

Technology Transfer

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Introductions

- Phil Rufe - Technology Transfer Coordinator, EMU.
- Brian Anderson – Director, Office of Research Development, EMU.
- Caryn Charter –Associate Director, Office of Research Development, EMU.

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Agenda

- Overview of technology transfer.
- Overview of EMU technology transfer policy.
- U-TEAMED overview.

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What is Technology Transfer?

- Transfer of University-developed innovations into the marketplace for the benefit of the community, general public, and University.

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Why Technology Transfer?

- Innovation and its dissemination is the first and foremost goal.
- Revenue generation perpetuates the research and technology transfer process.

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Who should participate?

- Faculty
- Students
- Employees

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Idea vs. Invention?

- Idea – problem statement
- Invention
 - solution to the problem
 - embodiment of the solution
 - Computer code
 - Prototype
 - Chemical formulation
 - Electronic schematic

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Intellectual Property (IP)

- Patent
 - any person who “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.” (35 U.S.C 101)
- Copyright
 - protects the form of expression rather than the subject matter.

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What does a patent do?

- A patent is a property right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States for a limited time.
- It does not guarantee revenue.

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Practical and Legal Considerations

- 1984 Bayh-Dole Act
 - Federal funding does not require inventions to be "public domain". Public domain often inhibits public benefit.
 - The University has the option of retaining title to an invention resulting from federal funding.
 - If the University does not elect to retain title,
 - the federal funding agency may take title to the invention.
 - inventors can request title from the agency.

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Industrial Contracts

- University retains title to the invention in exchange for granting an exclusive license to the industrial sponsor.

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Commercially Viable Technology

- Applied vs. basic research
- Commercial viability
 - ORD/U-TEAMED will make that determination.
- Disclose even if you don't think it has potential.
- Examples
 - computer software
 - inventions
 - techniques
 - other technology and improvements to existing technology

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When should I contact Phil or ORD?

- Preferably prior to a public (oral or written) disclosure.
 - After a public disclosure, we lose foreign filing rights
 - Twelve months after a public disclosure, we lose U.S. filing rights
- Tech transfer process is not intended to inhibit publication.
- If you are “stuck” in your research due to time, budget, or equipment constraints

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What are the steps?

- Complete an invention disclosure form and submit any publication and/or presentation you have or will make.
- ORD will decide if the disclosure will be forwarded to UTEAMED for additional assessment.
- UTEAMED (Michigan Tech) will assess the technology’s commercial viability.
- If favorable, inventor(s) assign IP rights to EMU.
- EMU will file a patent application and begin the licensing process.

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EMU Technology Transfer Policy

Historical Background

Technology Transfer Policy Development Committee

Initial Meeting: January 27, 2005

Members: Brian Anderson – ORD
John Dugger – College of Technology
Marianne Laporte – Dept. of Biology
Ken McKanders – EMU Legal Affairs
Susan Moeller – Dept. of Accounting & Finance
Donald Snyder – Dept. of Chemistry
Denise Tanquay – College of Business
John Texter – School of Engineering Technology

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This Policy is intended to:

- Expedite technology transfer and the dissemination of useful knowledge.
- Protect and balance equitable rights of faculty inventors, research sponsors, the University, and the public.
- Support and stimulate additional research and inventions.
- Prevent improper exploitation of inventions and inventors and abuse of new information.

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Ownership

- Faculty own what they create outside of sponsored research.
- University owns what faculty create as a result of sponsored research, unless otherwise indicated by a research agreement.

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What is Sponsored Research?

- Research conducted at EMU facilities funded or otherwise supported at a level beyond a faculty member's normal duties.
- Research for which a faculty member receives from the University, additional salary, research award, release time, sabbatical leave, and/or Spring/ Summer Research Award.
- Research that is funded by a research grant, agreement, contract, or research award administered by the University.

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Royalty Distribution

	<u>Net Income</u>	<u>Inventor</u>	<u>University</u>
Up to \$10,000		100%	0%
Next \$240,000		55%	45%
More than \$250,000		45%	55%

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U-TEAMED Overview

- Collaboration of Michigan Tech, Oakland, Central, and Eastern Michigan Universities
- Initiated in September 2004 with partial funding from MTTC grant through MEDC
- Intended to leverage complementary strengths of each partner institution to produce growth in sponsored research and technology transfer.

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Collective Mass 2004 Data

	U-TEAMED Partners	University Of Michigan	Michigan State University	Wayne State University
Number of Faculty	5,426	5,154	2,767	2,629
Number of Tenured Faculty	1,516	1,841	1,304	699
Number of Students	71,750	38,618	44,937	29,200
Number of Michigan-resident Students	67,693	22,757	40,362	26,712
Annual State Appropriation (2002/03)	\$285 M	\$364 M	\$326 M	\$254 M
Research Expenditures (NSF Report 2004)	\$51 M	\$769 M	\$325 M	\$225 M

Michigan Tech's Support Role

- Assist in:
 - Commercial opportunity assessment
 - Development planning
 - Protection strategies
 - License strategy and negotiation
 - Sponsored research negotiation

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Michigan Tech Background

- Tech Transfer Office established in 1987
- Three licensing staff (one from U-TEAMED)
- Three year averages for Michigan Tech:
 - Invention disclosures - 40
 - Licenses - 8
 - Royalty revenue - \$450K

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