Technology Transfer: Commercial Evaluation, Patenting & Marketing Primer
Disclaimer

• This presentation is for informational purposes only. It is not legal advice and should not be considered a substitute for legal counsel.
What is “Technology Transfer”?

• Technology transfer is a term used to describe a formal transfer of rights to use and commercialize new discoveries and innovations resulting from scientific research to another party.

• Benefits:
  – Leads to new products and services that improve our quality of life.
  – Adds billions of dollars to the U.S. economy
  – Supports hundreds of thousands of jobs.
  – Creates new businesses, industries and markets.
What are the Stages of Technology Transfer?

- Research
- Technology Disclosure
- Commercialization Evaluation
- Protection
- Marketing
- License/Sponsored Research Agreement
When to File an Invention Disclosure

• When do you have an invention/innovation?
  • Scientific/technical breakthrough
  • Concept or reduction to practice
  • Doesn't have to be a “big ticket” item
  • Realize a need in the marketplace

• Should you disclose? → YES!
  • Are there potential commercial benefits to the discovery?
  • Better, Faster, Stronger, Cheaper, Greener
  • Talk to us early and often! We can help determine when your research is at a point that it should be protected and/or commercialized

• PRE-PUBLICATION – the sooner, the better!
• Scientific breakthrough ≠ Commercial opportunity
Determining the Commercial Value

• Once a technology is disclosed to the University, it needs to be evaluated for commercial potential
  • Technologies are evaluated from a commercial perspective

• This differs from a legal or scientific evaluation
  • The scientific and creative side of inventions are generally top-notch
  • Science alone does not create a market
  • Similarly, just because a technology can be patented does not mean there is a market need for the innovation

• For successful commercialization efforts, it is important to match innovation value with market need
Commercialization Evaluation – Content

- Commercial Application
  - Relationship of the invention to a product-commercial application. What problem does it solve?

- Technical Technology Summary

- Competitive Landscape and Commercial Benefits
  - What are the top competing technologies?
  - How does this new invention compare to competing technologies?
    - Faster, Cheaper, Greener, Stronger, etc.
Commercialization Evaluation – Content Cont.

• Market Size and Trend
  - Define target industry/industry sectors
  - Describe size and current trend of the target industries

• Technical Development Direction
  - Develop a recommended pathway to development
  - Suggest additional applications or features for optimization
  - Identify regulatory/commercialization hurdles and provide advice for ways to overcome them

• Potential Partners Industry Partners
  - Who might be interested in licensing or developing this?
    - Industry Partners, Investors/VCs, Community/Economic Development Groups
What is Patentable?

- **US Code:**
  
  “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

- **What this means:**
  
  - Process, machine, manufacture, composition of matter
  - Inventorship—YOUR idea
  - New—Novel—no one has thought of (or at least published it) before
  - Non-obvious to someone skilled in the art
  - Useful
The Patent Process (in a nutshell)

- **Provisional Patent (US only)**
  - One year
  - No prosecution

- **Patent Cooperation Treaty (PCT)**
  - 18 months (generally)
  - Then you choose the countries in which to “nationalize”

- **Non-provisional US application**
  - Prosecution occurs here
  - Office Actions and other back and forth with USPTO
  - Issuance and subsequent applications

- **Annuity Fees**
Let’s Go Fishing! (Marketing)

• Two Types of Marketing
  • Passive
    • Publication
    • Website Posting
    • Other Technology Databases
  • Active
    • Existing relationships
      • Research relationship
      • Existing commercial partner or sponsor
    • Industry & Economic Development Meetings (Active & Passive)
    • Direct Marketing
      – Identify and contact potential partners
The Bait (Marketing Documents)

• Non-confidential document
  – 1st document sent to potential partners
    • Covers
      • Summary of the technology
      • Highlights key benefits of the invention
      • Commercial application defined
      • Market space defined
      • Inventor Bio

• Marketing list of potential partners

• Additional non-confidential materials
  - Publications, pictures, videos, graphics and presentations
  - Delivered if the potential partner requests additional information
Marketing – Contacting Potential Partners

• Initial contact is made through a phone call, if possible

• Subsequently an email is sent with attached Non-Confidential Document

• Additional information is sent as requested

• CDA executed if an inventor/industry phone call is requested or confidential materials are requested

• MTA executed if a prototype is requested
Marketing – Things to Remember

• Companies are interested in the inventor as well as the technology
  • Inventor Participation is KEY!!!

• The Importance of Feedback
  – Potential industry partners can provide valuable feedback related to a technology
    • The technology won’t fit in the market because...
    • If it did this better, we would be interested
    • It does not dramatically affect our margins on our existing products
    • Regulatory hurdles
  – Feedback should be shared with inventors
    • May assist in directing the research goals and business plan
    • Could be an easy fix
A few final points . . .

• Maximize the impact of your research!

• Your participation in the process is of UTMOST importance

• Reporting requirements under federal grants

• Effect of Publication
Q&A