

Small Technology Transfer Offices: Making a Little Go a Long Way

Welcoming remarks will begin at
11:55 a.m. Eastern Time.

The formal presentation will begin at noon.

For audio, dial in by phone:

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Access code 5627649

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Small Technology Transfer Offices: Making a Little Go a Long Way

Presented by:

Allyson Best, University of Mississippi
Christopher McKinney, Georgia Regents University

June 18, 2013

Questions?

We will be taking questions during
and after the presentation.

Please type your questions into the chat.

Operator Assistance

Audio difficulties: Dial 0 0

Other issues: +1-847-559-0846

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after the event.**

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- *AUTM Better World Report*
- AUTM Salary Survey
- AUTM Technology Transfer Practice Manual
- AUTM Licensing Activity Survey (currently for United States and Canada)
- AUTM Update

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- Meetings at national and regional levels

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- Access to post data on the **Global Technology Port**

Member Benefits

Member Benefits

Introducing AUTM's newest member benefit: The AUTM Global Technology Portal (GTP)



AUTM Global Technology Portal



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GTP.AUTM.NET



Allyson Best
Associate Director, Office of
Research and Sponsored Programs
University of Mississippi



Christopher McKinney
Associate Vice President,
Technology Transfer and Economic
Development
Georgia Regents University



Managing Technology Transfer with a Small (or No) Technology Transfer Office Perspectives from a Small Office at a Public University

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The University of Mississippi
662/915-7188 amilhou@olemiss.edu



Why Formalize These Efforts?

- Transfer Technologies Out to Companies to Benefit Society
- Federal Obligations
- Industrial Sponsored Research Obligations
- Our Faculty, Staff, and Students Collaborate On A Global Scale
- Timely: Local, Regional, State, National, International Discussions
- You Might Already Have a Hit
- Asset For Your Organization
- Successful Operations Can Serve as a Recruitment Tool
- Dare I Say It: It's a fun job.



Goals for Today

- Context: Technology Transfer at Ole Miss & GRU
- Technology Transfer 101: Ideal Office
- Technology Transfer 102: Reality
- Internal & External Stakeholders
- Developing a Plan: Strategies and Tips
- Dare I Say It: Hopefully sound convincing that it really is a fun job.



Georgia Regents University

- New university (Jan., 2013) reflecting the consolidation of:

Georgia Health Sciences University

(fka Medical College of Georgia)

&

Augusta State University

So...we're in an exciting phase in our TTO!



GRU funded research strengths...

- Comprehensive university with research strengths in:
 - cancer
 - cardiometabolic disease
 - genomics and personalized medicine
 - neurological disease
 - public and preventive health
 - regenerative medicine

- *AND, so much more!!!*



GRU innovation commercialization

- TTO since ~2000; 10K sq. ft. bio-business incubator; innovation-based economic development mission.

- Five staff...all wearing multiple "hats"

- FY13 licensing revenue of ~\$300K
- Mid-term aspirations of >\$1MM
- Long-term aspirations of \$15-20MM
- *Oh yes, we're adding a LOT of researchers @ GRU*



The University of Mississippi

- IP Portfolio goes back to the 1960s with several successful licenses but we did not have a centralized TTO until 2006
 - 2006: 1 FTE (PhD, 25+ yr industry exec)
 - 2007: 2 FTE (added a project coordinator)
 - 2008: 3 FTE (MBA)
- 2009 – present: 3 FTE (+ .5 GS)
- Part of Sponsored Research but we do have a Research Foundation for equity deals



The University of Mississippi

- Currently maintain ~ 40 issued patents (50% have some international filings) and another ~30 pending applications (65% of those have international filings), ~10 disclosures a year.
- Currently maintain ~17 licenses (almost all of the exclusive), 13 start-ups
- Earn ~\$250,000/yr in income (peak years 2006-2010 we earned over \$1M/yr)
- Licenses have evolved from mostly large corporations to almost entirely start-ups.
- Spend ~\$115,000/yr in legal fees, ~40% reimbursed.



The University of Mississippi

- Industry Segments: Pharma (Dietary Supplements and Analytical Chemistry), Acoustics, IT and other.....
- Our main metric: ROI
 - 60% of our portfolio either licensed or in a productive R&D collaborative agreement.
 - Currently at ~50%
- Medical Center in our University system but not on our campus or in our TTO



The University of Mississippi

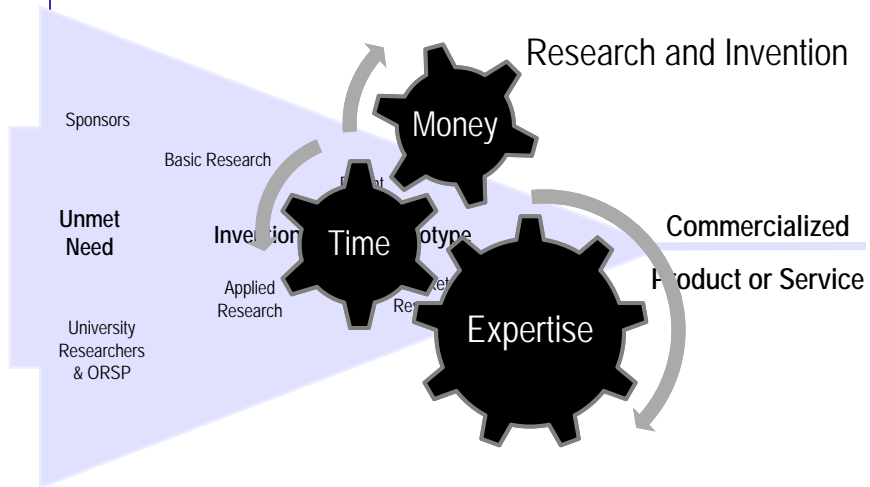
How does this translate?

We are small by any definition but have been successful with managed IP risk coupled with targeted and aggressive commercialization efforts.





Technology Transfer 101: Ideal Office



Technology Transfer 101: Ideal Office





Technology Transfer 102: Reality



Technology Transfer 102: Reality

- 2011 AUTM Data: Annual Licensing Survey
 - 151 Named Respondents

	5 FTE or less	5 FTE or more	10 FTE or more
# of offices	97 (64%)	54 (36%)	23 (15%)
AVG YR TTO FOUNDED	1992	1980	1976

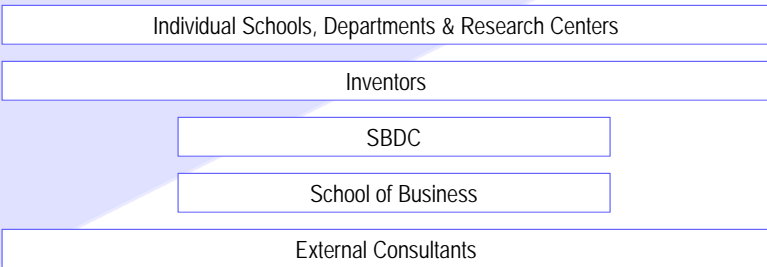


Research and Invention at Ole Miss

Vice Chancellor for Research and Sponsored Programs

Pre/Post Award Administration Division of Technology Management
Division of Compliance Insight Park

Unmet Need Invention Prototype Commercialized
Product or Service



We interrupt this presentation



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MEMBER CONNECT	ABOUT AUTM	ABOUT TECH TRANSFER	EVENTS	SURVEYS & PUBLICATIONS	MARKETPLACE
<ul style="list-style-type: none"> Home About AUTM Member Benefits: Join and Renew Mission and Goals Board of Directors Organization Chart Committees Staff Special Interest Groups Bylaws AUTM Policies Public Policy Scholarships Opportunities and Resources for 	<p>Home . About AUTM . Mission and Goals</p> <p>AUTM Board of Directors - Mission and Goals</p> <p>Adopted by Board of Trustees July 22, 2009</p> <p>Mission The core purpose of AUTM is to support and advance academic technology transfer globally.</p> <p>Core Values</p> <ol style="list-style-type: none"> The creative output of AUTM members' work benefits the public. Professional development is essential for AUTM members to stay ahead in a rapidly changing field. A sense of community connects AUTM members and enhances the sharing of information and knowledge among them. Professionalism and ethical behavior are the hallmarks of the way AUTM members conduct themselves. <p>Goals Defining the Profession</p>				



Internal and External Stakeholders:

Perspectives From A Small Public Technology Transfer Office

1. Compliance
2. The Assets of Your Institution
3. Enabling and Evaluating Disclosures
4. Related Agreements
5. IP Management
6. Marketing
7. Licensing & Licensee Management
8. Metrics



Internal and External Stakeholders:

Perspectives From A Small Public Technology Transfer Office

- Internal Stakeholders:
 - Think anyone that has ever been inside your organization.
- External Stakeholders:
 - Think anyone outside of your organization
- Helpful? Stay with us....



Developing a Plan: Strategies and Tips

- Your goal today maybe managing this process without a formal office or starting/growing one.
- Why?
 - Compliance
 - Organizational priority
 - State priority
 - Collaborative survival
 - Fun Stuff



Strategic Tips: Management Strategies

1. Compliance
2. The Assets of Your Institution
3. Enabling and Evaluating Disclosures
4. Related Agreements
5. IP Management
6. Marketing
7. Licensing & Licensee Management
8. Metrics



1: Compliance

the COMPETES Act reauthorization requirement for institutions to report to NSF the URL for a public website for technology transfer and commercialization of research now is in effect. It applies to any institution of higher education that received NSF research support and at least \$25M in total federal research grants in the most recent fiscal year.

NSF has included the requirement in its February 1, 2012 Research Terms and Conditions (http://www.nsf.gov/pubs/policydocs/rtc/nsf_212.pdf). It applies to all new NSF grants and funding amendments to existing NSF grants awarded on or after February 1, 2012. The award term (#19) states: "Any institution of higher education...that receives NSF research support (i.e., any grant or cooperative agreement awarded by NSF) and has received at least \$25,000,000 in total Federal research grants in the most recently completed Federal fiscal year shall keep, maintain, and report annually to the National Science Foundation the universal resource locator (URL) for a public website that contains information concerning its general approach to and mechanisms for transfer of technology and the commercialization of research results, including:

1. contact information for individuals and university offices responsible for technology transfer and commercialization;
2. information for both university researchers and industry on the institution's technology licensing and commercialization strategies;
3. success stories, statistics and examples of how the university supports commercialization of research results;
4. technologies available for licensing by the university where appropriate; and
5. any other information deemed by the institution to be helpful to companies with the potential to commercialize university inventions.



1: Compliance

- The institution's URL containing the information required in section a. must be electronically submitted to the following email alias: ACA520@nsf.gov. The URLs will be available to the public on the Science, Engineering and Education (SEE) Innovation section of Research.gov at: <http://www.research.gov/acasection520>.

The screenshot shows the Research.gov website interface. The main heading is "Academic Technology Transfer and Commercialization of University Research". Below this, there is a paragraph of text explaining the requirement under Section 520 of the America COMPETES Reauthorization Act of 2010. A list of five items is provided, matching the list in the first slide. The text is as follows:

Section 520 of the America COMPETES Reauthorization Act of 2010 requires higher education institutions that have NSF research support and at least \$25,000,000 in total Federal research grants in the most recently completed Federal fiscal year to submit to NSF the universal resource locator (URL) that contains information on their transfer of technology and commercialization of research results efforts.

The URLs are displayed as submitted to the National Science Foundation. Awardees are responsible for the information contained on these websites. NSF has not approved or endorsed the content of these websites.

This requirement is effective for all new awards and funding amendments to existing NSF grants awarded on or after February 1, 2012. It has been implemented via a new NSF award term and condition, which states:

"A. Any institution of higher education (as such term is defined in section 1011A) of the Higher Education Act of 1965 (20 U.S.C. 1011a) that receives National Science Foundation research support (i.e., any grant or cooperative agreement awarded by NSF) and has received at least \$25,000,000 in total Federal research grants in the most recently completed Federal fiscal year shall keep, maintain, and report annually to the National Science Foundation the universal resource locator (URL) for a public website that contains information concerning its general approach to and mechanisms for transfer of technology and the commercialization of research results, including:

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5. any other information deemed by the institution to be helpful to companies with the potential to commercialize university inventions.

The receipt of information submitted by an institution under the requirement for the submission of the URL research.gov and the National



2: The Assets of Your Institution

- Look at everything and discuss the goal with as many internal stakeholders as possible
- Operational Analysis: Who currently works on these types of issues:
 - Existing policies (IP, Copyright, COI)
 - Are there any informal rules / point of contacts in place?
 - SPA, awards administration, contract officers
 - Existing foundations, licensing efforts
 - University counsel, current 3rd party agreements
 - Entre & Support Programs (SBDC, SOB & other units!)



2: The Assets of Your Institution

- Cultural Analysis
 - Administration's goals
 - Champions / Detractors
 - Existing relationships with foundations & industry
 - Your development office and officers
 - Existing angels and VC networks in your area
 - Current state / local ED environment & goals
 - System Issues
 - State Regulations



2: The Assets of Your Institution

- Opportunity Analysis (with scarce resources)
 - Your core competencies
 - Read 24 months of press releases
 - Pull the sponsored research list
 - Read seminar announcements
 - Pull the enrollment / graduation data
 - Read the annual reports (department and university)



2: The Assets of Your Institution

- Human and Fiscal K
 - Faculty, Staff, and Students
 - Alumni (commercialization, SME, IP, etc)
 - Advisory Boards for your Colleges or Schools
 - Existing collaborations (SPA, Foundation, Industry)
 - System and/or State Support
 - Local and State government, ED, & Chambers
 - NETWORK with other TTOs



3: Enabling and Evaluating Disclosures

- Fundamental unit of currency in our business.
- Disclosure forms: Don't start from scratch.
- Current SPA and compliance efforts.
- Get out of your office. Go ask them to tell their story.
- Start with the obvious but always ask for referrals.
- Develop an honest and open process and stick to it.
- Ask for help: SMEs, internal boards or committees.
- Document everything.



4: Related Agreements

- Breathe Deep: Think “can of worms” analogy.....
 - CDAs / NDAs (individual signatory issues)
 - MTAs (in or out)
 - IIAs
 - SRAs
 - Options, Licenses, Commercialization
 - IP Sharing agreements
 - Assignments
 - Equity
- Current administration and operations, expectations for the TTO
- Do not underestimate how much time is involved if you assume responsibility.



4: Related Agreements

- All those fun contractual issues that public state universities have to deal with
 - Equity
 - Liability
 - Indemnity
 - Jurisdiction
 - That “unique language” that only exists in a state’s code

Notwithstanding any provision to the contrary contained herein, it is recognized that MISSISSIPPI is a public agency of the State of Mississippi and is subject to the Mississippi Public Records Act, § 25-61-1, et. seq., Miss. Code Ann. If a public records request is made for any Information provided to MISSISSIPPI pursuant to this agreement, MISSISSIPPI shall promptly notify the disclosing party of such request. The disclosing party shall promptly institute appropriate legal proceedings to protect its Confidential Information. No Party to this agreement shall be liable to the other Party for disclosures of Confidential Information required by Court order or required by law.



4: Related Agreements

- Current relationships with university counsel is critical to success. Must have a positive and trusting relationship for this to work.
- Don't start from scratch if you need to build your own templates. Network internally and externally.
- Signatory authority issues (written authority from administration)



5: IP Management

- Inside vs. Outside patent and commercialization counsel
- Retaining outside patent counsel: breathe deep
- Leverage and consult with other organizations
- Watch for state regulations on contracts and rate schedules
- Document everything



5: IP Management

- Docketing your IP Portfolio
 - Get a good filing system in place – paper and electronic. Does not have to be fancy.
 - Set regular dates to review the portfolio and docket.
 - Ask your attorney for help (weekly/monthly/quarterly emails or conference calls).
 - Document everything.
 - Watch USPTO/PAIR



5: IP Management

- IP strategy
 - Network and establish clear internal objectives
 - Patents are expensive and start clocks you cannot stop
 - A “Patent Pending” stamp does very little to actually facilitate technology transfer
 - Try not to file until you have a plan in place for the next 12,18 and 31 months. “Back of the envelope” has actually been used in this exercise (at least I admit to it).



6: Marketing

- Website: “Technologies Available for Licensing” or “Opportunities for Collaboration”

THE UNIVERSITY OF MISSISSIPPI Research, Scholarship, and Innovation

Technology Transfer UM Employees Industry Entrepreneurs Express Agreements Technologies Available Our Office

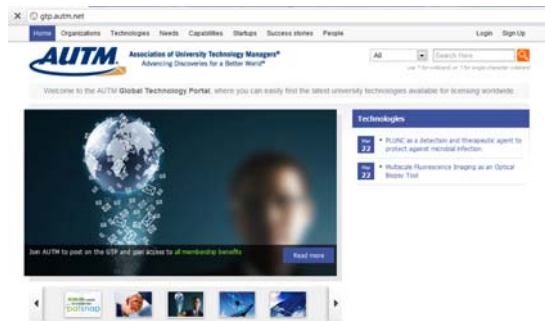
Technologies Available for Licensing

Pharmaceuticals, Devices, Agriculture & Research Tools	UM File No	PI	Patent Status
Methods and Compositions for Isolating Taxanes	1270	Eisobly	5,618,538 5,480,539
Method of Screening Anticancer Compounds	1290	Pisaco	6,200,760
Denture Adhesive for Oral Candidiasis	1520	Rajka	6,375,963
Novel Selective Algaecides for Control of Cyanobacteria	1630	Narayakkara	6,949,250
Method and Apparatus for Pellet Freezing Molten Solid Matrices	1661	Cheboynia	Patent Pending



6: Marketing

- Utilize inexpensive or free third party websites (Flintbox, etc) and the AUTM GTP!



6: Marketing

- Shotgun vs. Rifle – YOU need to know what they are looking for
- Network as much as possible
- Work with and leverage your co-Assignees / Development institutions and the inventors
- Student groups / work
- Start-up vs. License considerations
- Talk to your communications / media department / social media teams
- Consider conferences & biz plan competitions



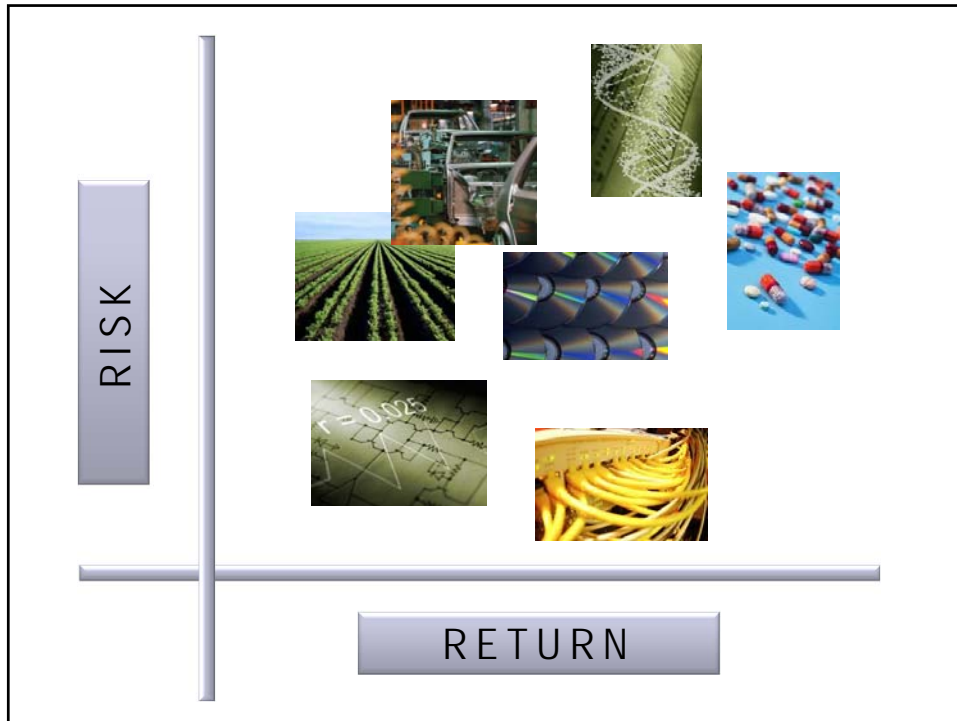
6: Marketing

- Marketing Documents
 - Start simple: A **brief** nonconfidential summary that must contain a quantifiable competitive advantage statement. If you can't write one then you are not ready to market.
 - Follow on documents are longer, confidential and technically more complete.
 - This is where the art of technology transfer really comes into play.



7: Licensing Considerations

- Fields of Use
- Use of Name
- Milestones / Royalty Rates
- Bankruptcy / Ownership of Data
- Publication and Publicity
- Patent Prosecution
- Goals: Home run or a success story?



7: Licensee Management

- Breathe deep and expect anything
- Their expectations: regulatory, IP, scale-up, production costs, clinical work, safety, QC, endorsements, etc.
- Do not underestimate how much work is involved
- Time vs. Return (your office, your administrators, and your inventors)
- Start up vs. Licensee issues



8: Metrics

- Behold....“The power of the Excel cell”
- Current topic of discussion at national, regional, state and local levels
- There is a lot of data out there to support your metric decisions. AUTM reports, APLU, AAU, COGR, AACU



8: Metrics

- Making metric decisions
 - Agree on governance for the TT efforts. Funding for the TT efforts.
 - Who will read the reports, who will prepare the reports. ID key stakeholders.
 - Define goals first but provide for adaptability and change.
 - Keep them appropriate: We are not a fan of patent #s or income but like ROI and rate changes.



Lessons Learned

- “Accept the fact that you will be second guessed – you are making private risk impacted decisions in a public forum” (Vincie Albritton)
- Don't underestimate the challenges of translating every single thing (from documents to tone of voice) between the academic and business worlds.
- Reach out to faculty and staff that are new to your university. They may have hated their former TTO office and you will have to overcome that bias. They may have extensive experience in angel investing – you won't know unless you ask. Also reach out to their family members. They may be a great SME resource.
- You will have to win the trust and support of administrators, especially those outside your chain of command.



Lessons Learned

- Leverage every resource you can – internal and external but manage expectations and especially message.
- Remember that it takes time and money but most of all expertise.
- Funding is an issue you cannot avoid and you have to be prepared for change at any moment. Most efforts need multiple sources.
- Stay networked and ask for help.
- Document everything you can.
- Find nontraditional ways to engage faculty, staff and students. They may not have a patentable invention yet but they might need some help with the background section of a grant application. Small industrial sponsored projects might lead to something bigger.



Lessons Learned

- Watch the impulse to over-negotiate the first couple of deals. If your office is young, you may leave some money on the table but I would rather have the license and a success story. NOTHING influences disclosure rates more than word in the halls of a successful deal.
- Alumni networks (social media, advisory boards, parent councils) can be powerful allies.
- I would spend any consulting money on a good SME before spending it on a marketing, IP, or just about anything else.



Resources

AUTM Small Office SIG and List serves:

The One Big Idea: Identifying the Most Critical Aspect in Running Your Small Office Technology Transfer Office
SIG participants have the opportunity to discuss issues unique to small technology transfer offices and network with fellow AUTM members who face the same challenges.

Facilitator: Vincie C. Albritton, M.B.A.
Clemson University
valbrit@clemson.edu



Wishing you blue
skies, green
pastures and great
success.....



A SPECIAL THANK YOU TO:

Vincie Albritton
Clemson University Research Foundation Associate Director
Clemson University



Wayne Watkins
Associate Vice President for Research
The University of Akron





AND NOTHING IS POSSIBLE WITHOUT...

Barbara Gunderson and her team
Professional Development Manager
Association of University Technology Managers



thank you

Questions? Comments?



Discussion and Q&A

Click the raise hand button.

When called on, press * 7 on your telephone keypad to un-mute your phone.

Press * 6 to re-mute your phone.

Thank you for your participation.

Remember to complete
our online survey.

Webinar Recordings

Basics of Technology Transfer for Licensing Professionals

Basic Patenting 101

Copyright Law and Content/Software Licensing

Equity Based License Agreements

Financial Conflicts of Interest

Marketing: Whether By Traditional or Social Media, the Value

Need to Know Basics of Technology Transfer for Support Staff

Negotiation of License Agreements

Nuts and Bolts for Compliance Under Federal Funding Awards

The Basics of Open Source Licensing

Tips for Managing MTAs

Triage

Valuation of Inventions and Patents

(More Added Monthly)

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http://twitter.com/AUTM_Network



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Search groups for AUTM at www.linkedin.com

Register now for AUTM's next webinar

- **Certified Licensing Professional (CLE):
A Career Development Opportunity**

– July 23 **FREE**



Watch the AUTM Website for upcoming webinars

- **The Unitary Patent in Europe**
 - July 31
- **Negotiation of License Agreements**
 - August 21
- **Royalties and Relationships – Keeping Current, Complete and Congenial**
 - Sept. 18
- **Dashboard Driven IP Portfolio Management**
 - Sept. 25

- **Many more to come!**



AUTM Region Meetings



AUTM Central Region Meeting

July 17 – 19, 2013
Hyatt Regency Indianapolis
Indianapolis, IN USA

AUTM Eastern Region Meeting

Sept. 9 – 10, 2013
The Boston Park Plaza & Towers
Boston, MA USA



AUTM Western Region Meeting

Sept. 30 – Oct. 1
The Nines Hotel
Portland, OR USA

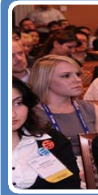
AUTM Courses



New for 2013!

AUTM Symposium

- Aug. 14 - 16
USPTO Headquarters
Global Intellectual Property Academy
Alexandria, VA USA



Save the Date!

Successful Practices in Small Technology Transfer Offices

- Oct. 23 – 24
InterContinental Dallas
Dallas, TX USA

AUTM Courses

AUTM Essentials of Academic Technology Transfer Course

- October 23 – 25
InterContinental Dallas
Dallas, TX USA

Save the Date

AUTM Technology Operations and Organization Licensing Skills (TOOLS) Course

- October 23 – 25
InterContinental Dallas
Dallas, TX USA





AUTM Professional Development Programs

www.autm.net/events



AUTM Annual Meeting



Save the Date!

AUTM 2014 Annual Meeting

Feb. 19 – 22
San Francisco Marriott Marquis
San Francisco, CA USA

