



Intellectual Property and Tech Transfer Sub-Group

Jilda Garton, Georgia Tech
Amy Laster, Foundation Fighting Blindness
Fred Reinhart, University of Massachusetts



Government | University | Industry
RESEARCH ROUNDTABLE

COGR
Council On Governmental Relations



Working together to optimize investment in health research and training.

Purpose and Goals

The IP and Tech Transfer Sub-group has the following goals:

- Identify agreed-upon principles that underlie the parties' mutual interests inherent in research engagements that seek to find new technologies that may be brought to bear on important problems in medicine and science.
- Identify areas of divergence in needs, policy, and practice between funders and research performers.
- Examine best practices and examples of innovative relationships that ease negotiations of those parts of research agreements that address intellectual property and technology transfer that are sometimes contentious.
- Endeavor to identify approaches that respect the constraints and missions of both parties while achieving the common goals identified as the purpose of the research engagement.



Sub-committees and co-chairs:

- Control of licensing;
 - Co-chairs: Sally O’Neil, Stanford, and Dario Dieguez, Foundation for Physical Therapy
- Definition of IP and Background IP
 - Co-chairs: Alexandra Albinak, Johns Hopkins and Kevin Wozniak, Georgia Tech (Foundation co-chair to be recruited)
- Principles on Patient access
 - Co-chairs: Felice Lu, UCOP and Amy Laster, Foundation Fighting Blindness
- Principles on Royalty sharing (total cost of research)
 - Co-chairs: John Ritter, Princeton and Jackie Hausman, Kenneth Ranin Foundation



Since May 16 IP/TT WG has been working through the subgroups to...

- gather resources and materials that might be useful in articulating principles important in the research funder-performer relationship, and
- when possible, identify common ground.

The November 7th priority topics further explored:



IP/TT Subgroup: Definition of Invention

- Using University-Institution Demonstration Partnership (UIDP) Guiding Principles:
 - Access to intangible research results should be treated separately from intellectual property (IP)
 - Foreground IP includes patentable subject matter resulting from research activity
 - Background IP should be defined in statement of work/application
 - Disclosure of Background IP



IP/TT Subgroup: Control of Licensing

- Themes identified:
 - Control vs Communication
 - Pre- and post-license rights
- Pre-license:
 - Licensing strategy
 - Choice of licensee
 - Negotiation process
- Post-license:
 - Licensee's progress



IP/TT Subgroup: Principles on Royalty Sharing

| General Agreement | Rarely Happens | Needs further discussion |
|---|---|--|
| Amount and cost of previous work (and potentially future) done at the institution | Premium to funder for certain contributions | Value other than funds provided by funder |
| Stage of Development | Reduced share to funder in some circumstances | Expenses not paid by funder |
| Funders need to share & performers need compensation | | Share kicks in at certain level of revenue |
| Avoiding complex calculations | | Funder royalty share is a reasonable % |
| Investor share | | Funder's ROI reflects contribution |

IP/TT Subgroup: Patient Access

Step 1: Define scope of the subgroup

Aspects of patient access the workgroup could consider:

- a) Patient Access Programs that decrease cost of treatment and/or assist with cost of travel to obtain treatment
- b) Development of inventions to treat orphan diseases or diseases where a smaller population is affected
- c) Access to treatments in poor/undeveloped countries
- d) Anything else? (seeking audience suggestions)

Next step: Finalize scope and start researching

