KU Center for Technology Commercialization

“Promoting Innovation to Benefit Society”

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Sources of Faculty Inventions

- Colleague referrals to the Technology Transfer Office
- Publications
- Abstracts posted at a conference
- Industry sponsored research
- Conference presentations
- Grant submissions
Technology Commercialization Process

- Disclosure of invention
- Initial evaluation and market research
- Patentability Search
- Commercialization strategy
- File patent/copyright/trademark
- Potential enhancement of technology
- Material Transfer/Research Agreements
- Out licensing or Company spin-off
Formal disclosure of the invention to KUCTC

Is a public disclosure scheduled?

Does a company have rights to the invention under an MTA or research agreement?

Is the company interested in the invention?

Is the company ready to license the invention or take an option?

Yes

Yes

Yes

Special note: A informal pre-invention disclosure discussion may also be scheduled. The Institute for Advancing Medical Innovation (IAMI) staff participates in all life science invention disclosure meetings.

KUCTC will consider expediting the patenting process, which may involve the filing of a Provisional Patent Application. Copyright and trademark protection will also be considered as appropriate.

KUCTC will pursue an option agreement or Letter of Intent with the company.

KUCTC will negotiate a license agreement for the invention. The agreement will include but not limited to upfront fees or equity in the case of a start-up company, annual maintenance fees, milestone fees (clinical trials), diligence terms with performance milestones, and the payment of patent costs.

For life science inventions, the IAMI will determine if they wish to include the invention in their Project Pipeline. If IAMI chooses not to include the invention in their Project Pipeline, KUCTC staff will contact companies that might be interested in licensing the invention. If appropriate, KUCTC will discuss start-up opportunities with faculty and/or students who have expressed such an interest.

If there is no start-up opportunity and no existing companies are interested in the invention, KUCTC will evaluate the market potential for the invention. KUCTC may decide to either (a) apply for patent protection despite the lack of interest if KUCTC believes the technology to have substantial future commercial value (b) continue to evaluate the invention in the future to determine if further development work might enhance the commercial value of the invention or (c) return the invention to the Inventor(s).
Technology Assessment

- Occurs at the time of –
  - Invention disclosure
  - Patent conversion
  - USPTO Office Actions
  - PCT filings
  - Before returning to inventor

- Deal structures
- To secure potential licensees
- By whom-
  - IAMI Board
  - KU Alumni
  - KU administration and faculty
  - Regional and national entrepreneurs and executives
Marketing

- Faculty/Staff member is often a good resource
- Database searches, associations lists, conventions, publications and personal networking
- Non-confidential disclosures
- Confidential disclosures
- Corporate Partner for licensing and/or additional funding
University Patent Budgets

- How is the Tech Transfer Office funded?
- Expectations for the office, i.e., self-sustaining?
- Current status of licensing revenues, i.e. big hit or soon to expire patent
- Status of technology pipeline
- Does the TT office have an endowment?
Patent Expenses

- Cover Sheet Provisional Patent Application- ~ $1K
- Full Provisional Patent Application- ~ $4 K
- NonProvisional Patent Application- ~ $11 K
- PCT Patent Filing- ~ $5 K
- National Phase Patent Filing- ~ $5-10 K per country
- Office Actions- Variable cost
- Restrictions (Divisionals)- results in a new patent
Patent Application Timing

- File Patent Application before public disclosure to preserve foreign rights
- Convert Provisional Patent Application to a Non-Provisional Patent Application within 12 months of its filing
- File Patent Cooperation Treaty (PCT) 12 months from the first patent filing
- Patent will be published online 18 months from filing
- Select foreign countries 30 months from the first patent filing
IAMI Organization

Supervisory Committee
Provost (Chair)

Weir Director,
IAMI

Industry Advisory Board

Drug Discovery & Lead Generation
Sittampalam

KU Endowment Association
Grinage

Drug Delivery
Weir (Interim)

Bioengineering Research Center
Spencer

KU Center for Technology Commercialization
Baxendale

Innovation Fellows Training & Education
Friis

Office of Project & Portfolio Management
Hughes
Integration with Technology Transfer

• Invention disclosure and patent activities integrated into drug project team activities managed by IAMI Project directors
  » Technical evaluation of invention disclosure
  » Go/no go decision points tied to patent investments
  » “Pharma” profiling of intellectual property
  » Seed funding decisions based on ROI
  » Industry approach to laboratory documentation, central repository for data, standard format for commercial product summaries
• KUCTC full members on project teams, Target Prioritization Committee, and to-be-formed Pipeline Prioritization Committee
• Patent research to map IP landscape and guide or direct focused areas of research
• Move technology out of KU and into the hands of organizations who have the resources to advance technologies and products
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http://www.ctc.ku.edu