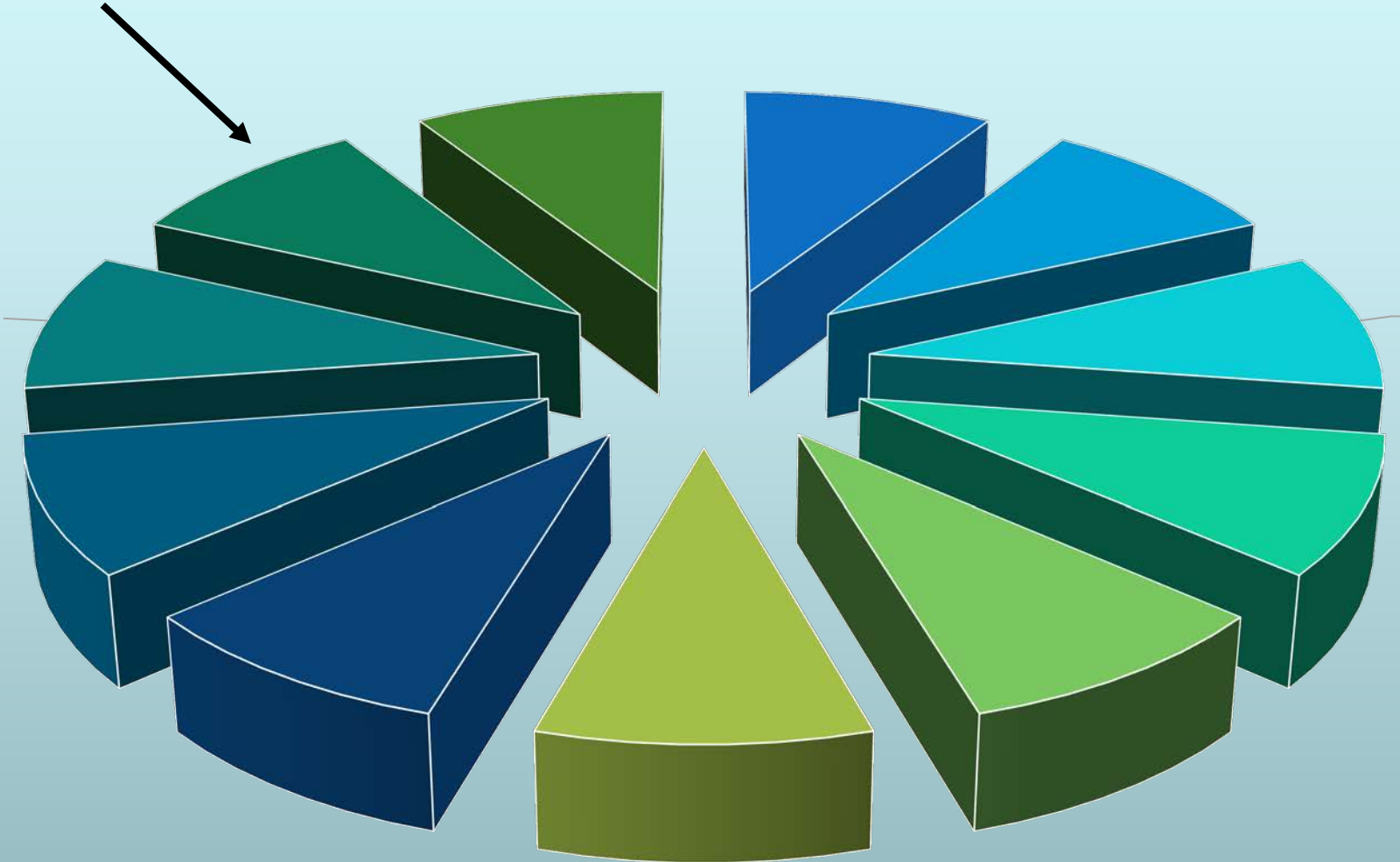
**Tech Marketing &
Business Development**

Tech Marketing & Business Development²⁰

- Successful and sustainable IP-based tech transfer absolutely requires proactive and creative technology marketing
- “Tech Marketing” is that set of varied activities designed to find, contact, and negotiate with preferred commercialization partners
- Tech Marketing requires a proactive mindset – new technologies DO NOT “sell themselves”
- Certain methods of Tech Marketing have been proven effective, but there’s always room for creativity and new approaches
- The TTP should use the “Business Development” approach to developing a commercialization strategy and implementing a Tech Marketing campaign

Elements of Technology Transfer

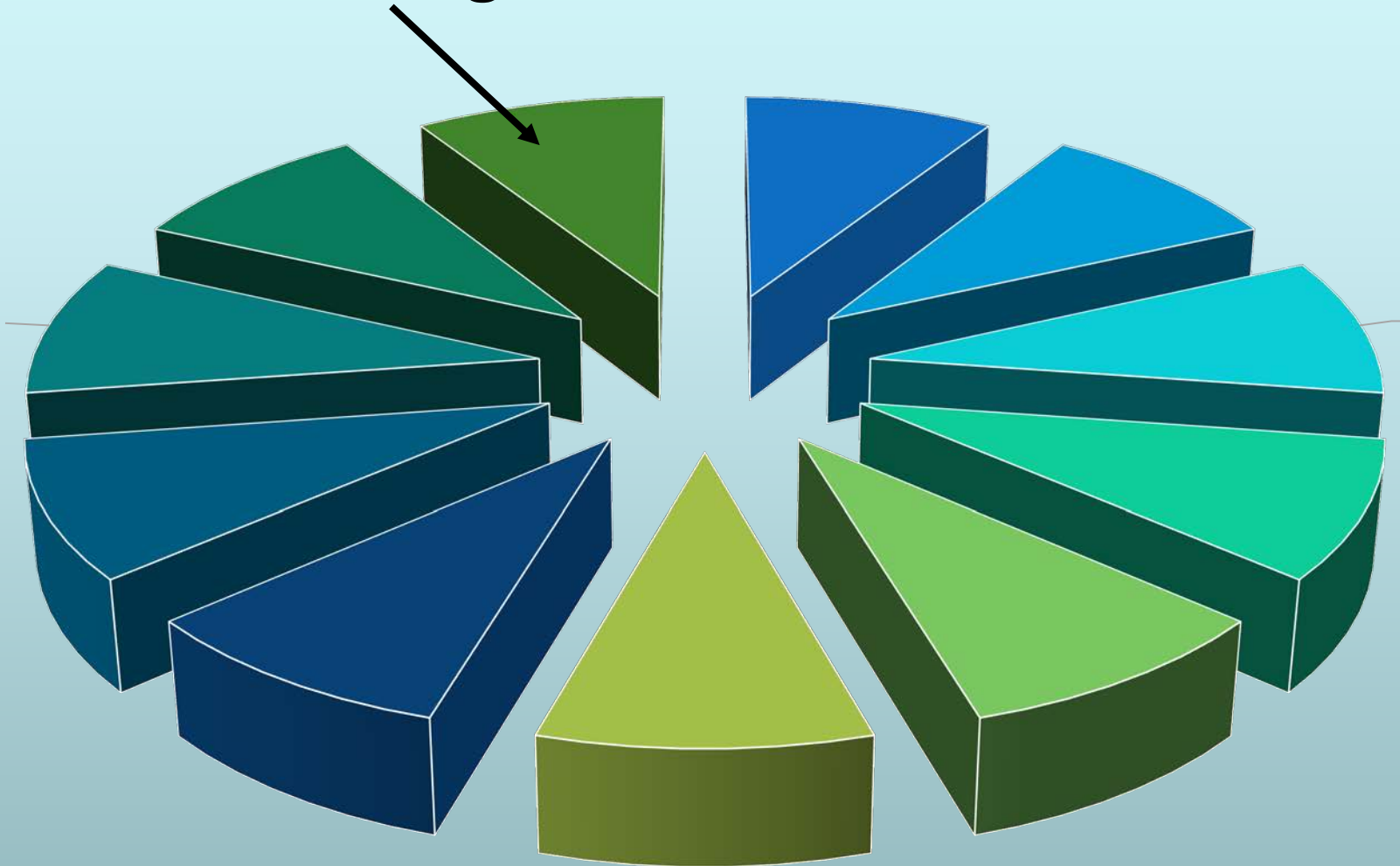
Licensing



- Since it is highly recommended that PSRI never sell their IP, licensing is the commercialization route
- Licensing, like renting real estate, involves the granting of commercial-use rights, but not ownership
- License agreements are the heart of the technology transfer function
- Licenses should be tailored to suit the invention, the applicable market applications, and the licensee.
- Licenses can be exclusive or non-exclusive, limited by field of use, territory, time, and many other factors
- Licenses are negotiated between the TTP and their counterpart of the commercialization partner
- Licenses are like marriages: long term partnerships
- They are best built on mutual trust, transparency, respect

Elements of Technology Transfer

Contract management

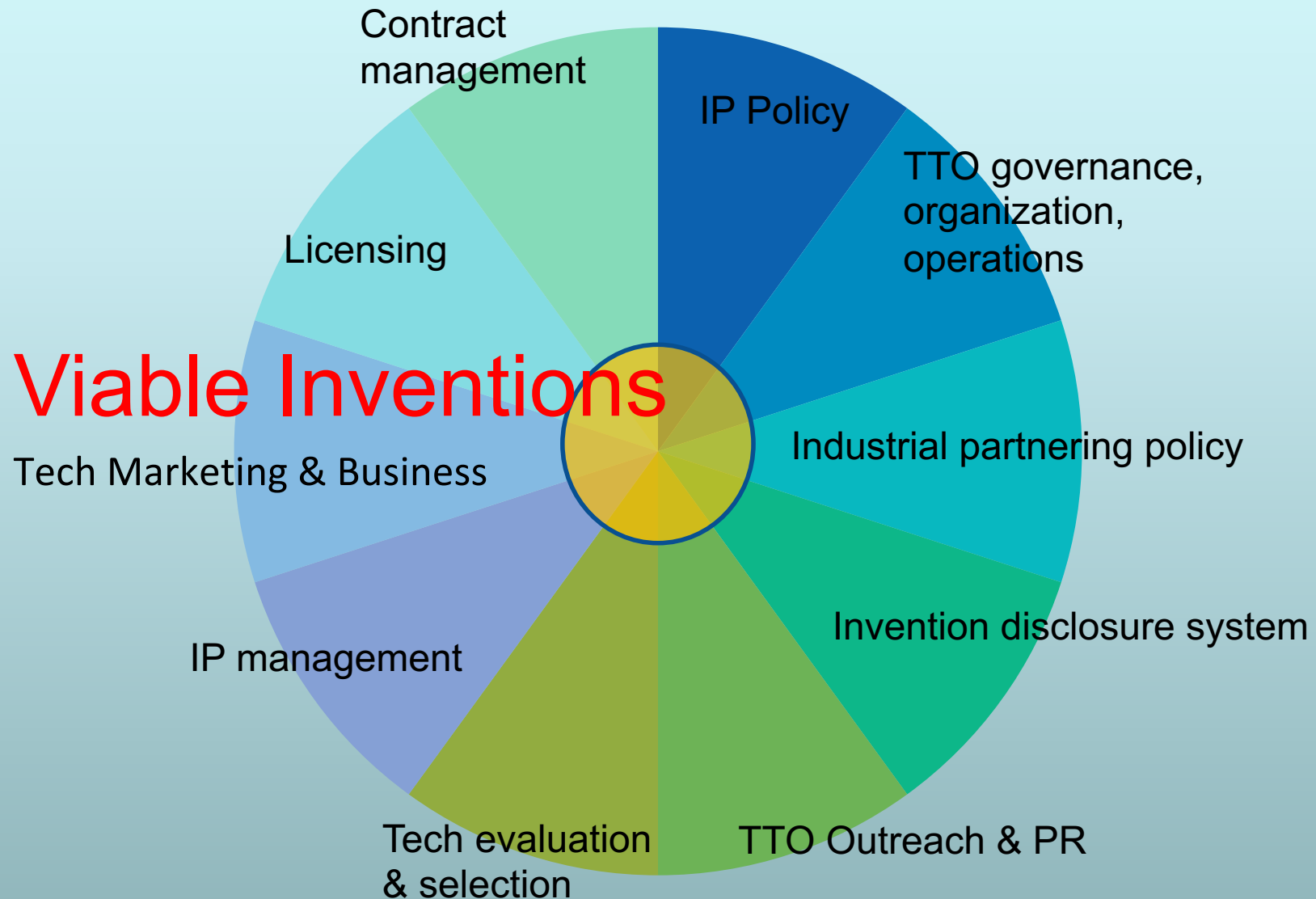


- Since license agreements are the heart of the tech transfer function, they require careful attention to negotiate
- The terms and conditions of license agreements must be monitored by both licensor and licensee
- Without effective and systematic contract monitoring, license agreements fall into “disrepair”, leading to loss of revenue, lack of commercialization diligence, breaches of contracts, and even litigation
- Poorly managed licenses lead to poor technology commercialization, and unhappy inventors
- Failure to properly monitor license agreements can lead to an overall failure of the TTO and the TTP
- Good contract management identifies and solves issues before they become substantial problems

Technology Transfer system



Technology Transfer system



Track I, Topic 1.2.1
Elements of Technology Transfer

Thank You