USM TECHNOLOGY TRANSFER:
AN OVERVIEW

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• Transition results of research out for “public benefit”

• Adopted in 1980 and implemented by 37 C.F.R. 401

• Gives U.S. universities control of the intellectual property rights related to inventions resulting from federal-government funded research.

• B-D permits a university to elect to pursue ownership of an invention in preference to the government.
The Office of Technology Development (OTD) is responsible for the protection, development and commercialization of the University’s research innovations. We strive to proactively support USM in its mission of education, research and public service.

OTD serves the faculty, staff, and students of USM and the public by:

1) Fostering a culture that promotes creative invention, creative authorship, and innovation at USM.

2) Protecting USM generated intellectual property (IP) through patents, copyrights, trademarks, or other means.

3) Present technologies for potential applied use for public benefit via collaborative research, licensing of IP, and companies specifically interested in commercializing IP.
What is Technology Transfer?

- Research
- Invention Disclosure
- Review & Evaluation
- IP Protection
- Licensing
- Marketing
- Development
- Public Benefit
Basic Research
Inventions and Discoveries
Have you ever gotten the “Polite Nod?”
"THE BIOTA EXPERIENCED A 100% NEGATIVE RESPONSE."

Case in point…
Issues

• Is this product/invention patentable / protectable?

• Is there a market for this invention?

• Can we find a business interested in licensing, developing and commercializing this technology?

• Can we start a new company?

• Are there available dollars to help further develop the inventive technology?
How OTD answers these questions...

• Analyze marketplace, develop business plans, and understand patent/licensing issues

• Interface with attorneys to help with intellectual property processes

• Network to venture/angel capital

• Resource for connecting people and/or companies looking for new technology inventions; helping faculty further develop the technology pipeline.
Steps for success

- Patents/licensing agreements
- Proof of concept programs
- Industry partnerships
- Business plans
- Innovation/Entrepreneurship Initiatives
- Venture capital / patenting costs
591 new commercial products introduced
4,899 licenses executed
1,152 options executed
416 executed licenses containing equity
38,600 active licenses and options
670 new companies formed, 487 of which had their primary place of business in the licensing institution’s home state
3,927 startup companies still operating as of the end of FY2011
SO... What IS a “disclosure?”

For technology transfer purposes, there are two contexts for the word “disclosure.”

1. **Internal disclosure**: Communicating a discovery, innovation, or invention to the OTD

2. **Public disclosure**: Publications in books and technical journals. Poster sessions, slides, lectures, seminars which are open to the public, letters, even conversations can count as a disclosure.
The basic act of informing a party that one has made an invention is not considered a "public disclosure" of the invention.

In order to act as a patent bar, the disclosure must be enabling – in other words, it must teach someone "of ordinary skill in the art" how to actually duplicate the invention.
DISCLOSING THE INNOVATION

Public disclosure can include, but are not limited to, the following:

1. Written or oral disclosure, can be considered a public disclosure, unless the information was communicated in confidence (i.e. NDA). Disclosures to employees are not considered to be public disclosures.

2. Poster sessions, slides, lectures, seminars which are open to the public, letters, even conversations can count as a bar to patentability.

3. An "offer for sale" counts as a bar to patenting (after the one year "grace period") in the U.S. For example: Showing a product at a trade show could be considered as such.
The basic act of informing a party that one has made an invention is not considered a "public disclosure" of the invention.

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IMPORTANT

Conversations between and OTD staff and USM employees regarding the disclosure of their invention are considered to be confidential in nature and do not constitute a “public disclosure.”
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