Tech Transfer Resources for Teaching-Intensive Universities

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Outline

• Definition of University tech transfer
• Current tech transfer landscape
• Best Practices and Resources
• What is AUTM and how can it help?

What is Tech Transfer?

• Educated students entering the workforce
• Publishing and presenting scientific results
• Faculty consulting
• Conferences and events
• Licensing technology to commercial partners
Benefits of Tech Transfer

• Enhance the likelihood that new discoveries and innovations will lead to useful products, processes and services to benefit the general public.
• Propel new research collaborations, promote the exchange of materials, information and personnel with industry, and offer unique research opportunities for faculty and students.
• Provide income to fund new research, teaching programs and financial support for students.
• Assist in recruiting and retaining faculty and graduate students with interests in research and technology transfer
• Provide educational benefits through student internships and work-study opportunities
• Leverage business partners to stimulate local and regional economic development
• Enhance the reputation of the university to attract researchers, faculty and students

Bayh-Dole Act of 1980

• Provided a uniform policy to promote the commercialization of government-funded research
• Assigns title of any resulting inventions to universities, small businesses and other non-profits providing:
  - proactive efforts are made to commercialize inventions
  - preference given to small U.S. businesses
  - inventors share in any rewards from licensing
• Results: In 2008 alone:
  - 5,100 new agreements
  - 650 new products
  - 595 new business startups
  (source: AUTM survey)

University Objectives in Licensing

Primary Goal: Making the technology available to the public

Milestones are included to verify diligence by licensee toward commercialization

A fair commercial return; timing and form of the return can be tailored appropriately

Licensee must pay associated patent costs and costs of doing business (e.g., liability insurance, enforcing patents, etc.)
A Bit of History

- Vast majority of US TTOs formed in mid ‘80s to mid ‘90s
- third party organizations (RCT, UPI, independent consultants) did much of the work
- While current staffing averages 11, ~40% have 3 or less full time staff
- Disclosures have increased from a total of 11.6K in ’99 to 20K in ’08
- Licensing to small companies and startups represent almost 70% of the business
- Over 500 startups have been created each of the past 3 years (70% begin in the home state)

TTOs Vary

- Individual TTO’s mission and objectives defined by variety of factors:
  - Public vs. Private
  - Volume of research expenditures
  - Diversity of faculty research (Eng/Med/Vet/Ag, etc.)
  - Local/regional innovation ecosystem
- Funding and resources:
  - Much of TTO job remains service; not revenue generating
  - Minority of offices “Revenue Positive”; revenue sharing policies go mostly to inventors/colleges/administration
  - Majority of economic benefit to the private sector
  - Funding for patent expenses vs. salaries and other resources

Original Roles of TTOs

- Service to faculty on all aspects of IP
  - Education on IP (Patent and Copyright laws; Publication)
  - Disclosure management (B-D Reporting, tracking, IP protection)
  - Marketing and Licensing
  - IP Clauses in Sponsored Programs
- Focused almost entirely on patents
  - Today considerable “business in copyrighted materials/software/research tools"
- Revenue and business formation secondary at many universities
Evolving Issues and Roles

• External Uncertainties Combined with Increased Expectations
  Patent Office changes (increased costs, longer time)
  Decrease in venture funding for early stage tech
• Increased and more sophisticated deals
  Equity
  More complicated financial structures
  Professional training of tech transfer professionals
  Conflict of interest
• Translational Research/Gap Funding
• Business Formation/Incubators/Accelerators
  Offices with discrete biz formation group
  Mentors/Entrepreneurs in residence
  Entrepreneurial training
  Associated biz incubation/regional accelerators

University Stakeholders

• The Inventor
• The Department
• The College
• The University
• The State
• The Nation
• The World

Stakeholder Conflicts

• Dollars vs. Deals
• Royalties vs. Research Funds
• Startups vs. Established Licenses
• Licensees in Your State vs. Other States
• Access in Developing Countries
Specific Issues for Emerging Research Universities

- Compliance with Federal Regulations:
  - Invention Reporting
  - Patent marking
  - COI
- Patent Costs and Management
- People

Examples of Collaboration

- Wisconsin WiSys Program:
  - A wholly-owned subsidiary of WARF
  - Supporting basic research throughout the University of Wisconsin System
  - Licensing technologies to industry for the benefit of the University System, the inventor, the licensee, and society as a whole
- Historical relationship between Children’s Hospitals and Related University
- VA and related University

Association of University Technology Managers

- AUTM is a community of over 3500 technology transfer professionals working in academic, research, government, legal and commercial settings
- Dedicated to transferring research from academic/research institutions for the benefit of the public through commercial avenues
Association of University Technology Managers
Available Resources/Collaboration

- Professional Training (TOOLS class, regional meetings, webinars)
- Special Interest Groups for small offices
- Networking
- Standard Practice Guide/Standard Agreements
- Benchmarks