

Technology Transfer: Protecting and commercializing University Innovations



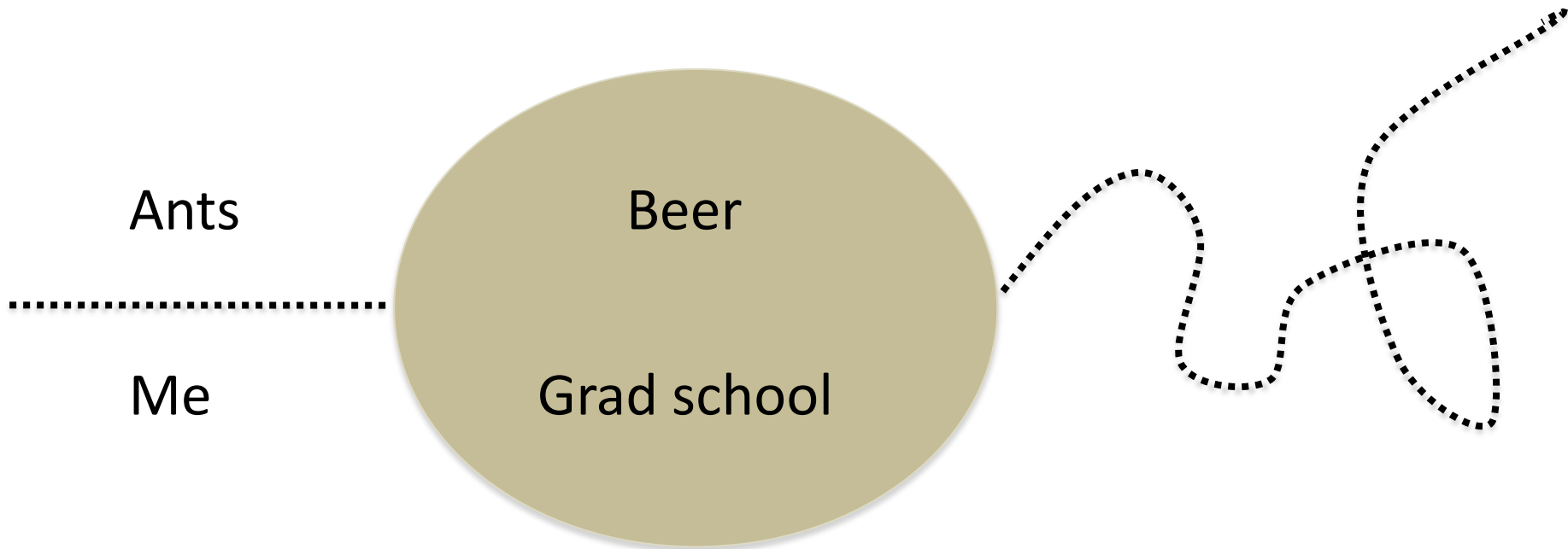
Mark Staudt

Licensing Manager: Wisconsin Alumni Research Foundation (WARF)

(University of Wisconsin – Madison)

mstaudt@warf.org <https://www.warf.org/>





My perspective...



BS: ChemE
BA: Plan II



PhD: Biomolecular Chemistry



Technology transfer is a confluence...



Where could you work?



- Universities
- Industry
- Government
- Law firms
- Start-ups
- Venture capital



Bayh-Dole Act (1980)

Before:

- Gov't took title to inventions from federally funded research.
- ~5% of inventions were commercialized (licensed)

Objectives:

- Improve U.S. industrial competitiveness
- Encourage U.S. economic development

Results:

- Universities take title to inventions from federally funded research
- More technology is reaching industry

The Act is "perhaps the most inspired piece of legislation to be enacted in America over the past half-century," - The Economist.

Intellectual property (IP)

Definition: Creations of the human mind
(items of information or knowledge)

Four main types:

Copyright: ©

- *Original works*

Trademarks: ®
TM

- *Identifies commercial entity:*



Trade secrets

- *KFC recipe and Coke formula*

Patents

- *USPTO*

Steps in University Licensing

Disclose invention

- Faculty/Student disclose technology to OTT
- Licensing officer meets with inventors

Protect IP

- Licensing officer evaluates invention
- Develops and enacts IP protection strategy with outside counsel

Market and license

- Develop Non-disclosing descriptions for web
- Values technology and negotiate licenses
- Manage licenses

To protect or not to protect?

Intellectual Property position

- Is it patentable? (novel, useful, non-obvious)
- Prior art landscape
- Narrow vs. Broad rights

Commercial/economic position

- Size of market
- Time to market
- “Game changer” vs. improvement
- Licensee in hand

Additional factors

- Options
- Joint IP?
- *PI/inventor “Buy-in”*

Licensing considerations

Are they a good partner?

- Knowledgeable in space
- OK with some R&D
- Good plan and means to execute

Fair return to the university

- “Comparables”
- Share in potential upside

Additional factors

- Reputational risk for University
- Legal/contract details

Day in the life...

- Check email for any fires
- Meetings
 - Inventors, licensees, internal, etc.
- Manage IP decisions
- Review agreements
 - MTAs, CDAs, License agreements
- More emails/calls
 - Very much an “office job”

Rainbows

- Stay close to research
- Help products get to market
- Interact with amazing people
- Help people achieve goals
- See tangible(-ish) work products – contracts
- Variety



- Mission oriented work
- Quality of life
 - No billable hours
 - Set own pace of work
 - Academic setting
 - Worklife balance



Rainclouds

- Lots of email/high volume
- Understaffed at times
- Lots to know
 - Miles wide, inch deep if lucky
- Data always lacking
- Hard to focus
- Lower salary (vs industry)
- Unique – smaller niche world
- Fairly flat structure
 - Eg: move to advance

Bull 💩



Remember, a job is still a job

like people, friendships, relationships,
etc. ... they all have rainbows and
rainclouds

Find those trade-offs that work for you
(and be ok with them)

“This is Water” – David Foster Wallace



Skimmers

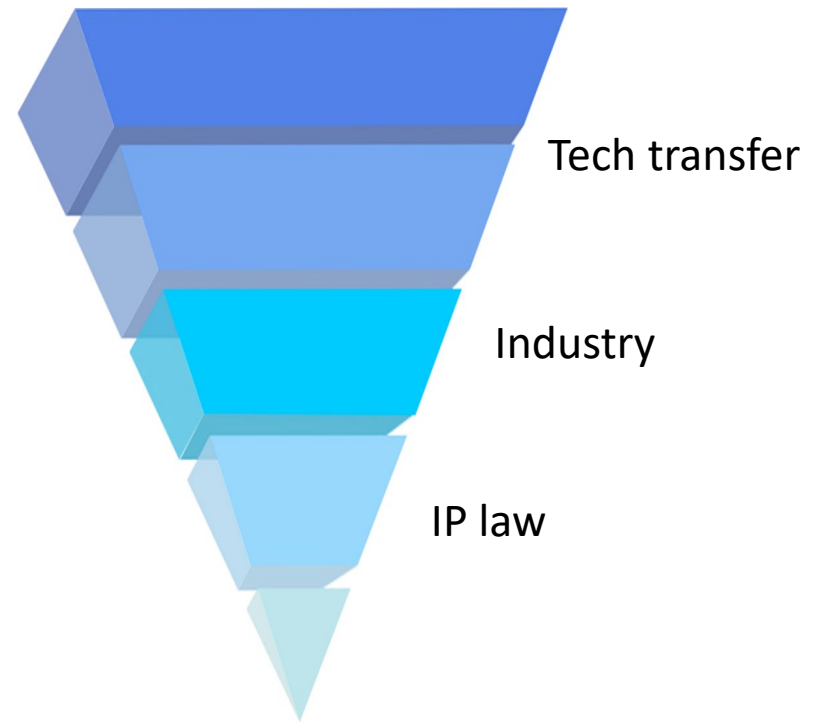
- Where do you like to work?
- How much detail?
- How comfortable with gut checks?
- Do you like to know little about a lot, or vice versa?

& Divers



Intellectual Property (IP) Law

- More lucrative
 - Billable hours
 - Lifestyle (not the client)
- More Diver-ish
 - More detailed
 - More focused
 - peer reviewed level



Transferable skills/traits needed

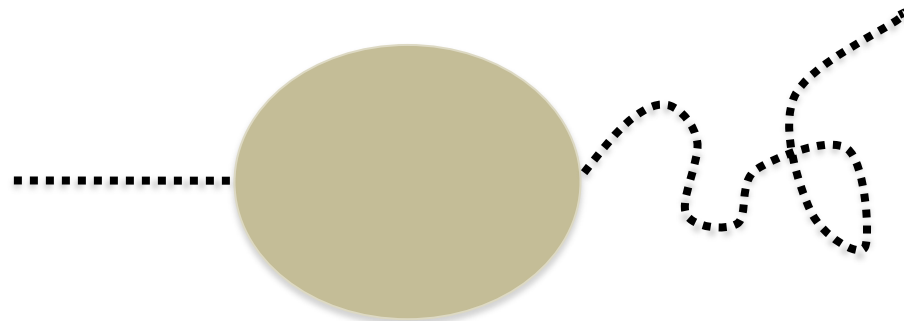
- Communication skills
- Ability to multi-task
- Interpersonal skills
 - Managerial (?)
- Adaptability
- Network building
- OK with some chaos
- OK with limited data



--Negotiation → Rice interview

Weave a narrative

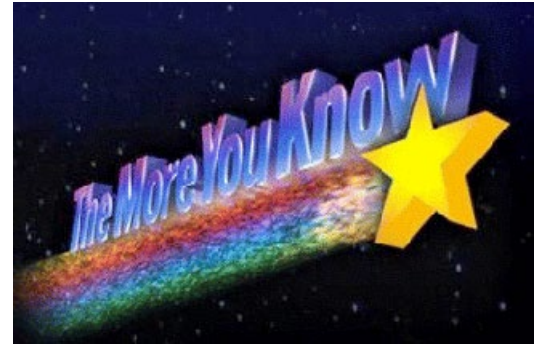
- Research your target
 - Diction/word choice
- Plausible story
 - Narrative hook
 - Networking: “Referred by _____”
- Highlight transferable skills
 - Bite size examples (practice anecdotal answer or 2)



IP resources

- Association of University Technology Managers (AUTM)
 - <http://www.autm.net/Home.htm>
 - https://careercenter.autm.net/jobs/?str=1&max=25&sort=start_&vnet=0&long=1
- Licensing Executive Society (LES)
 - <http://www.lesusacanada.org/>
- USPTO
 - <http://www.uspto.gov/>

General career resources



- What Color Is Your Parachute? 2011: A Practical Manual for Job-Hunters and Career-Changers
 - by Richard N. Bolles
- Alternative Careers in Science, Second Edition: Leaving the Ivory Tower (Scientific Survival Skills)
 - by Cynthia Robbins-Roth
- So What Are You Going to Do with That?: Finding Careers Outside Academia
 - by Susan Basalla and Maggie Debelius



BREATHE
You've got this

