

Office of Research Awareness presents:

Introduction to Technology Transfer

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Syracuse University

Office of Research

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Office of Research, Syracuse University

- **Office of Technology Transfer (OTT)**
- **Office of Sponsored Programs (OSP)**
- **Office of Proposal Support Services (OPSS)**
- **Office of Research Integrity and Protections (ORIP)**
- **Syracuse Office of Undergraduate Research & Creative Engagement (SOURCE)**

Meet Office of Technology Transfer Team:

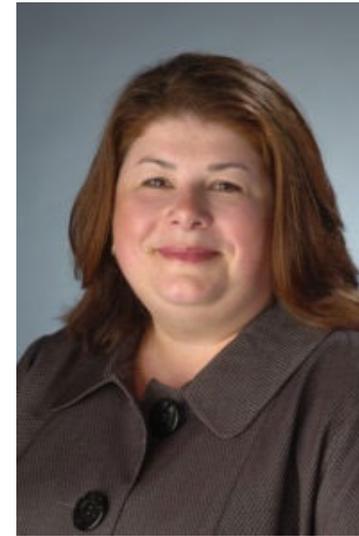
Jennifer Crisp, J.D.

Director



Elizabeth “Beth” Jeffery

Operations Specialist



Not pictured: Outside Intellectual Property/Patent Counsel

Point of contact for **intellectual property (IP)** matters including patents, software, copyrights, and data rights

What We Do

- Advise on IP-centric (patent, software, copyright, data) contract terms appearing in research grants, and IP policy.
- Manage the segment of IP developed by university faculty that has commercial value & *which is also owned by SU*.
- Execute contracts and agreements
- Central unit
- Liaison between the university and industry; and the university and government, as relates to IP

Technology Transfer Supports Faculty, Post-Docs & Grad Students

- Services are available across all schools and colleges, regardless of discipline/department
- We wear many “hats” and are many things to many people
- Our constituencies are internal and external (our focus today is on the internal....)
- External constituencies include industry, government, and other universities in the US and abroad

A Bridge From the Academy to the World

“Syracuse is a top-tier international research university, where academic inquiry spans and unites a full range of disciplines. From chronicling Fascist imperialism in Europe to detecting deep-space gravitational waves, faculty and student researchers bring diverse expertise and perspectives in order to advance fundamental understanding and address pressing global needs.”

Technology transfer: moving university knowledge and discoveries beyond the walls of the academy, and beyond the confines of academic publications, for the benefit of a broader base.

Intellectual Property is What Brings Us Together

Section 3.23 of the SU Faculty
Manual: Ownership and Management
of Intellectual Property



Why U.S. Universities Have IP Policies

- Bayh-Dole Act
- Obligations of university community members to report IP to a designated office
- Incentives to commercialize, including sharing of the financial “upside” of IP licenses with innovators and to support continuing research and innovation
- Ownership of IP
- Management of IP
- IP protection is attractive to industry

Syracuse University IP Policy

- A few notes about the policy
 - The term “Technology”
 - Patentable inventions treated differently than non-software copyright
 - Software treated more like a patentable invention
 - SU ownership of Technology & IP is clearest when there is a sponsored project
- Academic publications, and the copyright that affixes to them, are treated consistently with long-standing academic principles

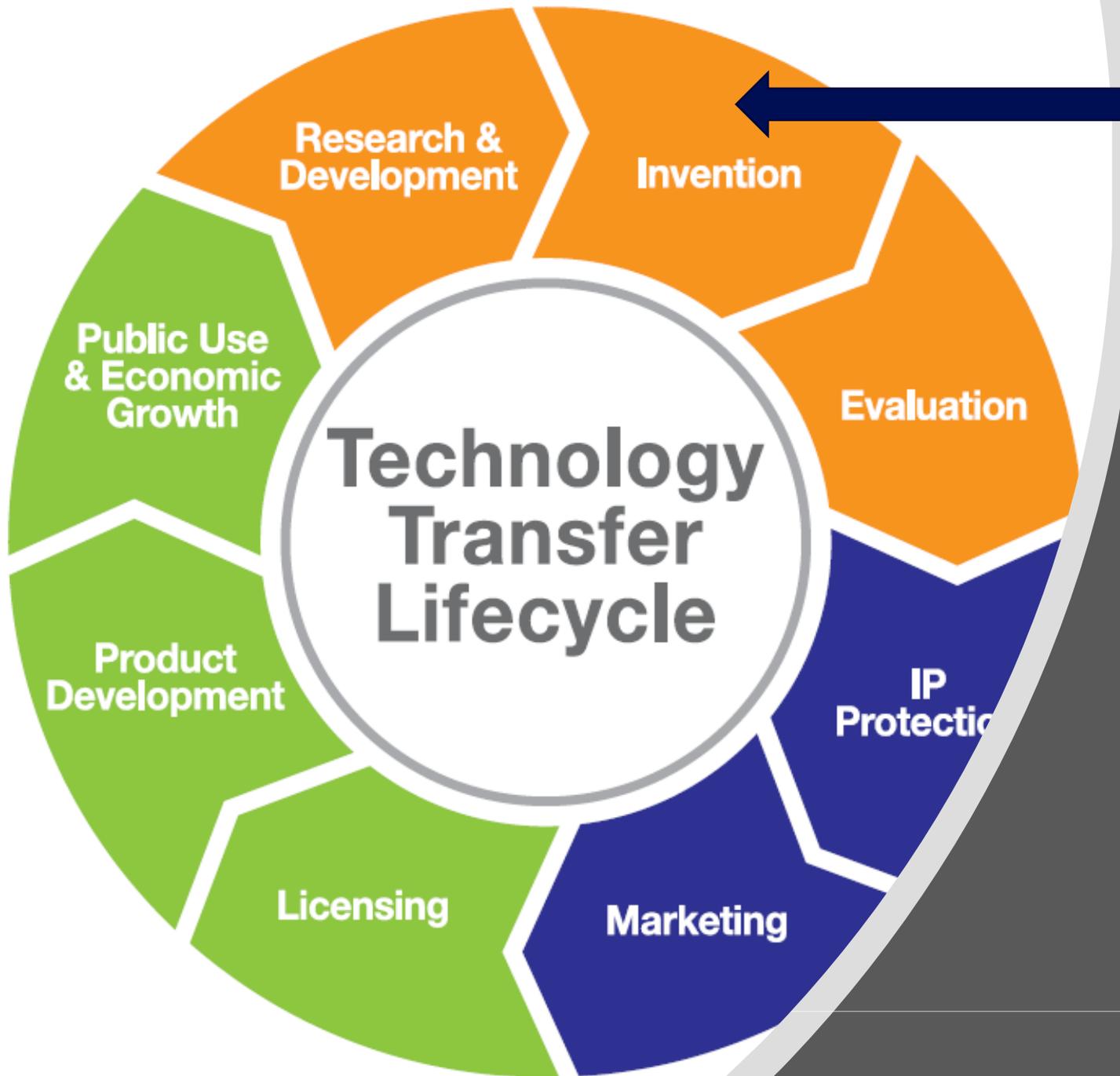
Syracuse University IP Policy

- This internal policy *clarifies IP matters*, thus positioning SU to make contractual obligations to third parties relative to IP
 - Federal grants
 - NYS grants
 - Corporate Sponsors
 - Multi-party research efforts/collaborations
- How any given discovery is treated under the policy is influenced by “the origin story” of the discovery

Why Technology Transfer Exists

“Pure” Technology Transfer

- To strategically move compelling discoveries from academia (i.e. labs, scholarship; your domain) to the commercial marketplace.
- We do this via **Intellectual Property (IP) licensing** (our domain).
- Licensing affords companies rights to create products and services based on university-developed innovation with a goal of improving lives, spurring economic development, and returning value to the university.

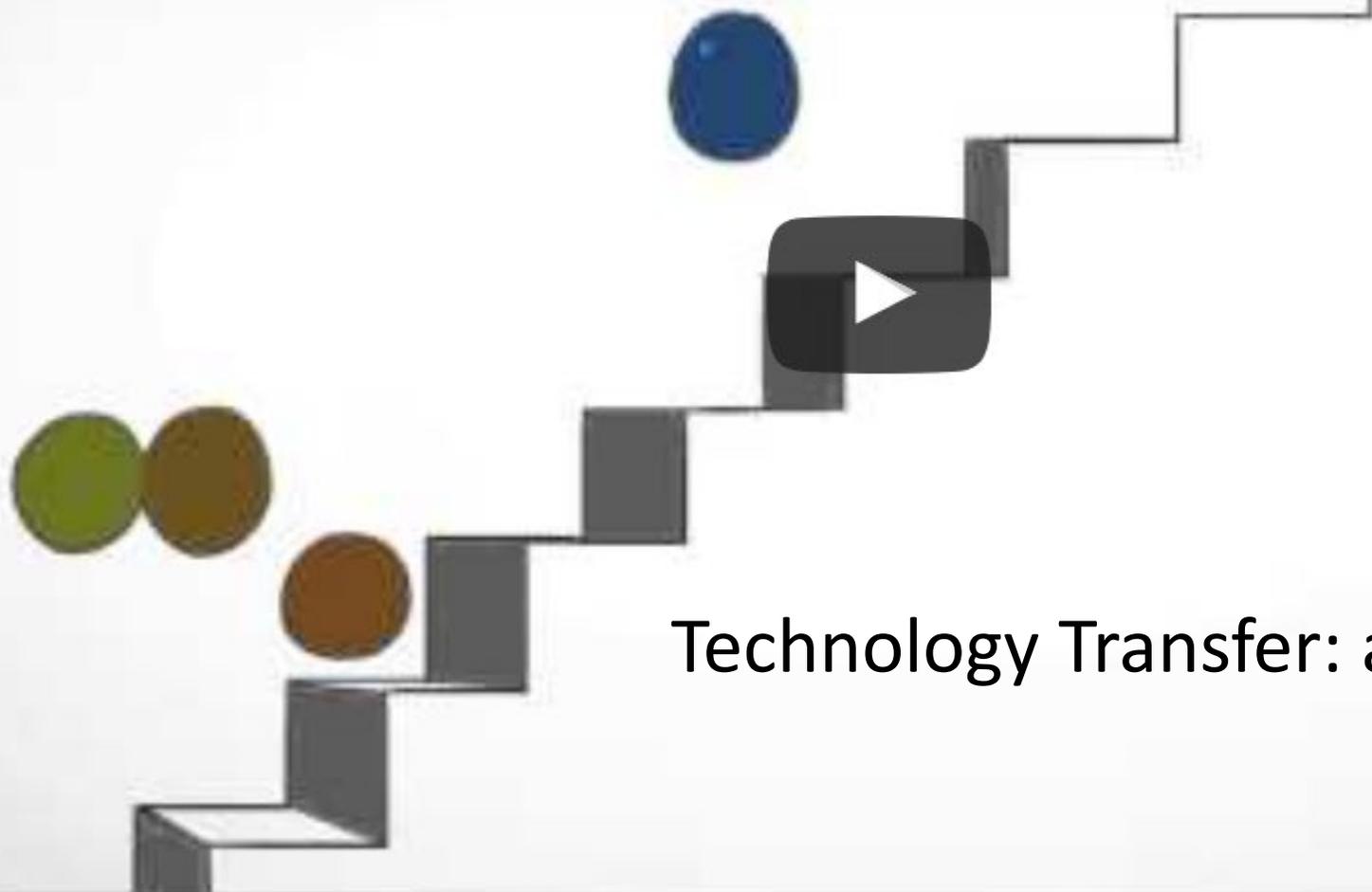


You are here.

We rely on you to communicate with OTT.

Timing is important.

About Technology Transfer



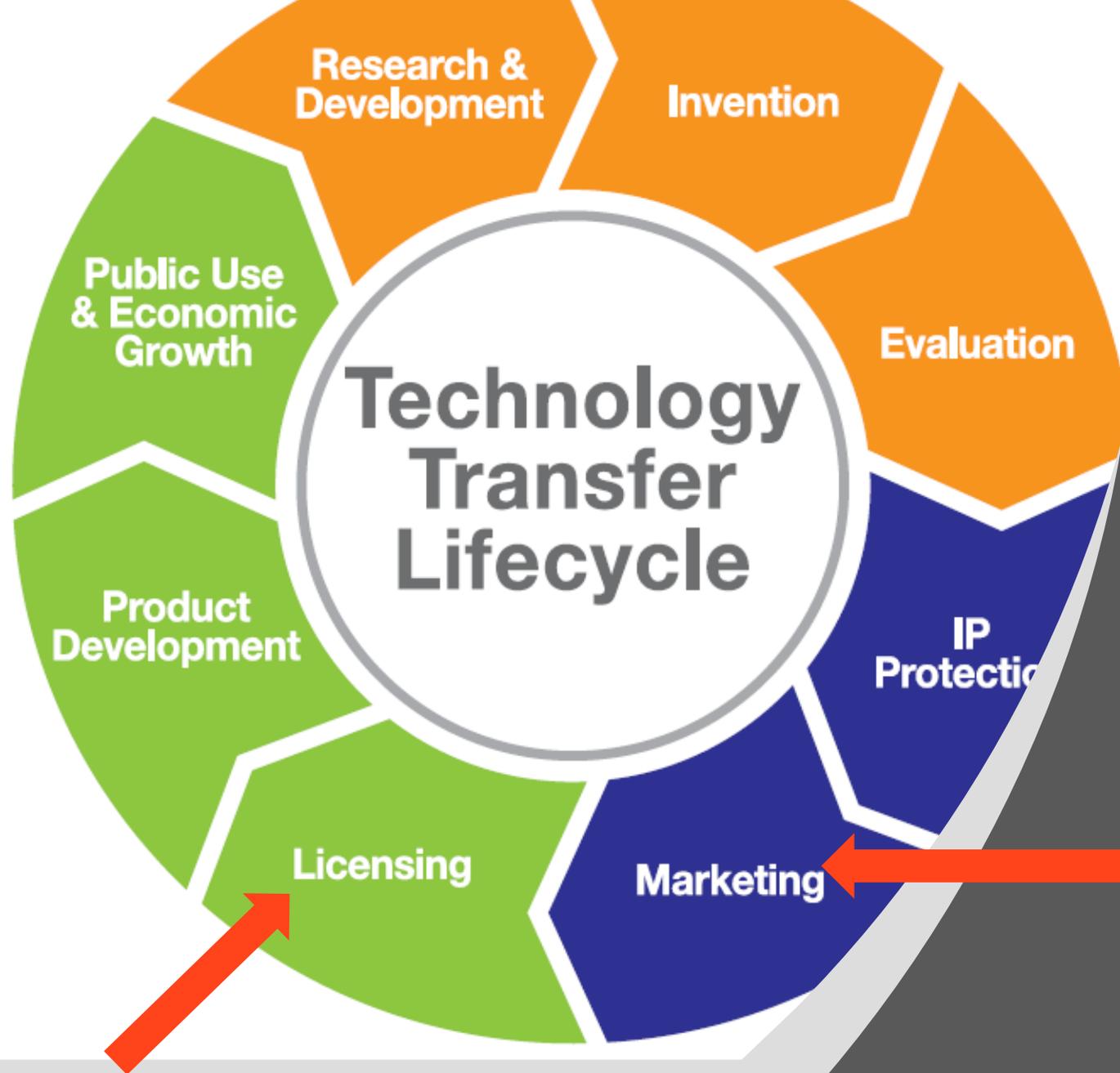
Technology Transfer: at it's core....

Leveraging Intellectual Property (IP) Developed at SU

- IP awareness, acumen and action - critical for success...
 - for you, your graduate students and post-docs
 - at a minimum, faculty are to report IP to OTT to enable SU to comply with IP laws and funding contract terms

More on IP Reporting to Technology Transfer Later . . .





What makes a good licensee target?

Commercialization strategy

Commercialization mindset

Existing company as licensee?

New company as licensee?

NSF I-Corps Program



The National Science Foundation's Innovation Corps (I-Corps™) program uses experiential education to help researchers gain valuable insight into entrepreneurship, starting a business or industry requirements and challenges.

Corporate sponsors and multi-party collaborations often require negotiated IP terms

Technology Transfer provides internal, researcher-centric support to OSP on IP and IP-related terms in Master Collaboration Agreements and Corporate Sponsored Research Agreements

We monitor trends in university-industry engagement via multiple modalities.



University-Industry (“U-I”) Resources

- UIDP
 - See also answers.syr.edu for additional content
- NACRO
- AUTM
- NACUA



Complementary & Adjacent Expertise and Services



- 1) Inter-Institutional Agreements
- 2) Confidentiality Agreements
- 3) Material Transfer Agreements
- 4) Considerations when contemplating starting a company
- 5) Advanced IP coaching for complex scenarios and when engaged with corporate entities
- 6) Consulting Agreements

Timing and Connecting with Technology Transfer

- Thinking and communicating ahead of collaborative proposals: multi-institutional proposals
 - These proposals might require an “Intellectual Property Strategy”
- Lead time: As much as possible!

Who reports IP to Sponsors?

- 1) Investigator
- 2) OSP
- 3) OTT



How do I go about reporting “technology” and software and patentable inventions to OTT?



Report innovations to Syracuse University Office of Technology Transfer

<https://techtransfer.syr.edu/innovators/submit-an-invention/>



The What: Description/Abstract: Technical Description | Non-Technical Description

The What, in context: What are the immediate/future applications of this invention? Why is this invention better/more advantageous than what is currently available?

Technology readiness/R&D status: Is work on this invention continuing? In answering, include information on whether there are limitations to overcome, or tasks to be done prior to practical application? Also, what further research and development is necessary? Is there test data?

What is your understanding of the “**Market Opportunity**” for this Tech/Innovation?

When: (timing/time bar)

Past: Has this innovation been disclosed in an abstract, paper, talk, news story, or a thesis?

Describe.

Immediate future: Do you intend on submitting a paper for publication? When? Will you also (or only) submit the paper to an Open Access repository? Which one? When (earliest date)

Agreements of note: Was this invention created or discovered under one or more funded projects?

The who: Who contributed to this innovation/invention? For each “involved individual,” describe his/her/their contribution to invention:

- Conceived of or collaborated on the conception of the solution
- Individual built, tested, or conducted experiments to establish that the solution works after the initial conception
- Both of the above



**A few words about
academic papers,
research posters and the
like...**

Publishing: your bread and butter

Publishing & Patenting are not mutually exclusive, but note:

For patentable technologies, sharing information outside your team, without confidentiality can irrevocably extinguish foreign patenting rights and start a one-year clock to patent in the U.S.

- And that is why it is critical to report possibly patentable technologies to the Office of Technology Transfer well in advance of a publication, conference presentation, and especially before uploading to an Open Access repository. 
- This is frowned on by the US government
- Can be quite limiting for the future of the technology beyond academia

Goal: decrease the frequency of “emergency” patent filings and the game of “beat the clock”

Timing of engaging with OTT

- The individual (faculty/student researcher/employee) has a duty to report the invention so that it can be evaluated and managed
- Timeliness of reporting is essential

Patent Resources

- USPTO.gov
- OTT website
 - *Inventor's Guide to Technology Transfer at SU*
 - *Quick Start Guide*
 - Bayh Dole Act at <https://techtransfer.syr.edu/about/bayh-dole/>
- Michaelson videos at <https://michelsonip.com/>

Software and IP Beyond Patents

- Copyright
- Trade Secret
- Data (sets)
- Multi-media



Rule of Thumb: OTT Functions as

“Keeper” of IP policy and adviser/arbiter of same

Unit charged with fiduciary responsibilities as to protecting (or releasing) and contracting (for monetization, dissemination, etc.) of the **University owned** intangible asset

- if it is not University owned, as is often true of undergraduates’ intellectual property technologies or assets, SU cannot assert rights to the IP (without a separate contract), and therefore has limited (or no) mission-driven purpose to advise on or manage undergraduate owned intellectual property

Final Thoughts

Together we have a lot of expertise!

Yours =

subject matter expertise, research, teaching, etc.

Ours =

IP, law, business, & the intersection of it all

When in doubt err on the conservative side & contact OTT

QUESTIONS





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