INNOVATION

Technology Transfer:
The Business of Intellectual Property

Bin Yan, PhD, JD
Director
Office of Technology Transfer
University of Miami

Technology Transfer

- What is Technology Transfer?
- Why are we doing it?
- What does it entail?

Technology Transfer

- **What is Technology Transfer?**

  "Technology transfer is the process of transferring scientific findings from one organization to another for the purpose of further development and commercialization" (AUTM)

Technology Transfer

- **Why are we doing it?**

  There are a variety of reasons:

  For example, the Bayh-Dole Act obligates universities to proactively protect and market technologies developed with federal funds or else forfeit them to the federal funding agency.

Technology Transfer

- **Why are we doing it?**

  There are a variety of reasons:

  Societal benefits
  Attracting industry sponsored research funding
  Generating revenue for the institute(s)

As an example, UM's position on Technology Transfer is codified in the Faculty Manual

Who is covered?

- UM Faculty Manual
  https://fs.miami.edu/_assets/pdf/facultysenate/Documents/FacultyManual.pdf
  - UNIVERSITY OF MIAMI POLICY ON INVENTIONS, INTELLECTUAL PROPERTY AND TECHNOLOGY TRANSFER
  - all full- and part-time faculty, staff and employees, students, fellows and non-employees who use University funds, facilities or other resources, or participate in University-administered research, including visiting faculty and industrial personnel, regardless of obligations to other companies or institutions ("**Applicable Personnel**")

U INNOVATION

UM's Position on Technology Transfer is Codified in the Faculty Manual

What is covered?

- UM Faculty Manual https://fs.miami.edu/_assets/pdf/facultysenate/Documents/FacultyManual.pdf

- "**Innovations**" patentable or un-patentable inventions, discoveries, processes, compositions, research tools, data, ideas, databases, know-how, **copyrightable works that are not scholarly or artistic Creations** and tangible property, including biological organisms, engineering prototypes, drawings, and software created, conceived or made by Applicable Personnel within their normal duties (including clinical duties), course of studies, field of research or scholarly expertise or making more than Incidental Use of University's resources
- Innovations are owned by the University
- This policy governs in the event of any inconsistent obligations to which Applicable Personnel may agree, including in an consulting agreement.

U INNOVATION

Technology Transfer

- **What does it entail?**

Identifying promising intellectual property

Intellectual Property

- Patent
- Copyright
- Trademark/tradename
- Trade secrets and know-how, data
- Proprietary materials

Criteria for Patentability

- Novel
  New, never before used
- Useful
  Must have a purpose or intended use
- Non-obvious to someone “skilled in the art”
  Peers and/or patent examiner would not readily identify the improvement or new application

What constitutes a publication? Examples include:

- **Electronic publications (e.g., Internet)**
- **Dissertations submitted to university libraries**
- **Printed slides accompanying presentation**
- **Scientific meeting presentations, poster presentations**
- **Foundation news letters**
- **ClinicalTrial.gov**

Confidentiality Agreements

- Always complete a Confidential Disclosure Agreement (CDA) prior to discussing the enabling aspects of your research with an outsider.
- A CDA protects your know-how

Technology Transfer

- **What does it entail?**

  Marketing & licensing of promising technologies

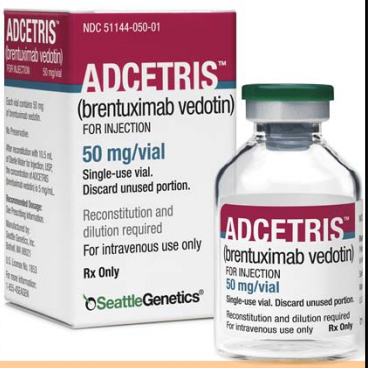
It does not have to be patentable in order to be commercializable

- Unpatented materials that have been successfully licensed and commercialized.
- Know-how, data, software, proprietary materials, techniques are all part of Intellectual Property.

IP Strategies for Protecting Cell Therapy Products

- Background IP
- Patents
- Data exclusivity
- Cell line exclusivity
- Manufacturing know how and trade secrets

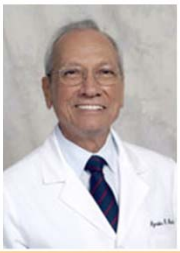
Technology Transfer



• An anti-CD30 monoclonal antibody developed by Dr. Eckhard Podack in 1992 was licensed to Seattle Genetics in 1999.

• The antibody led to the development of Adcetris, the first new treatment in years for CD30-positive lymphomas.

Technology Transfer



- Dr. Azorides Morales et al created a revolutionary new way to test tissue samples so that the patients learn the results of cancer biopsies and other surgery in just one hour instead of next day.
- The technology was licensed to Sakura which is selling the Tissue Xpress devices worldwide.

Thank you!