Technology Transfer for Pending Graduates

Presented by Janet Ralbovsky, Ph.D.
Licensing Associate

Technology Transfer: Health Science Center (Memphis) Office

What is “technology transfer”?  

- The goal of the technology transfer office is to find a suitable partner for viable inventions:
  - A partner strongly committed to turning the invention into a marketed product.
  - A partner with the financial and personnel resources to develop, manufacture, and sell the product.
  - A partner who is willing to pay the university a fair price for the invention.

A process to move knowledge and inventions from UT to an external partner to create products and services for public benefit
What is an invention?

Almost anything can be an invention!

- A piece of software developed in your lab
- An antibody useful for histology
- A mouse model of a disease
- A genetic polymorphism that is predictive for disease or treatment efficacy
- A new use of an old drug
- An entirely new pharmaceutical compound

*Each of these will have a different value, but they all can be commercialized.*

UTRF, Inventors and Revenues

- UTRF covers all expenses (patents, legal fees, marketing) and if we make money you make money.

Revenue Sharing formula:

<table>
<thead>
<tr>
<th>Revenue*</th>
<th>Inventor</th>
<th>UTHSC</th>
<th>Department</th>
<th>UTRF</th>
</tr>
</thead>
<tbody>
<tr>
<td>1st $5000</td>
<td>100%</td>
<td>0%</td>
<td>0%</td>
<td>0%</td>
</tr>
<tr>
<td>$5k-$1M</td>
<td>40%</td>
<td>15%</td>
<td>15%</td>
<td>30%</td>
</tr>
<tr>
<td>$1M+</td>
<td>35%</td>
<td>20%</td>
<td>20%</td>
<td>25%</td>
</tr>
</tbody>
</table>

* The inventor receives 100% of the first $5000 of gross revenue, but all other distributions refer to net revenue (i.e., after UTRF expenses are subtracted).
Working with UTRF

- Invention Disclosure Submitted and Evaluated
  - Assigned to case manager who talks to PI, studies invention
  - Assessed for novelty, protectability, and commercial potential
  - Go/no-go decision made and communicated back to inventor
- Patent attorney selected to draft patent application
- Manager prepares marketing material (with input from PI) and starts marketing the technology to potential licensees

Statutory Requirements

Statutory requirements for patentability in the United States:

- Novel
- Useful
- Non-obvious
Patentability

A research project may be publishable but not patentable:

- Not novel due to prior art (Prior art can be: Journals, books, patents, dissertations)
- Obvious to one skilled in the art

Public Disclosure

If an inventor discloses invention to public before filing a patent:

- Inventor has one year after disclosing invention to file US patent.
- Inventor loses foreign patent rights.
Public disclosure

Public disclosure can include:
- Published Thesis
- Publications in open literature (includes internet)
- Poster Sessions & Abstracts
- Presentations to open forum
- Personal communications without expectation of confidentiality
- Anything catalogued in a library

Primary discriminators are:
- Good faith attempt to maintain secrecy
- Substantiality of material disclosed

When to Contact UTRF

Contact UTRF:
- ANYTIME!
- Before publishing your dissertation
- Before presenting your work
- Before submitting abstracts that will be published—we will review abstracts to make sure they reveal appropriate material before they are published

*It is essential to protect your idea before it is presented to the public.*
Contacts

Richard Magid, Ph.D.
rmagid1@uthsc.edu
(901) 448-1562

Lakita Cavin, J.D., Ph.D.
lcavin@uthsc.edu
(901) 448-7827

Janet Ralbovsky, Ph.D.
jralbovs@uthsc.edu
(901) 448-1146