

University Technology Transfer Transactions

Fiona Wills
Director, Invention Licensing
UW TechTransfer

LSI Conference on Biotechnology

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INNOVATION. INVESTMENT. IMPACT.

Our mission

- ❖ To extend the impact of University of Washington research through the creation of partnerships that encourage investment in innovation

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What we do

- ❖ Intellectual Property Rights Management & Licensing
- ❖ Reporting of Federal Research Funding
- ❖ Outreach and Education
- ❖ Business and Economic Development
- ❖ Revenue Management and Disbursement

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About Us

- ❖ Invention Licensing Unit
 - Technology Managers/Licensing Officers
 - Patent Management Group
 - Agreements Group
 - Legal Affairs/Federal Reporting
- ❖ Digital Ventures Unit
 - Technology Managers/Licensing Officers
- ❖ Finance and Operations

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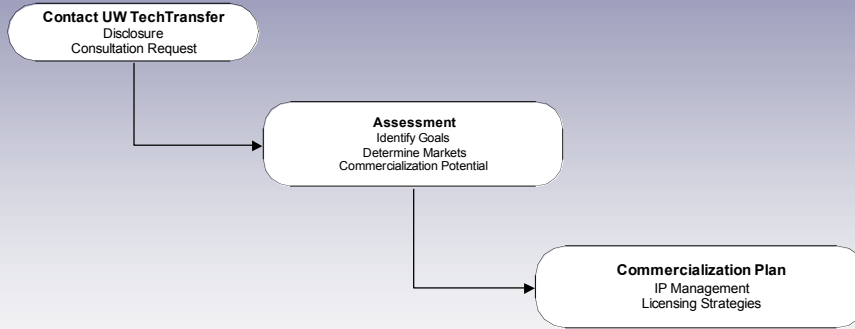
Types of IP

- ❖ Know-How
- ❖ Patents
- ❖ Materials
- ❖ Copyright
- ❖ Trade Secrets
- ❖ Trademarks

Transaction Types

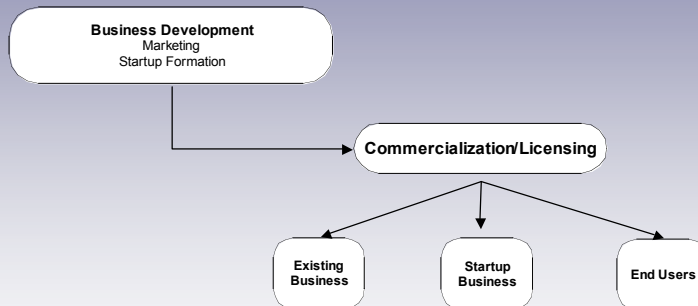
- ❖ Licenses and Options
- ❖ Agreements
 - ❑ Material Transfer
 - ❑ Confidentiality
 - ❑ Interinstitutional
 - ❑ Patent Management
- ❖ Sublicense Review
- ❖ Enforcement Activities

How the process works



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How the process works

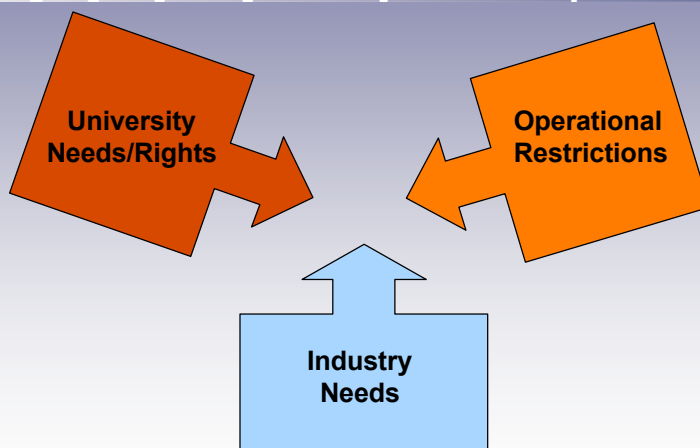


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How to best work with us

- ❖ Alignment of expectations
 - ❑ Culture
 - ❑ Business needs
 - ❑ Ability to perform
 - ❑ Technical abilities of the partner
- ❖ Give us a call

The convergence zone



University Needs/Rights

- ❖ Broad dissemination of technology
- ❖ Bayh-Dole compliance
- ❖ The right to publish
- ❖ The right to practice
- ❖ The right to do MTAs
- ❖ The right to do collaborative or sponsored research

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Industry Wish List

- ❖ Ownership of inventions
- ❖ Freedom to practice
 - ❑ Non-exclusive, royalty free, paid up license
- ❖ Ability to control publication
 - ❑ Protect confidential information
 - ❑ Ensure IP protection
- ❖ Rights to improvements
- ❖ Rights to future inventions

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Restrictions on Operations

- ❖ Restrictions from funding agencies
- ❖ State Ethics Act
- ❖ University policy

License Agreement terms

- ❖ Financial
- ❖ Non-Financial

License Agreement Terms

❖ Financial

- License Fee
- Maintenance Fee/Minimum Annual Royalties
- Royalties
- Patent Expenses / Cost Reimbursement
- Milestone Payments
- Sublicensing Consideration
- Equity

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License Agreement Terms

❖ Non Financial

- Performance Diligence
- Representations & Warranties
- Indemnification
- Reports & Auditing
- Sublicensing Rights & Requirements
- Control of patent prosecution
- Settlement of infringement/validity suits
- Reservation of Rights
- Net Sales Definition
- Know How / Consultation Rights
- Future/Background Rights

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Non-License Agreement Terms

- ❖ Material Transfer
- ❖ Confidentiality
- ❖ Interinstitutional
- ❖ Patent Management

Effective License Agreements

- ❖ Effective licensing results in diligent development and distribution of University technology.
- ❖ Effective licensing efforts should facilitate the business goals of the licensee.
- ❖ License structure is used to balance the potential value of the technology against the risks.

Deals that don't get done...

Differences in opinion over

- Diligence
- Exchange of information
- University retained rights

And

- Inability/unwillingness to find a middle ground

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Deals that get done

- ❖ Issues on the table rather than positional bargaining
- ❖ Agreeing on principle rather than exchanging redlines
- ❖ Listening to where our limitations lie
 - We can't tell investigators what research to do, how to do it, what not to do, how not to do it

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Thank you

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Additional information can be found on the UWTT website
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www.depts.washington.edu/techtran

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