(important) Lessons Learned in Pursuit of a Revised Intellectual Property Policy

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The good news:

It takes a village. None of us can do it alone.

The bad news:

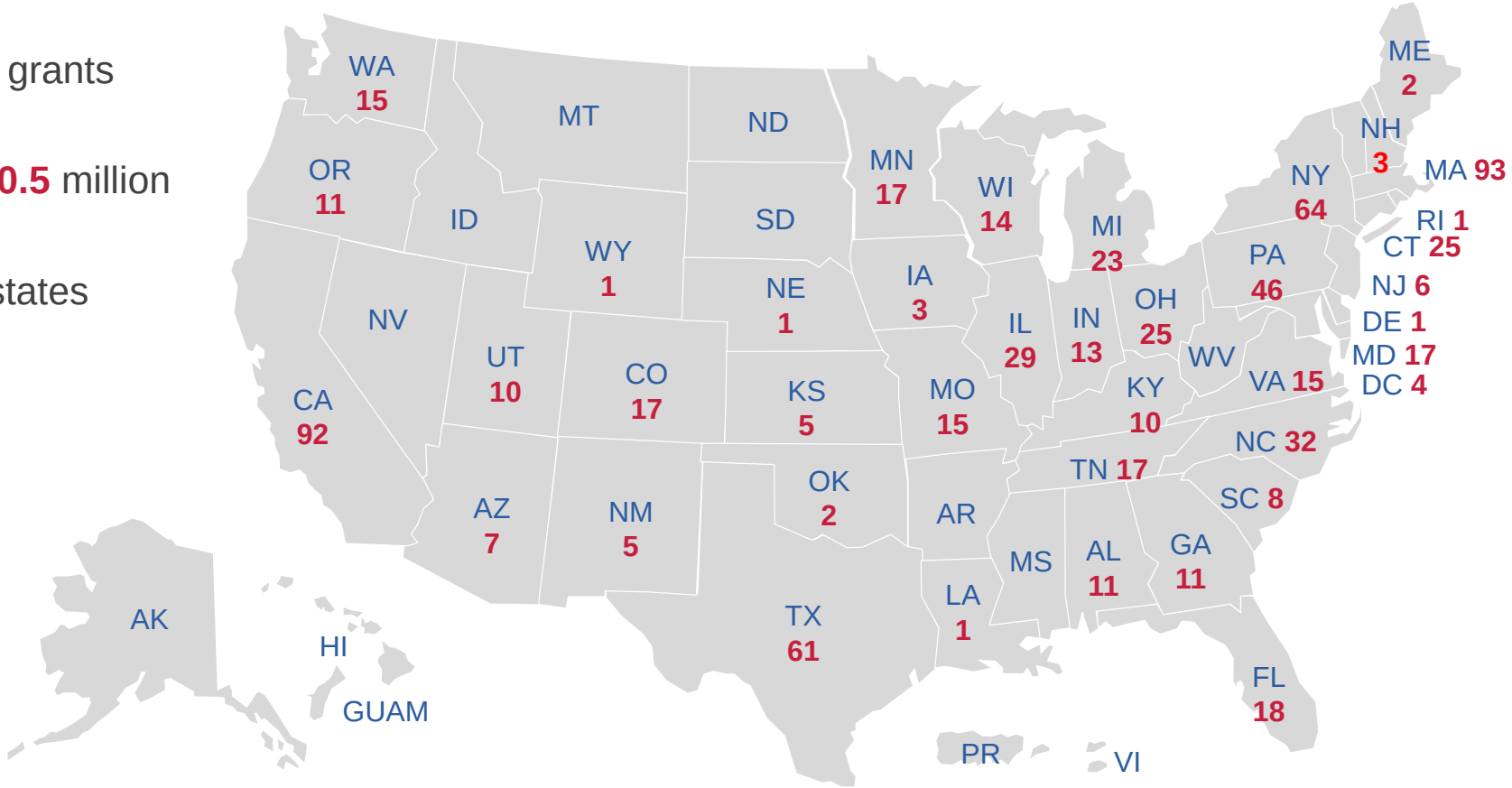
It takes a village. None of us can do it alone

ACS research investments drove a review of our intellectual property policy.

751 grants

$420.5 million

40 states



As of March 20, 2019

In 2018, an ACS Steering Committee evaluated ACS IP policy

- Reviewed current ACS intellectual property policy and ACS funding mechanisms ← **6/18**
- Reviewed a 2014 Health Research Alliance survey on intellectual property and collaborated with the HRA to survey members on intellectual property
- Reviewed ACS grantee reports of patent activities
- Met with technology transfer offices of ACS funded research
- Researched and reviewed intellectual property reporting
- Drafted revision(s) of ACS intellectual property policy
- Solicited external review of draft intellectual property policy documents by offices of tech transfer
- Planned rollout for revised ACS intellectual property policies
- Considered staffing and reporting needs
- Review of draft intellectual property policy by outside council ← **3/19**
- Phased rollout of new ACS intellectual property policy in 2019

Foundations and Tech Transfer Offices have similar missions –

to move the technology forward and into the world
as quickly and efficiently as possible.

“The top things University Technology Offices wish foundations knew as we develop intellectual property policies related to grants.”

#1-There are multiple players in the innovation ecosystem.

Who are the players on intellectual property teams? What are their roles?

- **Faculty are *inventors***
  - Faculty become founders, build companies, etc.
- **Graduate students, post doctoral fellows, technicians and external entrepreneurs are *doers***
  - Faculty can be doers, especially early on
- **Technology transfer officers are facilitators**
  - Matchmakers and red-tape problem solvers
  - Play a valuable role at critical transformation point

#2-Foundations have a unique position in the innovation ecosystem.

Solving common problems unites people, companies, foundations, universities, governments, etc.

- **Foundations can:**
  - Share our vision and problem statements

    Develop technology road-maps that rally resources to accelerate progress

    Help researchers understand unmet needs (*fill information gaps*)

    Focus resources and validate investment of time and money (from all parties)

<u>Foundations unite.</u>

#3-Foundations have an opportunity to align what we are asking for with why.

When putting reporting obligations into place, foundations can work with technology transfer offices to-

- Understand the goals of the foundation
- Assist with tailoring agreements
- Request reporting obligations that will be most helpful to the foundation

“We need to give an annual report to our donors. Donors are interested in knowing the number of inventions, patents, etc. generated by our funded grantees…”

- Enables the technology transfer office to set a date before the annual report and provide requested information.

#4-Highly specific reporting requirements can take the focus away from advancing the technology.

Where possible, using general language to request updates or information is preferred, rather than regular and highly specific reporting requirements.

- An added hurdle/bump in the road towards commercialization
- May require technology transfer offices to have highly sophisticated data bases

"…adds to the impression that companies have that it's hard to negotiate with a university because we don't know what we're doing…companies don't want lots of people seeing the details, can get in the way of negotiating…"

"The tech transfer office is already seen as an annoyance, as paper pushers, if you bring in more parties…if it's another bump in the road that may make the company say *no*"

#5-Tech transfer offices have lots to work on at any given time, potentially easier successes will get the most attention.

The university mission is to generate knowledge and then to disseminate that knowledge to the public through teaching and publication.

And…

Obligations imposed by foundation funding can stack the deck against the commercialization of technologies.

> …items that may create challenges to meeting a university's mission are going be more difficult for technology transfer offices to address.

- "requiring an in person meeting with the company"
- "restrictive publication language"
- "requiring approval before publishing"
- "requiring a drafts of replies to actions when we apply to the patent office"

#6-Limitations on how universities may share or use data/results from a research project can be a challenge.

Preserving the ability of faculty/researchers to freely interpret and use the fruits of their research are primary to meeting the university mission.

- Obstacles to the researcher's ability to use an invention they have made for research and education purposes are tough to manage
- Contractual terms and obligations that create hurdles to a company that may be interested in commercializing/licensing a new discovery are also problematic

"ultimately it is not the university or foundation that will be turning the discovery into a product…the terms of a funding agreement need to preserve a viable business opportunity for a commercial partner and keep that opportunity as attractive/enticing as possible…"

#7-Foundations are an IMPORTANT partner in advancing research…

- **BUT…**

- For many universities the primary “customer” or funder is the federal government (DOD, NIH, NSF)

- Obligations to the federal government therefore *often* supersede

- And…obligations that may put universities at odds in some way with the federal government are a challenge to accept

#8-Universities understand sharing income is appropriate.

- **BUT…**

- Sharing needs to be representative of the contributions made by the various parties (and there may be many)

- Income can be a big incentive/driver for inventors and may keep them vested in participating in the commercialization of their discovery

- Universities consider themselves to be the “first investor” in the discovery and take risks in spending money to protect a new discovery with a patent application

“Revenue sharing that cuts too much from the university and the inventor can serve as a disincentive.”

“…particularly prevalent in this day and age of collaborative science where we may also be revenue sharing with a joint owner as well and where multiple funding sources may have been used to develop the discovery….”

#9- Tech transfer offices *really* appreciate having a consistent and clear method to reach the IP contact at the foundation.

Contract managers say this is a HUGE time sink!

- "…if we contact the foundation to send reporting, or if we need to talk to someone about intellectual property…it is often difficult to find the right person to talk to…"

- "…we are all doing the best we can, you are all over worked and underpaid like we are…having a designated person or email is incredibly helpful in keeping the process moving…"

#10-The most important thing tech transfer offices want us to know…

…cuts both ways:

“we want colleagues from non-profits to understand our mission and how it impacts many of the issues we care about.”

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TO MOVE THE DISCOVERY/INVENTION/TECHNOLOGY FORWARD AND INTO THE WORLD AS QUICKLY AND EFFICIENTLY AS POSSIBLE.