

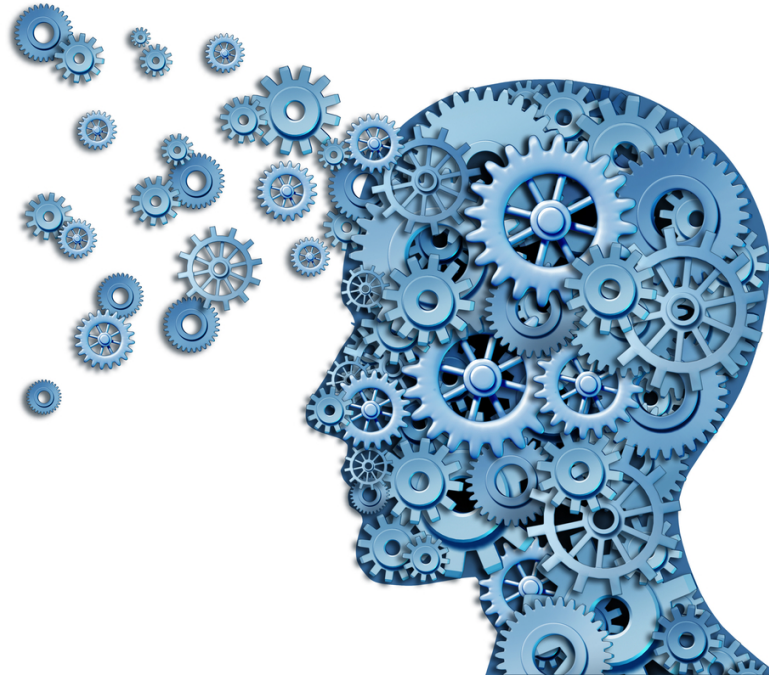


Technology Transfer: Commercial Evaluation, Patenting & Marketing Primer

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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 a 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
