University Technology Transfer

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The Institute for Innovation & Entrepreneurship
About my background:

• Technical writing
• Teaching
  • University
  • Community college
  • Proprietary school
  • Online
• Science Editing
• University technology transfer office (IIE)
University technology transfer:

Manage and commercialize intellectual property (discoveries, innovations) developed at universities

• UAB’s technology transfer office was initially formed in 1987 as a non-profit corporation to identify, assess, protect, and market and license commercially viable intellectual property developed at UAB.
Demands on the 21st Century University

Now expected to do more than educate students & create knowledge:

• Serve as an economic engine for the city/state/region/nation
• Interact with industry and businesses in a business-like manner
  • Natural friction between contrasting cultures
• Increasingly expected to self-fund programs as federal and state support declines
  • One avenue for revenue generation: commercialization of the university’s intellectual property
The UAB Institute for Innovation & Entrepreneurship (IIE)

• Vision

To create an internationally recognized university institute that *inspires, discovers, innovates & creates* successful entrepreneurial ventures & valuable products.

• Mission

To provide, foster & promote a strong innovative & entrepreneurial ecosystem through education & experiential learning that will facilitate the successful practice of entrepreneurship at UAB, the region & beyond.
Develop and enhance UAB’s graduate and undergraduate programs in entrepreneurship, innovation & new venture management.

Create an “Innovation and entrepreneurial community” through the use of on-line resources, social media & hosted events.

Cast a broad net to identify innovations, pick the most promising ones & develop their commercial potential.

Provide entry point for worldwide industries to successfully collaborate with UAB.
The IIE will enable UAB to enhance the value & output of its research enterprise

• More commercialization will produce more innovation capacity

• UAB will not be as reliant on NIH, NSF and other federally funded research $

• Technology based economic development is a necessity in today’s uncertain funding environment
Career in Technology Transfer

• **Typical day?**
  
  • Reviewing new IP – at different stages of development
  
  • Protection:
    
    • Evaluating patentability
    
    • Copyright, trademark, other...
  
  • Working with patent attorney to file and prosecute
  
  • Marketing a technology to companies & negotiating license agreements
  
  • Working with PIs, companies and other UAB offices on securing funding and negotiating terms of sponsored research agreements
  
  • Forging connections between people across departments, and outside of UAB, to nurture development of specific technologies and economic opportunities
Career in Technology Transfer

• Tech transfer offices (TTOs) - search websites at individual universities
• Association of University Technology Managers (AUTM)
  • www.autm.net
QUESTIONS?

http://www.uab.edu/research/innovation/partner

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Bayh-Dole Act (University and Small Business Procedures Act)

- 1980 legislation dealing with intellectual property (IP) that arises from federally funded research
- Gave universities, small businesses and non-profits IP control of their inventions and other IP that resulted from such funding
- Reversed the presumption of title – permits institutions to elect to pursue ownership of an invention in preference to the government.
- Obligation to make developments available in exchange for receipt of government grants
  - Universities must file patents on inventions they elect to own
  - Encourage collaboration with industry to promote utilization of inventions
  - Preference for small businesses
  - Manufacturing in U.S.
  - Government retains non-exclusive license and march-in rights
  - Report patenting and utilization.
Types of Intellectual Property

• Patents
• Copyrights
• Trademarks
• Trade Secrets
• Other
University Technology Transfer

- A term used to describe a formal transferring of new discoveries and innovations resulting from scientific research conducted at universities to the commercial sector
Intellectual Property (IP):

• includes any new and useful process, machine, composition of matter, life form, article of manufacture, software, copyrighted work or tangible property

• can include new or improved devices, circuits, chemical compounds, drugs, genetically engineered organisms, data sets, software, musical processes or unique and innovative uses of existing inventions.

• is created when something new and useful has been conceived or developed, or when unusual, unexpected or non-obvious results, obtained with an existing invention, can be practiced for some useful purpose.

• can be created by one or more individuals, each of whom, to be an inventor, must have conceived of an essential element or have contributed substantially to its conceptual development.
Types of Intellectual Property

- Patents
- Copyrights
- Trademarks
- Trade Secrets
Types of Intellectual Property

- **Patents** – [www.uspto.gov](http://www.uspto.gov)
  - protect *novel, useful, & non-obvious* inventions – processes, machines, products, compositions of matter & improvements thereof
  - exclude others from making, using or selling claimed invention during term of issued patent (once issued, for 20 yrs from application filing date)

- **Copyrights**
- **Trademarks**
- **Trade Secrets**
Types of Intellectual Property

- **Patents**
- **Copyrights** – [www.copyright.gov](http://www.copyright.gov)
  - protect tangible expression of an idea (not idea itself)
  - requirements: original, expression of creativity (i.e., not a compilation of data), fixed in a tangible medium
  - prevent others from copying, distributing, displaying publicly, performing publicly or making a derivative work from the original work
  - arise spontaneously whenever expression is fixed in a tangible medium, such as on paper, in a computer file, or on a tape (Registration necessary to enforce, but not to create, rights.)
- **Trademarks**
- **Trade Secrets**
Types of Intellectual Property

• **Patents**

• **Copyrights**

• **Trademarks – www.uspto.gov**
  - Identify and distinguish an idea, written words, pictures or products from those of competitors (ex: The Coca Cola script name is a registered trademark that identifies the product. University example: Gatorade™, Univ of Florida)
  - Mark serves to distinguish and identify the origin of the product or services. Purpose: to prevent consumer confusion about the source of the goods/services.

• **Trade Secrets**
Types of Intellectual Property

• Patents
• Copyrights
• Trademarks
• Trade Secrets - *seldom applicable in the university setting*
  • Information that is not publicly known; produces economic benefit to the owner, and that the owner maintains as secret (e.g., formulas, devices, compilations of know-how).
  • Counter to academic mission of knowledge dissemination