

2012 BRINGING ADMINISTRATORS TOGETHER CONFERENCE

# Effective Administration to Support Commercialization of Research Discoveries

April 11, 2012 11:00am

**UIC** UNIVERSITY OF ILLINOIS  
AT CHICAGO

**UIC**

Lincoln Hall

707 South Morgan Street

# Workshop Presenters

- Brenda Barrie, Coordinator of Grants and Contracts  
Office of Research Services (ORS)

1737 West Polk Street, Suite 304  
Administrative Office Building (M/C 672)  
Chicago, Illinois 60612-7227  
Phone: (312) 355-3372  
Fax: (312) 996-9005  
E-mail: [bbarrie@uic.edu](mailto:bbarrie@uic.edu)

- Jeremy Hollis, Visiting Assistant Director of Business Development  
Office of Technology Management (OTM)

1853 West Polk Street, Suite 433  
College of Medicine West (MC 682)  
Chicago, Illinois 60612-72247  
Phone: (312) 355-1601  
Fax: (312) 996-1995  
E-mail: [jhollis@uic.edu](mailto:jhollis@uic.edu)

# Please ...

- Turn off cell phones
- Sign the attendance roster
- **Feel free to ask questions during the presentation**
- Complete the evaluation at the end of the workshop

# Workshop Objectives

Provide a framework for understanding how you can help investigators throughout the research-commercialization cycle by engaging ORS and OTM to ensure that research discoveries can be translated into intellectual property and successfully commercialized

- Office of the Vice Chancellor for Research (OVCR) and Office of Research Services (ORS)
  - To be familiar with University General Rules regarding Research Gifts, Grants and Contracts
  - To understand the contract review process and the team effort approach
  - To be familiar with Material Transfer Agreements from the perspective of Academia vs. Industry and how the contract terms may ultimately impact the ability to commercialize
- Office of Technology Management (OTM)
  - To be familiar with the invention disclosure process with UIC Office of Technology management
  - To understand the importance of planning for successful protection of intellectual property
  - To be familiar with the process of technology licensing and commercialization

# Office of Research Services (ORS)

- The Office of Research Services (ORS) is responsible for sponsored program activity, including research, instruction and public service at the University of Illinois at Chicago.
- The ORS assists faculty and staff on all stages of sponsored activity
  - ORS assists with proposal development, review and endorsement of proposals, submission of electronic proposals, negotiation and execution of contracts, reporting, receipt and processing of the Notice of Awards.
  - ORS provides interpretation of sponsor guidelines, and ensuring compliance with both agency and University policies.

## **Office of Research Services (ORS)**

310 Administrative Office Building

1737 West Polk Street

Chicago, Illinois 60612

Reception: 312.996.2862

Fax: 312.996.9005

Email: [awards@uic.edu](mailto:awards@uic.edu)

## **Luis R. Vargas, Executive Director**

E-mail: [lrvargas@uic.edu](mailto:lrvargas@uic.edu)

Phone: 312.996.6150

## **Amneh Kiswani, Interim Associate Director**

E-mail: [akiswani@uic.edu](mailto:akiswani@uic.edu)

Phone: 312.996.9406

# Office of Technology Management (OTM)

- The Office of Technology Management (OTM) is responsible for managing the intellectual property generated by research and educational activities at the University of Illinois at Chicago
- The OTM actively reaches out to researchers to encourage disclosure of new innovations
  - The disclosure form helps OTM begin the process of evaluating the technology transfer potential for the intellectual property
- The OTM works closely with inventors to evaluate, protect, and commercialize University IP to help fulfill the University's mission, including economic development
- How do I work with the OTM?
  - Just email or call us – yes it is that simple!

## **OTM**

1853 West Polk Street, Suite 446  
Chicago, Illinois 60612

Reception: 312.996.7018

Fax: 312.996.1995

Email: [otm@uic.edu](mailto:otm@uic.edu)

[www.otm.uic.edu](http://www.otm.uic.edu)

## **Nancy Sullivan, Director**

E-mail: [nansulli@uic.edu](mailto:nansulli@uic.edu)

Phone: 312.996.7018

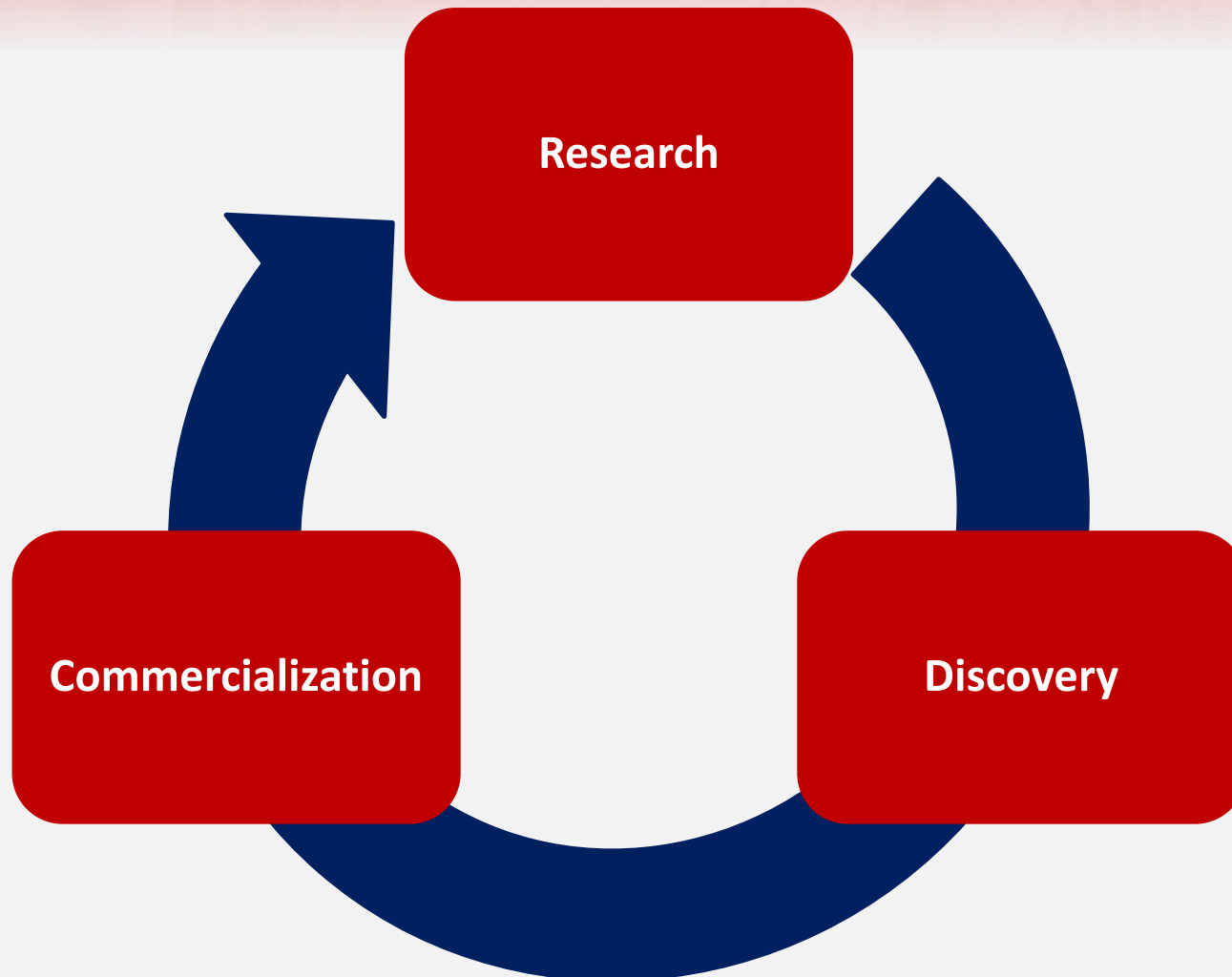
## **Jeremy Hollis, Assistant Director of Business Development**

E-mail: [jhollis@uic.edu](mailto:jhollis@uic.edu)

Phone: 312.355.1601

# ORS and OTM:

Serving The Research-Commercialization Cycle



# Commercialization of Research Discoveries:

What are we talking about?

## What is commercialization?

- The dissemination of research discoveries in the form of intellectual property (IP) rights through licensing and start-up creation
- Fulfills the University's economic development mission through the development and commercialization of new technological and scientific innovations

## What is intellectual property?

- Exclusive rights granted to owners of intangible assets
  - The discoveries that result from the research at the University
- This can include:
  - Patents
  - Copyrights
  - Trademarks
  - Trade Secrets
  - Tangible Material



# Commercialization of Research Discoveries:

What are the University's objectives related to IP?

- Make an impact
  - To provide protections and incentives to encourage discovery and development of new knowledge, its transfer for the public benefit and its use for development of the economy;
- Benefit financially and enhance reputation
  - To enhance the generation of revenue for the University and to provide financial and reputational benefits for the creator(s);
- Preserve ability to conduct research
  - To preserve the University's freedom to conduct research and to use the intellectual property created by that research or pursuant to an institutional initiative.



# University General Rules

<http://www.uillinois.edu/trustees/rules.cfm>

- Article II. Business Organization and Policies
  - Sections 6-8 define Research Gifts, Grants and Contracts
- Article III. Intellectual Property
  - Section 2 defines Intellectual Property
  - Section 7 addresses Commercialization

# Contract Negotiations

## Dilbert on sales-contract negotiations

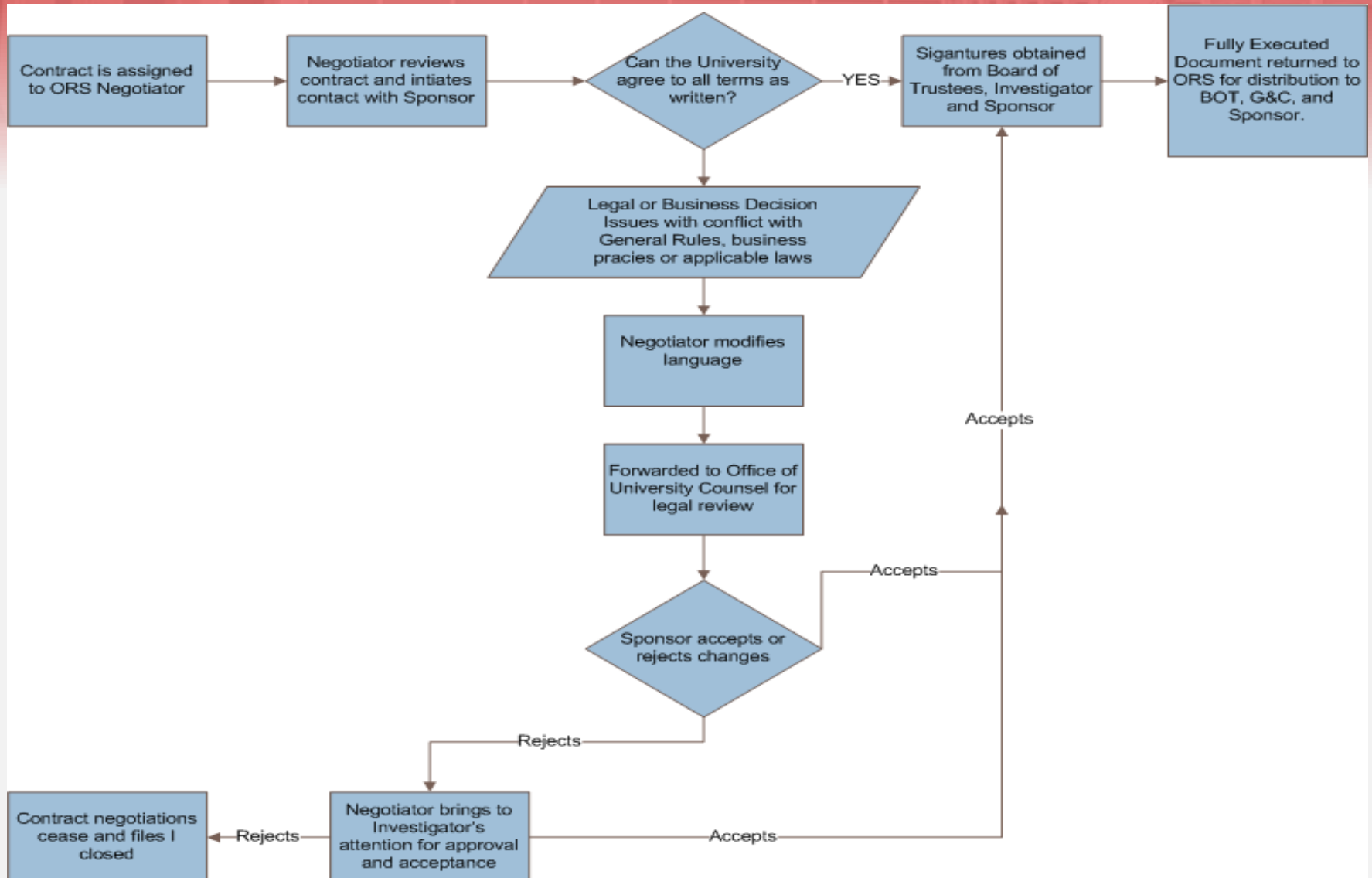
by D. C. TOEDT on NOVEMBER 10, 2009



## **Types of Research-Related Agreements and Implications:**

- Material Transfer Agreement**
- Clinical Trial Agreement**
- Non-disclosure Agreement**
- Standard Research Agreement**
- Data Use Agreement**
- Consultant Agreement**
- Technical Testing Agreement**

# ORS Bilateral Review Process



# Types of Research-Related Agreements and Implications: Material Transfer Agreement (MTA)

Material Transfer Agreement is the transfer of scientific material from one party to another, usually at no cost or a small fee.

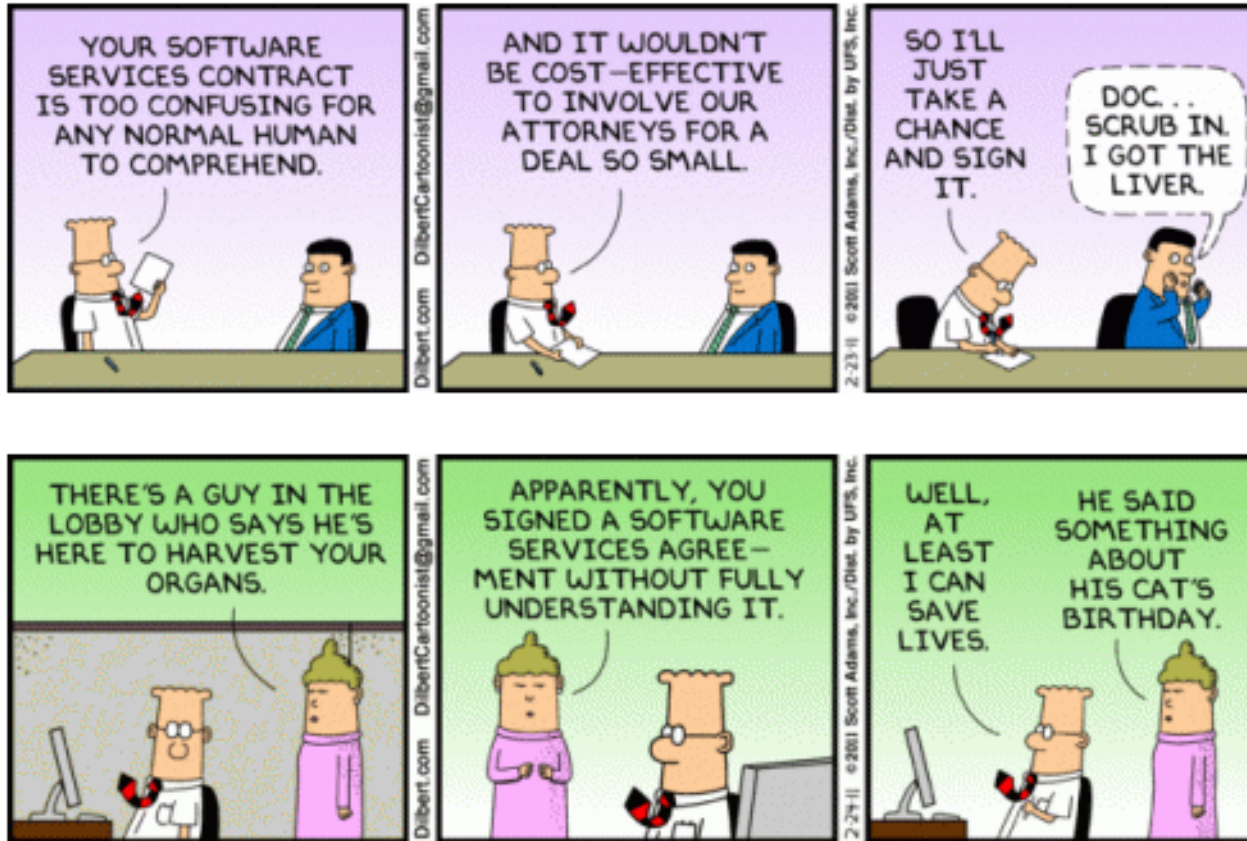
- Academia

- The National Institutes of Health and the Association of University Technology Managers (AUTM) developed standard language to simplify transfer of biological materials, issued as the **Uniform Biological Material Transfer Agreement (UBMTA)**. (autm.net)
- NIH-recommended **Simple Letter Agreement** for material transfers between academic/non-profit institutions.
- **Addgene** .com is a non-profit organization that serves as a plasmid repository. They use the UBMTA for their transfers.
- When the UBMTA or Simple Letter Agreement might not be appropriate:
  - When the materials are unpublished and we would like to ensure our Investigator's right to publish first;
  - When the materials have been licensed to a for-profit institution; or
  - When the materials involve third parties rights (i.e., when the material is a modification of a material received by a third party or funding received by a third party); or
  - A commercial entity wishes to receive the material; or
  - The material is the subject of a pending patent application or an issued patent.

# Types of Research-Related Agreements and Implications: Material Transfer Agreement (MTA)

- Industry
  - These contracts often originate from the Sponsor and their main goal is to protect their IP and obtain future IP.
  - Industrial MTAs often contain language that conflicts with basic academic rights or that places unnecessary restrictions on investigators. Complex areas of negotiation may include:
    - Confidentiality
    - Publication
    - Intellectual Property
    - Indemnification

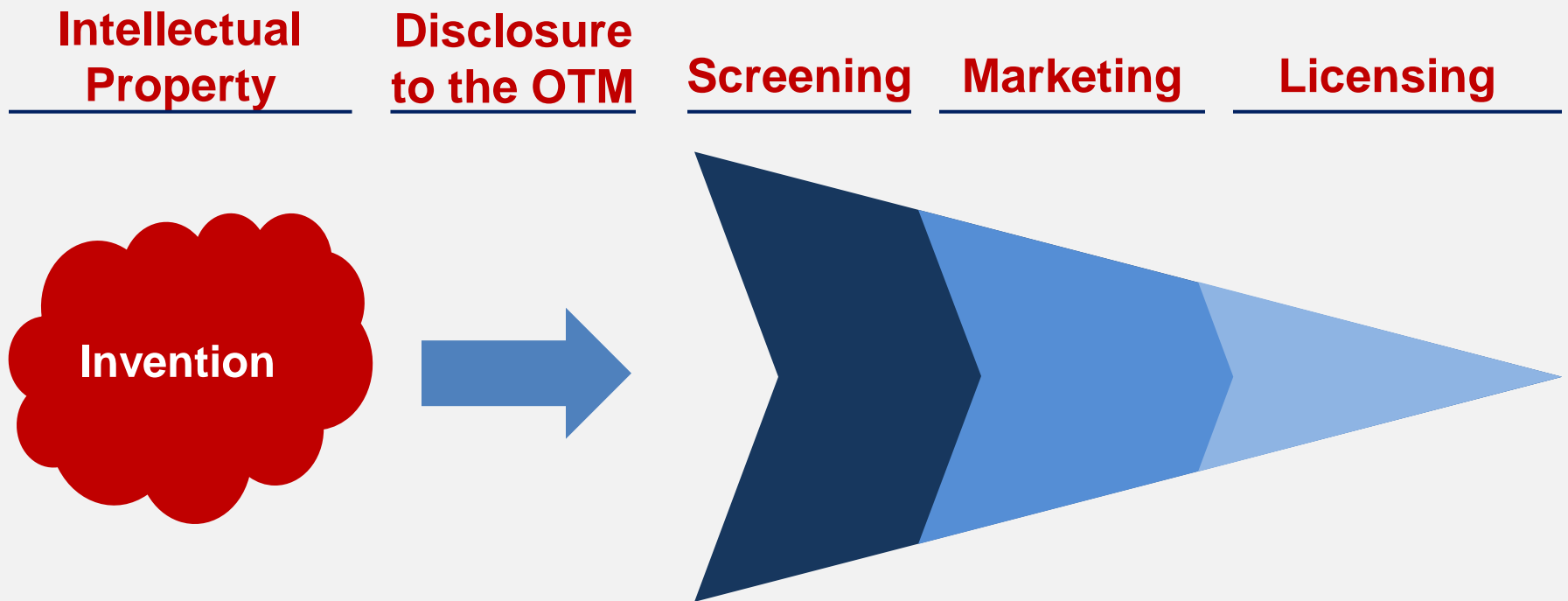
# Contract Negotiations





# From Discovery to Commercialization:

Partnering Throughout for Success



# **From Discovery to Commercialization:**

Documents/Agreements to be aware of related to OTM

- Report of Research Discovery (Invention Disclosure)
- Non-Disclosure Agreement (NDA)
- Option Agreement
- License Agreement
- Conflict Management Plan\*

# From Discovery to Commercialization:

Protecting potential IP during the research project

- Public disclosure of inventions can affect our ability to protect inventions
  - Prior to publication or presentation, contact the OTM if there is any doubt whether something should be disclosed
  - Think of about the need for NDA's before talking to companies
- Encourage investigators to fill out disclosure form or at minimum contact OTM when they think they have a potential invention
  - Keep in mind any IP terms that are in the original grant or sponsored research agreement that will impact commercialization

# From Discovery to Commercialization:

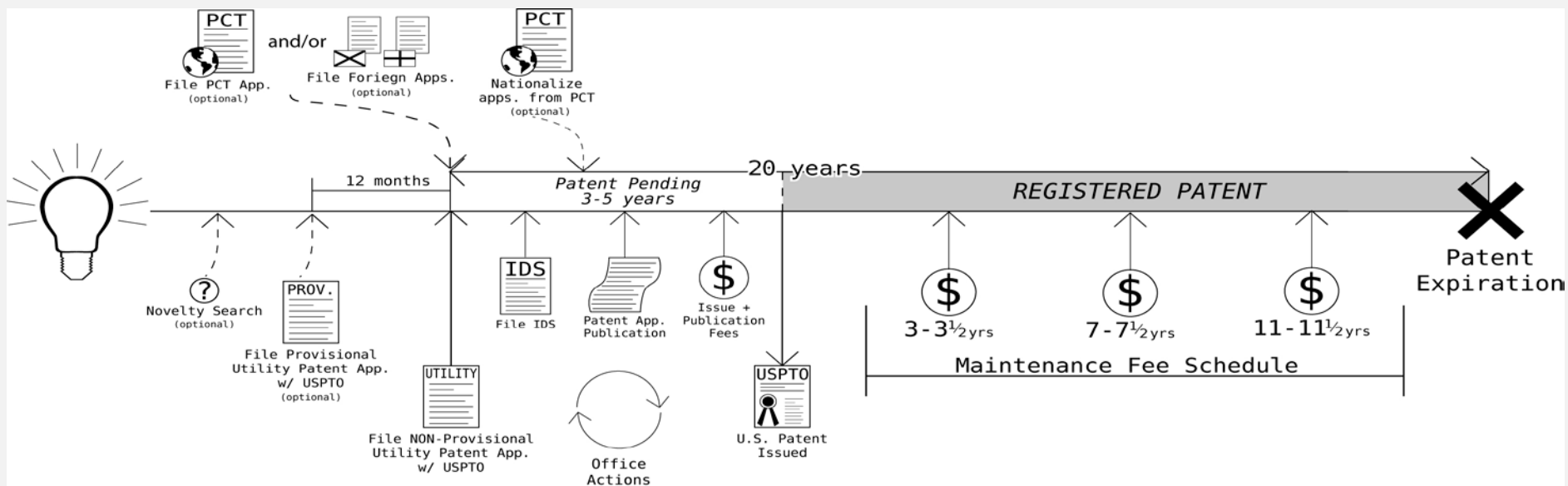
## Submitting a disclosure to OTM

- What kind of information is important?
  - Who are the contributors/inventors?
    - UIC faculty, students, staff
    - Non-UIC persons
  - What is the invention?
    - Title and Description
    - Any material that helps describe the discovery?
      - Grant Application
      - Presentation or Poster
      - Manuscript
  - Any public disclosures that have occurred or are upcoming?
  - **What type of funding supporting the research?**
    - Grant and other funding information
  - **Other existing agreements that might affect commercialization?**
    - Material Transfer
    - Sponsored Research
    - Confidentiality



# From Discovery to Commercialization:

How do we translate research discoveries into IP?



# From Discovery to Commercialization:

## Publication and its impact on patents

- Disclosure to the OTM does not alter publication timetable, but....
- **...public disclosure does affect the ability to obtain a patent**
  - Any public disclosure, prior to patenting, forfeits foreign rights
  - One year grace period from public disclosure to filing in the US
- **Examples of “Public Disclosure”**
  - Journal article on-line or in print
  - Public oral presentation
  - Posters or published abstract in a conference program guide
  - Published grant application (usually abstracts)
  - Thesis defense
  - Online blogs
  - Verbal or written communication without an expectation of confidentiality

# From Discovery to Commercialization:

Other types of IP – they can be valuable too!

- We don't just handle patentable inventions
- Other University IP that can be commercialized:
  - Biological Material
    - Antibodies
    - New animal models
  - Copyrights
    - Software
    - Manuals
    - Questionnaires
    - Educational Curriculum
    - Films
  - Trademarks

# From Discovery to Commercialization:

How do we commercialize IP from research discoveries?

- Option Agreements
  - Gives companies an exclusive right to negotiate a license agreement or evaluate the technology during a defined period
- License Agreements
  - Gives companies an exclusive or non-exclusive right to use University IP
  - Defines how it can be used and the terms for the right to use it
  - Start-up companies formed by faculty, students, or staff can be a licensee too! (*more about this on the next slide*)



# From Discovery to Commercialization:

## Start-up companies and their importance

- License agreements can be executed with a new company formed specifically to commercialize the University IP
  - Allows inventors to submit applications for SBIR/STTR Grants
  - Can lead to additional sponsored research back in the University
- Conflict management plans are needed prior to signing a license
  - But conflicts can be managed
- Resources for university start-up companies
  - Chicago Technology Park
  - SBIR/STTR Grants
    - ORS and OTM can help
    - We offer low-cost SBIR/STTR Option Agreements to faculty start-ups
  - Chicago Innovation Mentors program
  - IllinoisVENTURES

# From Discovery to Commercialization:

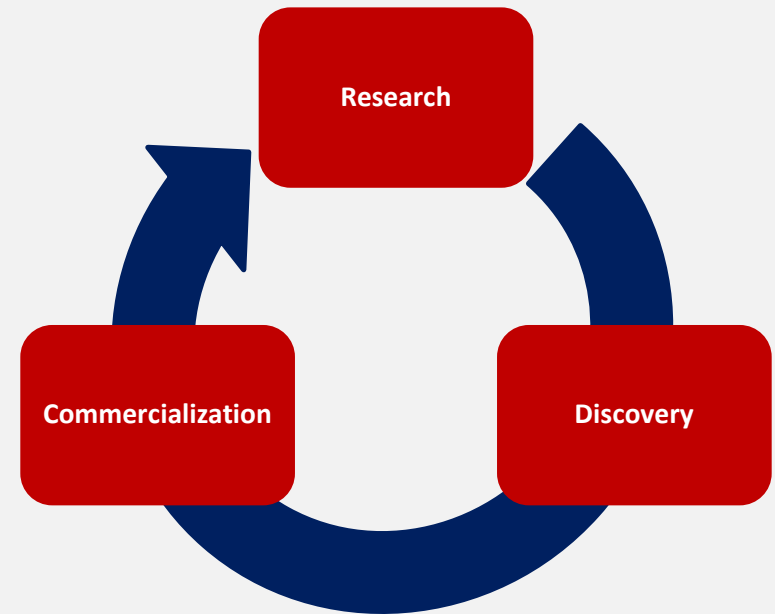
## The impact of successful commercialization

- Make an impact
  - Save and/or improve lives, making a positive impact in the world
- Benefit financially
  - How do scientists and the university benefit financially?
    - 40% is shared by Inventor(s)/Contributor(s)
    - 20% returned to the School/Department
    - 40% returned to the University
  - Distribution of the Inventor share is determined by inventors/contributors

# Workshop Summary

**Engaging with ORS and OTM early will allow you to help investigators throughout the research-commercialization cycle to ensure that research discoveries can be translated into intellectual property and successfully commercialized**

- Key questions to remember:
  - Is there previously created IP that needs to be considered in the context of new research agreements?
  - Is there new IP that will likely be created and how will the terms of the research agreement(s) impact commercialization?
  - Is there new IP that has resulted from research activities that should be disclosed and protected?
- Always involve ORS and OTM early and often
  - When in doubt give us a call!



# Questions?