

# TECHNOLOGY TRANSFER FAQ AND GUIDE

## What is technology transfer?

Technology transfer is the process of transitioning technologies from the research lab to the marketplace. This activity is complimentary to the process of publishing research findings.

## How does technology transfer fit within Ilia State University mission?

Part of Ilia State University public service mission is to ensure that the results of its research are made available for public use and benefit. This is accomplished in many ways: through educating students, publishing results of research and ensuring that inventions are developed into useful products and services for the benefit of the public. Since Ilia State University is not in the business of making and selling new products and services, we look to partner with industry to commercialize these inventions.

## What are the typical steps in the process?

### **Research**

Research often leads to discoveries and inventions with commercial potential. These discoveries or inventions may comprise intellectual property that would benefit from protection through patents, copyright, and occasionally trademarks. Early contact with Technology Commercialization Office (TCO) when you believe you have an invention is important.

### **Invention Disclosure**

Inventions are disclosed to TCO by submitting an Invention Disclosure Form. This submission formally begins the technology transfer process, although you should feel free to contact us before you even start to fill out an Invention Disclosure Form. The Invention Disclosure is a confidential document and we ask that you provide a full description of your invention, including how to make and use it, and any supporting experimental data that you have generated. The Invention Disclosure will be assigned to a licensing officer, assigned a tracking number and TCO will report the invention to sponsors of the research that led to the invention and/or any institutions that may be co-owners, as applicable. You will be notified of this information via email. The Invention Disclosure can be found at <http://tco.iliauni.edu.ge/index.php/researchers/submit-an-invention-report>

### **Assessment**

Our office will work with you to evaluate your invention's commercial potential, including its novelty and utility, and to help identify potential applications. Inventors can check the status of their invention(s) at any time by going to <http://tco.iliauni.edu.ge/index.php/researchers/check-invention-status>

### **Patent Protection**

A provisional patent application may be filed if the invention is sufficiently developed, has commercial potential, appears to be patentable, and where a patent position on the invention will facilitate finding a partner to commercialize the technology.

## **Marketing**

When the invention is ready to be marketed our office will develop marketing materials to help highlight the licensing opportunity to potential industry partners, which will likely include generating a non-confidential description of your invention. Your input in the development of this one-page document is very valuable as it helps refine and craft the message for industry. A list of target companies, investors, etc. for marketing the invention is compiled from many sources including our contacts database, market research and your industry contacts.

## **Licensing**

A license agreement is a contract between Ilia State University and a third party in which Ilia's rights to a technology (intellectual property and property rights) are licensed for commercial development and use. In exchange, Ilia State and the inventors receive financial remuneration (generally in the form of upfront payments, milestone payments and royalties on the sale of products and service that make it to market). Our office enters into license agreements with both startup and established companies. Often times, prior to entering into a license agreement we will implement a Letter of Intent (LOI) which is a short term, easy to execute agreement that allows a company to "lock up" the technology for a short period of time while negotiating the license, raising capital, etc.

## [How do I know that I have an "invention"?](#)

An "invention" can be anything from a new material, device, research tool, mouse model, to a novel algorithm and even a new use for a known drug. We encourage you to contact TCO even before filling out an Invention Report and we can talk through your idea and how we might best proceed.

## [When should I file an invention disclosure?](#)

It's never too early to talk to our office about an invention that you think might have commercial potential. You should disclose your invention to TCO before the work is published or publically presented. Although we may still be able to secure an intellectual property position in the US if a patent application is filed within one year after a public disclosure, the ability to secure patent protection in other countries is invariably lost. With some exceptions, submission of a manuscript to a journal is generally not considered a disclosure, but with many journals rapidly publishing online following acceptance, it is important to be aware of the actual publication dates. As always, feel free to contact us before filing an Invention Report or if you have questions as what constitutes a public disclosure.

## [Can I publish my work and still protect the intellectual property?](#)

Yes, but since patent rights may be affected by publications that precede a patent application filing, is it best to submit an Invention Disclosure well before any public communication or other disclosure of the invention. Such disclosures can include presentations, lectures, posters, abstracts, thesis defenses, and publications either online or in print. Research proposal submissions are generally not considered public disclosures but it is important to understand if the proposal will become publically available when the grant is awarded. Feel free to contact us even before filing an Invention Report so that we can map out a strategy for your invention.

What if the work was done in collaboration with someone at another research institution or company?

The invention may be jointly owned by Ilia State University and the other institution or company. Each inventor must disclose the invention to his or her home institution. TCO will work with the other institution or company to create an agreement that will determine who will take the lead in managing the invention.

Do I have to disclose inventions that I make in my spare time or under a consulting agreement?

Yes. All Ilia State employees sign a Patent Acknowledgement Agreement that requires them to disclose any potentially patentable inventions, whether or not University resources are utilized. If, however, the invention is created in your spare time, without using University resources and is outside of the scope of your employment, Ilia State may relinquish rights to the invention.

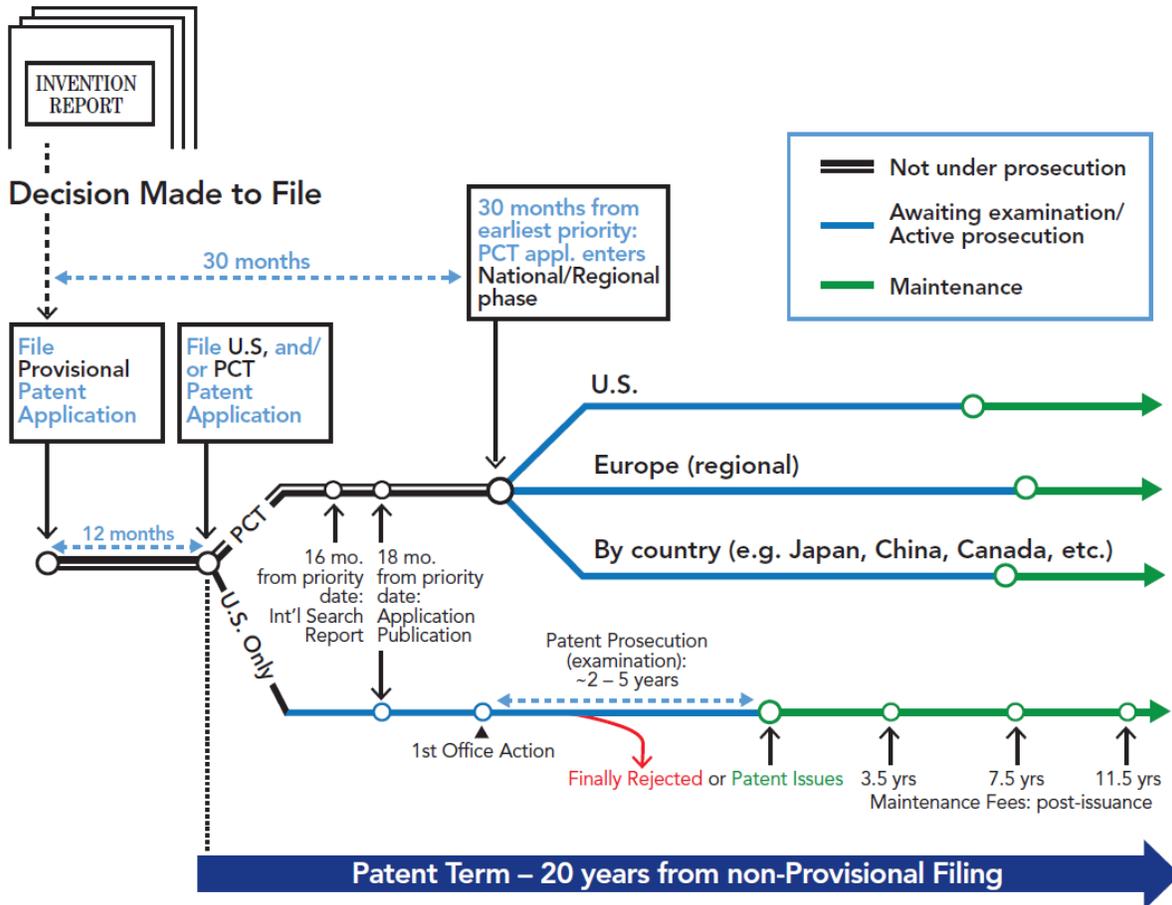
What is the definition of an inventor and who determines this?

Under patent law, an inventor is a person who is involved in the conception of an invention as claimed in a patent application. This is a legal determination that is distinct from authorship on a paper and is determined by our patent counsel. Correctly naming inventors on a patent is important for patent validity so you should list all individuals on the Invention Disclosure who may have made an inventive contribution and outside patent counsel can then determine who qualifies as inventors.

Can I share royalties with an individual who worked on the invention but is not an inventor?

Yes. If there is a person that you feel has contributed towards the development of an invention (but whose contribution does not rise to the level of inventorship) and you would like to reward them, you can designate a percentage of your royalties to be given to them. We can sign a letter agreement that the parties sign to memorialize this understanding.

What is the timeline for patenting an invention?



Will TCO file a patent even before a licensee has been identified?

Yes. Our goal is to file patents broadly and aggressively to protect Iliia State University inventions and maximize the possibility that these inventions will eventually be commercialized. Iliia State will often make the investment to convert a provisional application to a full patent application before a licensee has been identified, especially when the technology appears promising as outlined below.

## Why file a provisional patent application rather than a non-provisional patent application?

A provisional patent application is a very useful step in the patent process that has many benefits. Because a provisional application has fewer formal filing requirements than a non-provisional application, a provisional application allows an inventor to more quickly and easily obtain an effective filing date, while retaining the opportunity to supplement the provisional application over the year that follows with additional data that further supports the invention. A provisional application also has significantly reduced filing fees as compared with a non-provisional application. Lastly, a provisional application does not start the clock in calculating the 20-year term of any issuing patent (the clock begins when the subsequent non-provisional is ultimately filed, effectively extending the patent term by an additional year).

## How does TCO prioritize its resources for patenting and marketing of inventions?

Our office tries to actively patent and market all technologies that appear to have potential commercial value and are ready for marketing. There are several key factors that help determine this:

- Does the technology have the potential to address an unmet commercial need?
- Is the invention well-differentiated from competing solutions on the market or in development?
- Are patent rights obtainable and enforceable?
- Have clear technology development milestones been identified that would make the invention of interest to industry?
- Is the inventor actively engaged in developing the technology?
- Will having intellectual property protection facilitate the technology being commercially developed?

## How are licensees found?

Licensees are identified through existing relationships within the TCO office. We continually attempt to broaden these relationships through various forms of networking and market research.

## What is a non-confidential disclosure?

A non-confidential disclosure (NCD) is a short description of your invention that can be used to market the opportunity to potential licensees without disclosing confidential information. The description of the invention focuses on the benefits of the invention rather than underlying technology. TCO writes these NCD's, however your input and assistance with the content is very valuable.

## What if a company wants to know confidential information?

If a company is interested in obtaining more details about your invention for further evaluation, we can execute a Non-Disclosure Agreement (NDA) to ensure that proprietary information remains confidential and that any information disclosed is not deemed to be a public disclosure for the purposes of patenting. To avoid risking your patent rights, always contact TCO before having any discussions with individuals outside of the Ilia State where you plan to disclose your invention.

## How can I help the process?

Your active involvement can dramatically improve the chances of finding a licensee. Once interested companies are identified, the inventor is the best person to describe the details of the invention and its technical advantages. Typically companies are most interested in licensing technology where the inventor is invested in moving the technology toward commercialization.

## What is a “letter of intent”?

A Letter of Intent (LOI) is a simple three-page agreement giving the licensee a time limited exclusive right to negotiate an option or license agreement.

## What is an option agreement?

An option agreement provides a company the right to make and use (but not offer for sale or sell) the technology purely for internal research and evaluation purposes, with an option to enter into negotiations for a license for a fixed period of time.

## Can there be more than one licensee for a single invention?

Yes, an invention can be licensed to multiple licensees, either nonexclusively to several companies, co-exclusively to a defined and limited number of companies, or exclusively to several companies with each having a unique field-of-use or geography.

## How are license terms determined?

License terms are tailored to the specifics of the technology, market and business plans of the licensee. General terms found in most licenses include an upfront license fee (cash or cash and equity), royalties, diligence terms, milestone/maintenance fees, indemnification, insurance and reimbursement of historical and ongoing patent costs.

## How is licensing revenue distributed?

Per Ilia State IP policy, revenues from licensing fees, royalties and equity— minus any unreimbursed legal expenses—are shared with the inventors.

### What is a Material Transfer Agreement (MTA)?

An MTA is a written contract entered into by a provider and a recipient of tangible research material that specifies terms and conditions for the transfer and use of these materials. At Ilia State, TCO negotiates and signs all incoming and outgoing MTAs since intellectual property rights can be endangered if materials are used without a proper MTA. In particular, incoming MTA's may contain clauses that compromise the value of future patent rights arising from the use of the material.

### What is a copyright?

Copyright law protects original works of authorship that have been fixed in a tangible format in which the work can be recreated. This includes software code, literary, dramatic, musical, artistic, and certain other intellectual works. Copyright protection is automatic upon creation of the work, but registration is necessary before filing a legal action against any party infringing the copyright.

### How do I disclose my work that I want to copyright?

All copyrightable materials should be disclosed to TCO using special section of the Invention Disclosure Form. Please see <http://tco.iliauni.edu.ge/index.php/researchers/submit-an-invention-report>